

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: February 23, 2012

Opposition No. 91190899

Sharp Kabushiki Kaisha, a/t/a
Sharp Corporation

v.

Onsharp, Inc.

Cheryl S. Goodman, Interlocutory Attorney:

This case now comes up on opposer's motion, filed October 6, 2011, to compel discovery and to modify the Board's protective order; opposer's motion, filed October 6, 2011, to test the sufficiency of applicant's responses to its requests for admissions; and opposer's motion, filed October 6, 2011, to amend its pleading. Applicant has not responded to any of these motions.

Motion to Amend Notice of Opposition

Opposer's motion to amend the notice of opposition is granted as conceded.

Applicant is allowed until TWENTY DAYS from the mailing date of this order to file its answer thereto.

The Board now turns to the motion to compel and motion to test the sufficiency of applicant's responses to opposer's requests for admissions.

Good Faith Effort

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The Board finds opposer made a good faith effort to resolve the discovery dispute.

Document Requests

Document Request Nos. 1-8 and 12-34

Opposer complains that applicant's objections to the document requests are unexplained and applicant should be ordered to "delete these unexplained objections and fully respond to the requests."

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide amended written responses to these requests by deleting its unexplained objections from its written responses, and to fully respond to the requests, if responsive documents have been withheld on the basis of these objections.

Document Request Nos. 2-15, 21, 22, 29, 31 and 32

Opposer's complaint is that applicant's response that applicant's ONSHARP mark cannot be dissected is not well taken since the entire term SHARP is incorporated in the mark ONSHARP. Opposer seeks for the Board to rule that "Applicant may not withhold documents based on its response that its mark cannot be dissected."

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date to must produce responsive documents that have not been

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produced (to the extent that such document exist) on the basis that the ONSHARP mark cannot be dissected.

Document Request Nos. 2-5, 12 and 13

In its responses to these requests, applicant objected to the meaning of "similar term." Opposer requests that "applicant be required to provide a complete response to these requests based on Opposer's clarification on August 10, 2011, of the meaning of "similar term."

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce additional responsive documents, (to the extent that such documents exist), in view of opposer's August 10, 2011 clarification of "similar term."

Document Request Nos. 25

Opposer seeks for the Board to order applicant to "provide a complete response" based on the "already provided definition of 'Opposer's SHARP Marks'" to which opposer directed applicant in its August 10, 2011 letter.

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce additional responsive documents, (to the extent such documents exist), in view of opposer's August 10, 2011 clarification regarding the definition of "Opposer's SHARP marks."

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Document Request Nos. 26, 27 and 30

Opposer requests that applicant's objection that ONSHARP cannot be dissected be removed and applicant provide complete responses.

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce responsive documents (to the extent that such documents exist) that have not been produced on the basis that ONSHARP cannot be dissected, and to provide amended written responses to these requests, removing the objection that ONSHARP cannot be dissected.

Document Request nos. 9, 11, 30

Opposer requests that a complete response be provided based on its August 10, 2011 clarification of the definition of "Opposer's Sharp marks."

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce responsive documents (to the extent that they exist) in view of opposer's clarification of the definition of "Opposer's SHARP marks" as explained in opposer's August 10, 2011 letter.

Document Request no. 6

Opposer seeks a complete response to this request in view of it providing clarification in its letter of August 10, 2011 that applicant's answer should refer to "part 6(2)

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of the request" which provides meaning of "under such SHARP marks."

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce responsive documents (to the extent such documents exist) in view of opposer's August 10, 2011 clarification of "under such SHARP marks."

Document Request nos. 12, 13, 14 and 15

Opposer's complaint is that the information requested encompasses applicant's information related to the ONSHARP mark, not documents opposer is in possession thereof, and applicant has "objected to making a complete response based on its claimed belief that Opposer or its attorneys have possession, custody or control of the information requested."

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce responsive documents with respect to "*Applicant's information* related to the ONSHARP marks and any variations of the mark" in view of opposer's clarification of these requests.

Document Request nos. 14 and 15

Opposer clarified in its August 10, 2011 letter that "any mark containing the term SHARP" includes any mark containing the letters SHARP in that order. Opposer

requests that applicant be required to provide full responses to these requests based on its clarification.

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to produce responsive documents, (to the extent that such documents exist) in view of opposer's August 10, 2011 clarification of "any mark containing the term SHARP" and to amend its written responses.

In summary, the motion to compel is granted with regard to all document requests identified in the motion to compel.

Production of Electronic Copies

Opposer has requested that the Board order applicant to provide copies of its documents electronically rather than make the documents available for inspection or copying, or to quantify its responsive documents and things and provide an estimate to opposer so that opposer can take appropriate action.

Opposer's request is granted to the extent that applicant should provide an estimate to opposer of responsive documents (quantity) that will be produced or that are available for inspection and copying so that opposer can take appropriate action. If practicable, applicant may produce the responsive documents in electronic form.

To the extent no additional responsive documents exist with regard to the above document requests for which the motion to compel has been granted, applicant should so state in its supplemental written response.

Interrogatory Requests

Interrogatory no. 1

Opposer requests that applicant provide the information requested.

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide a supplemental response providing the requested information to this interrogatory request.

Interrogatory no. 3

Opposer requests supplementation of the response to Interrogatory no. 3 to identify the manner in which the mark was used.

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide a supplemental response identifying the manner in which the mark has been used.

Interrogatory no. 4

Opposer requests supplementation of this response to indicate the circumstances of first use, and whether the

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date of first use referenced in Interrogatory no. 2 applies to each of the services identified.

Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide a supplemental response indicating whether the statement in Interrogatory no. 2 applies to each of the services identified in response to Interrogatory no. 2 and to provide the details of the circumstances of each first use.

Interrogatory nos. 6, 9, 10, and 11

Opposer requests complete responses in view of its motion for entry of a protective order.

The motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide responses under the modified protective order in this case.

Interrogatory no. 8

Opposer states that applicant failed to provide the required information, regarding the dates in which promotional materials were/are distributed, and that it should supplement its response.

The motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to supplement its response to provide the

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dates in which the promotional materials were/are distributed.

Interrogatory nos. 11, 12 and 14

Opposer clarified this request in its August 10, 2011 letter and seeks for the Board to order that applicant provide the information requested, as it cannot withhold information based on its response that a mark cannot be dissected.

The motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide supplemental responses to these requests in view of opposer's August 10, 2011 clarification. Interrogatory no. 14

Opposer clarified this request in its August 10, 2011 letter stating that it seeks confirmation that the only keyword applicant purchased that includes the term SHARP is term ONSHARP.

The motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide a supplemental response confirming that the only keyword purchased by applicant or on applicant's behalf that includes the term SHARP is ONSHARP.

In summary, the motion to compel is granted with regard to all the interrogatory requests identified in the motion to compel.

Request for sanctions

Opposer's alternative request for sanctions is premature and will receive no consideration, as no discovery order previously issued in this case. Trademark Rule 2.120(g)(1).

However, applicant is advised that should it fail to comply with the order issued herein related to discovery, or the protective order in this case, it may be subject to a motion for sanctions, which remedies may include entry of default judgment, for noncompliance. Trademark Rule 2.120(g)(1); TBMP Section 527.01(a).

Request for Admissions

Admission requests nos. 8-12

Applicant has objected and then denied these admissions which is proper. However, because applicant's response indicates a lack of understanding of these requests due to terminology, and opposer has since clarified the language set forth in these admissions, the motion to test the sufficiency of these responses to the requests for admissions is granted to the extent that applicant shall provide supplemental responses within thirty days of the mailing date of this order in view of opposer's August 10, 2011 clarification.

Admission Request no. 9

Opposer clarified the meaning of "educational institution" in its letter of August 10, 2011, and requests that applicant supplement its response in view of the clarification.

The motion to test the sufficiency of the response to the request for admission is granted, in view of opposer's clarification, and applicant shall supplement its response within THIRTY DAYS of the mailing date of this order.

Admission Request no. 11

Opposer clarified the meaning of "commercial market" in its August 10, 2011, letter and requests applicant supplement its response in view of the clarification.

The motion to test the sufficiency of applicant's response to the admission is granted to the extent that, in view of the clarification, applicant shall supplement its response within THIRTY DAYS of the mailing date of this order.

Admission Request Nos. 20-22, 55-60, 86, 89, 90, and 92-94
Admission Request nos. 43-54; 61-84.

Opposer complains about applicant's objections to these requests for admissions and seeks better responses to these requests or seeks for the requests to be deemed admitted.

While the responses to the requests for admission include objections, they also include a denial of each request. Therefore, these responses are sufficient.

The motion to test the sufficiency of admissions is denied with regard to these requests. See TBMP Section 411.03 (3d ed. 2011) ("In instances, however, where a request for admission is either admitted or denied, such admissions or denials constitute a proper response even if the response also includes objections. The requesting party therefore should refrain from challenging the sufficiency of the response").

Admission Request no. 129

Applicant has denied this request and opposer requests that the response be supplemented to include the reasoning for this denial or that the request be deemed admitted.

The motion to test the sufficiency of admissions is denied with regard to this request, as applicant's response is sufficient and proper. Applicant is not required to explain the reasoning for this denial in a response to the request for admission; this matter is a question for proof at trial.

In summary, opposer's motion to test the sufficiency of applicant's responses to the requests for admissions is granted with respect to request for admission nos. 8-12 and denied with respect to request for admission nos. 20-22, 43-54; 55-60, 61-84, 86, 89, 90, and 92-94, and 129.

Request for Entry of Modified Protective Order

Opposer seeks a variation on certain terms with respect to the Board's standard protective order including a two-tiered level of confidentiality (confidential or highly confidential) rather than a three-tier level of confidentiality (confidential, highly confidential, commercially sensitive-trade secret). Under a two-tier agreement, trade secret and commercially sensitive information would be designated as "highly confidential." However, opposer also seeks to restrict from the definition of "attorney" Toni Sandlin, her law firm Sandlin Law, Ltd., "or any other person affiliated with an employee of Onsharp, Inc. (e.g., married)" with respect to access to confidential and highly confidential information and to specifically designate what legal department employees from Onsharp will have access to confidential information.

Opposer argues that Toni Sandlin is still listed as attorney of record on the application, and that "she has power of attorney in this proceeding" which has not been revoked. "Opposer believes it's reasonable to prevent the spouse of the president of Applicant from being given access to Opposer's confidential and highly confidential information and that it is also reasonable to preclude such access to legal employees of Applicant who are similarly related by affiliation with non-employees of Applicant because they present an unacceptable risk for inadvertent

disclosure of Opposer's information." Opposer argues that confidential information should be "limited and only given to persons expressly designated in the Protective order" given applicant's small size.

Although opposer argues that Sandlin is still the attorney of record due to the power of attorney not being revoked, the Board finds that applicant's filing on November 3, 2011, advising that it intended to represent itself, effectively acted as a revocation of any power of attorney filed in the case.¹ See Trademark Rule 2.19(a). The Board further notes that in view of applicant's pro se representation, it will not have access to trade secret or commercially sensitive information and will be required to hire outside counsel for such review on its behalf. TBMP Section 412.02 (3d ed. 2011).

Opposer's motion to amend the protective agreement to a two-tier agreement (confidential and highly confidential) is granted.

Opposer's motion to modify the protective order to specifically designate in-house counsel or legal department employees is granted. Trademark Rule 2.127(a).

With respect to opposer's proposal to amend the definition of "attorney" in the Board's standard protective

¹ The Board has updated the Office records to reflect the new correspondence address for applicant. No e-mail address has been provided.

agreement, the Board finds that opposer has not met its burden of showing good cause for modification of the definition to exclude Sandlin, her firm, or an individual "affiliated" with an Onsharp employee from accessing confidential information. Presently Sandlin is not counsel for applicant and no Onsharp employee attorney relatives have been identified as representing applicant; therefore, opposer's basis for entry of this provision is unsupported and speculative.² Moreover, if Sandlin or her firm or an attorney affiliated with an Onsharp employee were hired as applicant's outside counsel, opposer has not established good cause for restricting these counsels' access to the confidential information, especially since such information is accessible to Onsharp officers and to opposer's outside counsel under the terms of the protective agreement.

The Board is unwilling to preclude attorney access to confidential materials based only on a vague and speculative possibility of inadvertent disclosure or misuse of discovered materials. With regard to opposer's attempts to exclude Sandlin, her law firm and unidentified persons

² Even if Sandlin or an affiliate to an Onsharp employee were representing applicant, opposer has not supported its position that these attorneys should not be able to access confidential information, which such attorneys may do under the Board's standard protective agreement. The Board notes attorneys are officers of the court, are bound by the code of professional responsibility, and may be subject to sanctions for improper access or disclosure of confidential information provided under a protective order.

affiliated with an Onsharp employee from accessing highly confidential information, the Board finds that excluding such attorneys is premature inasmuch as applicant is representing itself pro se and presently, no outside counsel has been designated to review highly confidential documents on its behalf.³

Accordingly, opposer's motion to include the following language in the protective order under "Attorney:" "However Attorney for Applicant (in house or outside counsel may not include Toni M. Sandlin or Sandlin Law, Ltd., or any other person affiliated with an employee of Onsharp, Inc. (e.g., married)" is denied.

However, the Board will require the addition of the following paragraph in the modified protective agreement:

Disclosure to Outside Counsel (Pro Se Party)

(4(a)) If a party is representing itself pro se and desires to have access to information designated as "HIGHLY CONFIDENTIAL," it must first inform the other party or its attorney in writing of the identity of the outside counsel to whom such documents or information will be disclosed. The other party or its attorney who will have ten (10) days from receipt of such notice to object to disclosure to any of the attorneys identified, setting forth the reason for the objection. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the pro se party seeking access to the HIGHLY CONFIDENTIAL information by a particular outside counsel to move for an order of the Board allowing the disclosure of HIGHLY CONFIDENTIAL information

³ Should applicant hire outside counsel to represent itself, and not continue in its pro se status, opposer can raise objections to outside counsel's access to highly confidential matter, if appropriate, at a later date.

to its chosen outside counsel. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

In view thereof, opposer's motion to modify the Board's protective order is granted in part and denied in part. The parties are allowed until THIRTY DAYS from the mailing date of this order to submit a signed copy of the modified protective agreement as set forth herein.

Proceedings are resumed.

Dates are reset as follows:

Discovery Closes	4/23/12
Plaintiff's Pretrial Disclosures	6/7/12
Plaintiff's 30-day Trial Period Ends	7/22/12
Defendant's Pretrial Disclosures	8/6/12
Defendant's 30-day Trial Period Ends	9/20/12
Plaintiff's Rebuttal Disclosures	10/5/12
Plaintiff's 15-day Rebuttal Period Ends	11/4/12

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.