

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

Baxley

Mailed: May 21, 2007

Cancellation No. 92042082

Four Seasons Dairy, Inc.

v.

International Gold Star
Trading Corp.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of: 1) petitioner's motion (filed April 3, 2007) to compel discovery and to declare its requests for admissions to have been admitted; and 2) respondent's cross-motion (filed April 20, 2007) to reopen the discovery period, to allow it to serve discovery responses with objections, and for leave to amend its admissions.

The Board turns first to respondent's motion to reopen the discovery period, which closed on December 30, 2003. To obtain a reopening of the discovery period, respondent must show that its failure to act in a timely manner prior to the close of the discovery period was the result of excusable neglect. Although the parties have engaged in settlement negotiations since then, such negotiations do not rise to the level of excusable neglect. See *Atlanta-Fulton County*

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Zoo Inc. v. De Palma, 45 USPQ2d 1858 (TTAB 1998).

Accordingly, the motion to reopen the discovery period is denied.

The Board turns next to petitioner's motion to compel and respondent's cross-motion to be allowed to serve discovery responses with objections. As an initial matter, the Board finds that petitioner made a good faith effort, as required by Trademark Rule 2.120(e)(1), to resolve the parties' discovery dispute prior to seeking Board intervention.

Although petitioner served its first set of interrogatories and first set of document requests on December 29, 2003, the parties have been engaged in settlement negotiations since then and have sought numerous extensions based on those negotiations. For the same reasons that the Board denied respondent's motion to reopen the discovery period, the Board finds that respondent's failure to serve timely responses to petitioner's first set of interrogatories, first set of document requests, and first set of requests for admissions was not the result of excusable neglect.¹ See *Atlanta-Fulton County Zoo Inc. v.*

¹ With the exceptions of the time periods between October 18, 2004 and May 27, 2005 and between November 4, 2005 and June 6, 2006, when proceedings were suspended for settlement negotiations, dates continued to run in this case until opposer filed the motion to compel. Notwithstanding that the parties were negotiating to settle this case, respondent's discovery obligations were not tolled while dates were running.

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De Palma, supra. Nonetheless, the Board, in exercising its discretion to determine whether a party upon which discovery requests has been served has forfeited the right to object on the merits to those requests, finds that, under the circumstances in this case, petitioner should not receive the windfall of responses without objection to those interrogatories and document requests.² See *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). Accordingly, petitioner's motion to compel and respondent's motion to be allowed to serve discovery responses with objections are granted.

Respondent is allowed until thirty days from the mailing date set forth in the caption of this order to serve responses to petitioner's first set of interrogatories and first set of document requests. Respondent is allowed until thirty days from the mailing date set forth in the caption of this order to select, designate and identify the items and documents, or categories of items and documents, to be produced in response to petitioner's first set of document requests and to notify petitioner that the selection,

² Contrary to petitioner's contention in its attorney's correspondence with respondent's attorney, a party who has propounded discovery requests may not unilaterally declare that a responding party which has failed to respond to those requests in a timely manner has forfeited its right to object on the merits thereto. Rather, the Board, upon filing a motion to compel, may find that a responding party which has failed to respond to discovery requests in a timely manner has forfeited its right to object on the merits to those requests. See TBMP Section 403.03 (2d ed. rev. 2004).

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designation and identification of such items and documents has been completed.³ Petitioner is allowed until thirty days from receipt of notification from respondent that the items or documents have been selected, designated and identified to inspect and copy the produced materials, as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.⁴

To facilitate the orderly exchange of discovery, the Board hereby imposes its standard protective order, published in the *Official Gazette* on June 20, 2000 at 1235 TMOG 670, on both parties to this proceeding.⁵ A copy of the Board's standard form order is enclosed with each party's copy of this order. The parties are directed to file with the Board, within thirty days of the mailing date set forth in the caption of this order, signed copies of the attached acknowledgment form so that the terms of the protective order shall survive this proceeding.

The Board turns to respondent's motion for leave to amend its admissions. If a party upon which requests for

³ If the materials are voluminous, respondent may produce a representative sampling and so inform petitioner that a representative sampling has been produced. See TBMP Section 402.02 (2d ed. rev. 2004).

⁴ If respondent fails to comply with this order, petitioner's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1).

⁵ An electronic copy is available from the PTO website at <http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>.

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admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b) and granted by the Board. See Fed. R. Civ. P. 6(b) and 36(a); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990). The Board, upon motion, may permit withdrawal or amendment of an admission when the presentation of the merits of the proceeding will be subverted thereby, and the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits. See Fed. R. Civ. P. 36(b); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, *supra*.

After reviewing the parties' arguments, the Board finds that allowing respondent to amend its admissions will subvert presentation of the merits of this case.⁶ Moreover, there is no evidence that allowing respondent to amend its admissions will prejudice petitioner in maintaining its action on the merits herein. That is, petitioner has pointed to no specific evidence or witnesses

⁶ Although petitioner's requests for admission deal largely with allegations regarding possible nonuse abandonment of respondent's involved mark, petitioner has not pleaded a claim of abandonment in its petition to cancel.

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that will be lost or unavailable. See *Pratt v. Philbrook*, 109 F.3d 18 (1st^t Cir. 1997). Accordingly, respondent's motion for leave to amend its admissions is granted to the extent that respondent is allowed until thirty days from the mailing date set forth in the caption of this order to serve responses to petitioner's requests for admissions.

Proceedings herein are resumed. The discovery period remains closed. Testimony periods are reset as follows.

Plaintiff's 30-day testimony period to close: **8/24/07**

Defendant's 30-day testimony period to close: **10/23/07**

Plaintiff's 15-day rebuttal testimony period to close: **12/7/07**

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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

Four Seasons Dairy, Inc.

v.

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International Gold Star Trading Corp.

**PROVISIONS FOR PROTECTING
CONFIDENTIALITY OF INFORMATION
REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, **either** the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, **or** the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential—Material to be shielded by the Board from public access.

Highly Confidential—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to

this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their **attorneys** shall have access to information designated as **confidential** or **highly confidential**, subject to any agreed exceptions. **Outside counsel, but not in-house counsel**, shall have access to information designated as **trade secret/commercially sensitive**. **Independent experts or consultants, non-party witnesses, and any other individual** not otherwise specifically covered by the terms of this order may be afforded access to **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party that designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. 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 party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should

inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The

recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal.

Occasions when a whole document or brief must be submitted under seal should be very rare.

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

13) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the

information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

14) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15) Board's Jurisdiction; Handling of Materials After Termination.

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal. The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a

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particular provision of this order or for additional protections not provided by this order.

By Order of the Board, effective May 19, 2007.

/apb/

Andrew P. Baxley, interlocutory attorney

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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**ACKNOWLEDGMENT OF
AGREEMENT OR ORDER PROTECTING
CONFIDENTIALITY OF INFORMATION
REVEALED DURING BOARD PROCEEDING**

I, _____[print name], declare that I have been provided with a copy of the Agreement or Order regarding the disclosure of, and protection of, certain types of information and documents during and after the above-captioned opposition or cancellation proceeding before the Trademark Trial and Appeal Board.

I have read the Agreement or Order and understand its terms and provisions, by which I agree to be bound. Specifically, I agree to hold in confidence any information or documents disclosed to me in conjunction with any part I take in this proceeding.

I declare under the penalty of perjury that these statements are true and correct.

[signature]

[print title, if applicable]

[date]