

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

Mailed: January 31, 2006

Cancellation No. 92043900

Omnova Solutions, Inc.

v.

DIE GEM CO., INC., THE

Linda Skoro, Interlocutory Attorney

This case now comes up on a continuing dispute over entry of, and the nature of, a protective agreement.¹ At the outset, it is noted that respondent is appearing pro se. This has created a noticeable handicap in allowing this proceeding to move forward.

A review of the record reveals that when respondent finally filed its answer to the petition to cancel on June 1, 2005, it also attempted to prove its case at that time and submitted documents into the public record that it considered confidential. By order dated July 30, 2005, the Board withdrew those documents from the public record and

¹ It is noted that this proceeding has been technically suspended since July 30, 2005, yet there has been a series of informal filings by the parties. There was also a motion for default judgment filed by petitioner on July 25, 2005 due to respondent's failure to serve a copy of its answer, filed June 1, 2005, on petitioner. The answer has been served on petitioner and its motion for default judgment is hereby denied as moot.

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temporarily considered them confidential, suspending proceedings and allowing the defendant thirty days to file its confidential documents properly and for the parties to enter into a protective agreement providing for the designation of confidential materials. On August 4, 2005, respondent filed a copy of some correspondence directed to petitioner regarding a protective order, which prompted further "informal" filings² with the Board as the parties attempted to reach agreement on the provisions of a confidentiality agreement. The most recent of these filings is respondent's "Proof of need for confidentiality" filed January 18, 2006.

As alluded to earlier, much of the disagreement in this proceeding appears to be the result of respondent's lack of understanding of the nature of these proceedings³ and the purpose of confidentiality agreements. Respondent initially allowed what it considered to be confidential documents into the public record when it tried to prove its case through its answer to the petition to cancel. Any information and

²² The Board considers these to be informal, in that they are not in the form of a motion, but rather appear as letters to the interlocutory attorney assigned the case at that time, and they do not conform with the filing requirements provided at 37 CFR § 2.126.

³ It is also noted that as part of its "answer" filed on June 1, 2005, respondent attached at the end a "motion to dismiss". That motion is denied as untimely, in that an answer is of record, and it does not state any grounds upon which relief can be granted.

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documents in support of respondent's case should more appropriately have been provided to opposing counsel through discovery, with confidential materials being provided after agreement had been reached on how these materials would be kept confidential, and finally as evidence during its trial period.

To maintain confidentiality of its documents, and to exchange confidential information, respondent needs only to sign the protective agreement suggested by the Board, or as agreed to between the parties, and, in this case, as modified by petitioner. Through the various iterations of petitioner's proposed protective agreement, the Board finds that the one provided as an attachment to petitioner's November 17, 2005 filing is sufficient to cover all respondent's concerns about disclosure to petitioner's employees, as it contains an "attorney's eyes only" category. Accordingly, the Board hereby enters the November 17, 2005 copy of the protective order and it hereby governs the disclosure of information in this proceeding.⁴ It is noted, however, that since respondent is not represented by counsel, petitioner may withhold any trade secret

⁴ While petitioner argues that respondent "has not demonstrated any entitlement to a protective order" such is not necessary in Board proceedings. It is recognized that parties routinely seek to keep certain business information confidential, and by classifying that material according to an agreement allows for the discovery of information necessary to proving a party's case.

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information it reasonably believes would be damaging in the hands of a competitor.⁵ Respondent, on the other hand, must disclose such information to opposing counsel as it will be protected as "attorney's eyes only" and not be given to petitioner's employees.

In light of the foregoing, respondent has thirty days to sign petitioner's protective agreement and provide a copy to petitioner⁶. Additionally, due to respondent's lack of information regarding proceedings herein, the items submitted to the public record with its answer will be maintained by the Board as confidential, but defendant is advised to refer to the Trademark Trial and Appeal Board's Manual of Procedure (TBMP), section 412.04 for the procedure for future confidential filings.⁷ However, respondent has thirty days to advise opposing counsel as to the classification of these documents pursuant to the protective agreement so petitioner knows how to handle such documents.

⁵ If petitioner has any responsive trade secret information that it will withhold as a result of respondent's pro se status, it should simply identify such documents on a list, in response to a proper discovery request. This procedure applies to all responsive discovery items unless and until respondent obtains outside counsel, at which point such information would need to be provided to opposing counsel.

⁶ Although respondent is being required to sign a copy of the protective agreement, it still governs these proceedings in light of this order.

⁷ The TBMP is available on line at: www.uspto.gov

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Respondent is further encouraged to seek counsel to represent it.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

Both parties are advised to provide an appropriate caption in all future filings with the Board to insure proper association of all papers with their proceeding. See TBMP Chapters 100 and 300.

Proceedings are resumed and discovery and trial dates are reset as indicated below.

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|--|-------------------|
| Discovery period to close: | 5/15/2006 |
| 30-day testimony period for party in position of plaintiff to close: | 8/13/2006 |
| 30-day testimony period for party in position of defendant to close: | 10/12/2006 |
| 15-day rebuttal testimony period to close: | 11/26/2006 |

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.

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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.

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