**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
**2900 Crystal Drive**
**Arlington, Virginia 22202-3513**

Greenbaum

Mailed: September 4, 2002

Opposition No. 121,151

AMERICAN HONDA MOTOR CO., INC.

v.

TBC CORPORATION

Before Seeherman, Walters and Bucher, Administrative Trademark Judges.

By the Board:

On March 11, 2002, the Board granted as uncontested applicant's motion to compel, and ordered applicant to provide discovery responses without objection and within 30 days. Opposer responded to applicant's discovery requests, but applicant considers the responses deficient and in disregard of the March 11, 2002 Board order; thus, applicant has moved for entry of sanctions against opposer, in the form of entry of judgment. The parties have fully briefed the issues.

As an initial point, inasmuch as opposer served the ordered responses, rather than failing to respond at all, opposer is not subject to the sanction of entry of judgment under Trademark Rule 2.120(g), and applicant's request for

entry of judgment is denied. *See No Fear v. Rule*, 54 USPQ2d 1551 (TTAB 2000). However, we have construed applicant's motion for sanctions as seeking, in the alternative, an order compelling opposer to provide proper responses to applicant's discovery requests and the imposition of any appropriate lesser sanction. *Id.*

Applicant has three main complaints with opposer's responses. First, applicant views opposer's assertion that opposer may shield privileged or confidential documents and information from production as a violation of the Board's direction that opposer provide responses without objection. Second, applicant complains that opposer's responses do not include a dated and executed certificate of service. On a related matter, applicant complains that opposer did not sign its interrogatory responses. Third, applicant complains that opposer has produced no documents, and that opposer states that it will produce only "available" documents. Applicant interprets the latter statement as an impermissible objection that the associated requests are overly broad and/or unduly burdensome.

We turn first to opposer's assertion of privilege. We note that it is within the Board's discretion to hold, as the Board did here, that a party that does not contest a motion to compel has waived its right to object when responding to discovery requests. However, the Board will

not specifically delineate the grounds for objection that the responding party may raise. *See No Fear v. Rule, supra*, 54 USPQ at 1554. Thus, while opposer may not object to applicant's discovery requests on their merits, opposer has not waived the right to object to a discovery request that opposer believes seeks trade secret, business-sensitive or otherwise confidential information, or information that is subject to attorney-client or a similar privilege, or information that comprises attorney work product.[1] *Id.* at 1554.

We turn next to applicant's second complaint. Inasmuch as opposer attached to its response to the instant motion copies of dated and executed certificates of service pertaining to opposer's written discovery responses, applicant's second complaint is moot. However, because interrogatory responses must be verified, if opposer still has not served signed interrogatory responses, opposer has until THIRTY DAYS from the mailing date of this order to do so, failing which the Board may entertain a motion for sanctions under Trademark Rule 2.120(g).

[1] The Board published a standard protective order that may be imposed in an appropriate situation. See Official Gazette Notice of June 20, 2000. To obviate any further delays by opposer based on allegedly privileged, confidential or otherwise sensitive documents and information, we hereby impose the standard Board protective order attached hereto. As the parties can see from the terms of the agreement, they are free to agree to modifications or seek modifications by motion to the Board.

Additionally, as applicant states in a footnote, applicant's requests for admission stand admitted by operation of Fed. R. Civ. P. 36(a) due to opposer's failure to timely respond thereto. However, we construe opposer's responses to the requests for admission as opposer's request that the admissions be withdrawn and superceded by the actual responses. We grant opposer's request to withdraw the admissions because doing so will allow the Board to decide the case based on its merits, and because applicant has failed to identify any legally cognizable prejudice that would arise from withdrawal of opposer's admissions. *See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.,* 14 USPQ2d 2064 (TTAB 1990); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.,* 13 USPQ2d 1719 (TTAB 1989); and TBMP §§ 411.01 and 525 and cases cited therein.

In view thereof, opposer's admissions are withdrawn, and opposer's responses to the requests for admission, served on applicant on April 10, 2002, are now in effect.

Finally, we turn to applicant's third objection. Opposer's responses that it will produce "documents, if any," "available documents," "available documents, if any" and "non-privileged documents, if any" are plainly improper. As the Board noted in *No Fear v. Rule,* supra, 54 USPQ at 1555, opposer was "obligated to respond to each request, and a proper response requires either stating that there are

responsive documents and they will be produced or withheld on a claim of privilege or stating that [opposer] has no responsive documents," (citations omitted). In addition, opposer's responses "suggest that [opposer] has not actually searched for responsive documents and, therefore, has no idea whether there are documents responsive to particular requests for production." *Id.,* 54 USPQ2d at 1556.

In view of the foregoing, opposer is ordered to provide substitute, proper responses to each of applicant's document requests within THIRTY DAYS of the mailing date of this order. Moreover, as a sanction, opposer is directed to copy responsive documents and forward them to applicant at opposer's expense.

Trial dates, including the close of discovery, are reset as follows:

| | |
|---|---|
| DISCOVERY PERIOD TO CLOSE: | **December 15, 2002** |
| Testimony period for party in position of plaintiff to close: | **March 15, 2003** |
| Testimony period for party in position of defendant to close: | **May 14, 2003** |
| Rebuttal testimony period to close: | **June 28, 2003** |

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.l25.

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.l29.

| | | |
|---|---|---|
| **AMERICAN HONDA MOTOR CO., INC.** | : | |
| | : | Opposition |
| v. | : | No. 121,151 |
| **TBC CORPORATION** | : | |

**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.[2] 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**

[2] There may be a remedy at court for any breach of contract that occurs after the conclusion of this Board proceeding. *See* Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552, 1555 (TTAB 1987). *See also*, Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

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 confidential or highly confidential 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 trade secret/commercially sensitive 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 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 relevant portions of 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 Judgment.**

The Board's jurisdiction over the parties and their attorneys ends with the entry of a final judgment, unless jurisdiction is restored by grant of a post-judgment motion or as the result of an appellate proceeding. After entry of judgment, the parties' handling of protected information and materials is governed only by any agreements to which the parties may agree.

**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 Order of the Board, effective** SEPTEMBER 3, 2002.

Cindy B. Greenbaum,
Interlocutory Attorney,
Trademark Trial and Appeal Board
[print or type name and title of Board attorney
or judge imposing order]

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

| | | |
|---|---|---|
| **AMERICAN HONDA MOTOR CO., INC.** | : | |
| | : | Opposition |
| v. | : | No. 121,151 |
| **TBC CORPORATION** | : | |

**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]