

ESTTA Tracking number: **ESTTA68174**

Filing date: **02/26/2006**

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

Proceeding	92043900
Party	Defendant DIE GEM CO., INC., THE DIE GEM CO., INC., THE P.O. BOX 8033 MAPLE VALLEY STATION AKRON, OH 44320
Correspondence Address	THE DIE GEM CO., INC. P.O. BOX 8033, MAPLE VALLEY STATION AKRON, OH 44320
Submission	Other Motions/Papers
Filer's Name	Jame R Adams
Filer's e-mail	JRA@die-gem.com
Signature	/James R Adams/
Date	02/26/2006
Attachments	Prov for Prot Agree0001Email.pdf ( 8 pages ) 2252006 WhittcarEmail.pdf ( 2 pages ) Acknow of Ord 2252005Email.pdf ( 1 page ) PkigLstTradeSecret92043900Email.pdf ( 1 page )

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 23313-1451

November 16, 2005

Petitioner: Omnova Solutions, Inc.  
175 Ghent Road  
Fairlawn, OH 44333-3300

V.

Respondent: The Die-Gem Co., Inc.  
One The Die-Gem Way  
Akron, OH 44312-1539

**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, the parties have agreed to be bound by the terms of this order, in its standard form as modified by agreement. As used in this order, the term "information" covers both oral testimony and documentary material.

The Parties 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. The terms are binding from the date the parties or their attorneys sign the order.

**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 or disclosure even as to the parties and/or their attorneys.

**Trade Secret/Commercially Sensitive**-Material to be shielded by the Board from public access or disclosure, 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 other than through discovery processes; or (e) is disclosed by a non-designating party with the written 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 which designated the information as protected. Notification must be personally served or forwarded by any trackable mail or courier service, 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, except for exhibits that previously were designated and stamped as protected.

### **9) Filing Notices of Reliance.**

Whether or not 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 affected 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.

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.**

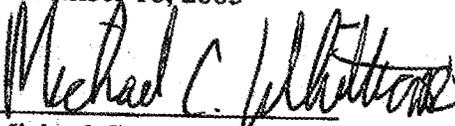
The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

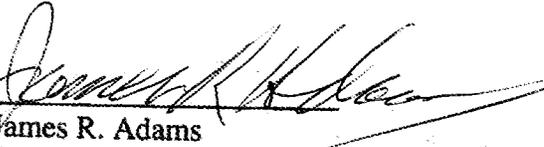
The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed 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.**

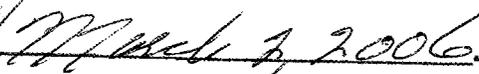
This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided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

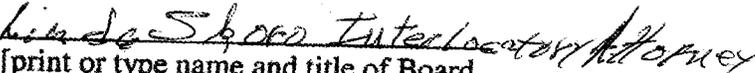
By Agreement of the Following, effective  
November 16, 2005

  
Michael C. Whitticar  
Attorney for Plaintiff  
Jagtiani + Guttag

  
James R. Adams  
President  
The Die-Gem Co., Inc.

By Order of the Board, effective

  
November 7, 2006.

  
[print or type name and title of Board  
Attorney or judge imposing order]

Proceeding 92043900 OMNOVA Solutions Inc. Vs The Die-Gem Co., Inc.

2/24/2006

Mr. Michael C Whitticar Partner  
Jagtiani + Guttag  
10363-A Democracy Lane  
Fairfax, Va. 22030

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RE: Signed Protective Agreement, Part of Answer to Cancellation marked  
Trade Secret Answer to Cancellation 92043900

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Dear Mr. Whitticar:

By order of the Trademark Trial and Appeal Board The Die-Gem Co., Inc. is required to sign the protective agreement dated November 16, 2005 and signed by Michael C Whitticar of Jagtiani + Guttag, representative for OMNOVA Solutions Inc.

By opening, the contents of the attached CD marked Trade Secret Answer to Cancellation 92043900 you agree to the following;

1. As the Representative of OMNOVA Solutions Inc. you agree to control the "attorney eyes only" contents and dissemination of the trade secret information to Jagtiani + Guttag and withhold to all others except those others that The Die-Gem Co. Inc. agrees to in writing.
2. All information provided to you in this proceeding will be returned to The Die-Gem Co., Inc. within 30 days of the termination of this proceeding.

Protective Agreement:

Please be advised that the protective agreement signed by Michael C Whitticar and forwarded to The Die-Gem Co., Inc. is missing a page as noted by the page numbering system used in the agreement and a page referenced in paragraph 4) Disclosure to Any Individual, page 4 of 8 is also missing.

The following pages have been added to the protective agreement dated November 16, 2005. The Die-Gem Co., Inc. has downloaded a document from the (proceeding 92043900) Trademark Trial and Appeal Board Inquiry System and attached a copy with the same page number, page 7-8. A form for access by others to protected information has also been attached.

The protective agreement dated November 16, 2005 has been amended as described here in and is agreed to by The Die-Gem Co., Inc.

James R Adams  
President  
The Die-Gem Co., Inc.  
P O 8033  
Akron OH 44320

Petitioner OMNOVA Solutions Inc. Vs Respondent The Die-Gem Co., Inc  
92043900

#### Certification

I certify that on the 25<sup>th</sup> day of February 2006 that the protected agreement and protected documents by order of the Trademark Trial and Appeal Board were served by FedEx and addressed to the representative of OMNOVA Solutions Inc. at:

Mr. Michael C Whitticar  
Jagtiani + Guttag  
10363-A Democracy Lane  
Fairfax, Va. 22030

James R Adams  
President, The Die-Gem Co., Inc., P O B8033, Akron OH 44320

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

-----  
Plaintiff OMNOVA Solutions Inc.

v.

Cancellation No 92043900

Defendant The Die-Gem Co., Inc.  
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**ACKNOWLEDGMENT OF  
ORDER PROTECTING  
CONFIDENTIALITY OF INFORMATION  
REVEALED DURING BOARD PROCEEDINGS**

I \_\_\_\_\_ (print name), declare that I have been provided with copy of the Order regarding the disclosure of, and protection of certain types of information and documents during and after the above-captioned cancellation proceeding before the Trademark Trail and Appeal Board.

I have read the 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)

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(print title, if applicable)

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(date)

Proceeding 92043900 Petitioner, OMNOVA Solutions Inc., V. Defendant,  
The Die-Gem Co., Inc

## Packing List of Trade Secret Documents

Letter to Michael C Whitticar Partner Jagtiani + Gutttag print date  
2/25/2006 RE: Signed Protective Agreement, Part of Answer to  
Cancellation marked Trade Secret Answer to Cancellation 92043900

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Printed Signed Amended Protective Agreement,

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ON CD marked Trade Secret Answer to Cancellation 92043900

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Answer to Cancellation Page 20 through 24 Marked Trade Secret

Exhibit # 5 Marked Trade Secret

Exhibit # 6 Marked Trade Secret

Exhibit # 7 Marked Trade Secret

Exhibit # 8 Marked Trade Secret