United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Taylor

Mailed: February 28, 2005

Opposition No. 91158240

United Industries Corporation

v.

OMS Investments, Inc.

Jyll S. Taylor, Attorney:

This case now comes up for consideration of opposer's motion, filed November 15, 2004, to extend the testimony periods by ninety days. Although captioned as a stipulated motion, opposer does not assert applicant's consent to the extension. Rather, opposer contends that the requested extension is needed to allow opposer time to review applicant's eleven-page proposed protective order and to negotiate a protective agreement acceptable to both parties. Opposer further contends that upon entry of a acceptable protective order, applicant will complete its responses to discovery "in order for Opposer to go into the testimony period."

In response, applicant states that it did not consent to opposer's motion to extend; that the motion is falsely captioned; and that the body of the motion contains a

statement of the reason for which extension is sought that is misleading. Applicant argues that good cause does not exist for the requested extension. More specifically, applicant argues that by the close of discovery, each party had served discovery requests on the other; that as certain discovery requested of the other sought information subject to confidential and/or trade secret protection, the parties agreed to stipulations of the trial schedule in this case; that the most recent stipulated extension reset opposer's testimony to close on November 12, 2004; and that no testimony has been taken by opposer.

Applicant further explains that it sent a proposed draft protective agreement to opposer on September 14, 2004; that in an October 11, 2004 telephone call to opposer's counsel, opposer's counsel said her clerk filed the draft order away without showing it to her, but she would now retrieve it and discuss it with opposer; that applicant's counsel heard nothing until November 11, when opposer's counsel left a voice mail stating that the file had been "set aside" and the order never forwarded to opposer and that she intended to move for an extension as consented to unless counsel for applicant informed her otherwise.

Applicant further argues that opposer's statement that the extension was being requested to allow opposer time to review the proposed protective order "glossed over" the fact

that twice in the eight weeks since counsel provided the draft order to counsel for opposer, counsel for opposer either mislaid or neglected to provide it to applicant; that such inattention evinces either neglect or lack of care on the part of opposer as to the outcome of this proceeding; and that in light of the lack of care by opposer, and opposer's incomplete and conclusory assertions concerning the reason it seeks an extension, when balanced against the prejudice to applicant of a continuing delay in the registration of its mark, opposer's motion for extension should be denied.

Applicant also argues that with the denial of opposer's motion, opposer's time to take testimony in this proceeding will have expired, and opposer has failed to take testimony or file any material in support of its case. Applicant therefore moves pursuant to 37 C.F.R. § 2.132(a) to dismiss this proceeding for opposer's failure to prove its case.

In reply, opposer states that it regrets the inadvertent mistitling of its motion and asserts that the substance of the motion did not state there was consent. Opposer further explains that its motion to extend did not reflect the fact that the reason for the previous two extensions were due to applicant's failure to provide the protective order until September 14, 2004; that applicant granted opposer a three-week delay in responding to

discovery only to learn when the discovery was received that it would not answer unless a protective order was entered into; that opposer's motion was based on the fact that the parties were attempting to move forward with the discovery issues and that the motion was stated in a neutral manner, rather than to allocate "blame"; that on November 16, 2004, and before receiving applicant's motions, opposer responded to applicant's protective order with one minor change requested, but applicant did not respond to this communication; and that opposer's response to the protective order demonstrates its good faith and diligence to resolve the discovery issues in order to move forward with the opposition.

Opposer further argues that applicant's motion for judgment is "disingenuous" in light of the fact that part of the delays in this case were a result in applicant's failure to respond promptly to discovery, and when it did, to provide the protective order it believed was needed to fully respond to discovery; and that opposer was unable to proceed with testimony since it did not have the discovery responses from applicant. Opposer therefore contends that it has shown sufficient cause for not proceeding with its testimony.

For those reasons, opposer maintains that its motion to extend should be granted and opposer's motion for judgment be denied.

Opposer, in a caption to a paragraph, also requested that this proceeding be suspended pending the completion of discovery.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Civ. P. 6(b) and TBMP §509. The Board generally is liberal in granting extensions of time so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See, e.g., American Vitamin Products Inc., v. DowBrands Inc*., 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985).

After a review of the parties' arguments, the Board finds that opposer has shown sufficient cause, albeit barely, for the requested extension. More particularly, opposer has pointed to, and applicant has acknowledged, the parties' attempts at completing discovery with the entry of a protective agreement. Indeed, there was delay by both parties during this process and the previous grants of extension were on consent and apparently made in an effort to facilitate the completion of an acceptable protective agreement and the exchange of discovery responses. As such,

the Board does not find that opposer has abused its privilege of extensions. Additionally, applicant points to no prejudice to it, beyond delay and the Board finds that the delay in this proceeding can be attributed to both parties. Last, although there appears to have been some docketing problems in opposer's counsel's office, the evidence does not show that the problems were the result of negligence or bad faith by opposer.

In view of the foregoing, opposer's motion to extend the testimony periods is granted.[1] Opposer should note that the Board will not approve further extensions of its testimony period, in the absence of an agreement by the parties or a showing of unanticipated, extraordinary circumstances. Additionally, opposer's "motion" to suspend is denied. The Board has allowed ample time for the parties to complete discovery prior to the opening of opposer's testimony period, as reset below.

To facilitate the exchange of responses to outstanding discovery requests and to alleviate further delay of this case due to the parties apparent lack of an acceptable protective agreement, the standard Board protective agreement is hereby imposed, and an executed order is attached to each party's copy of this order. The parties

[1] Consequently, applicant's motion for judgment pursuant to Trademark Rule 2.132 is premature and will be given no consideration.

are allowed until **thirty days** from the mailing date of this order to serve responses to any outstanding discovery requests.

Finally, trial dates are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	June 15, 2005
30-day testimony period for party in position of defendant to close:	August 14, 2005
15-day rebuttal testimony period to close:	September 28, 2005

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. Rule 2.l25.

Briefs shall be filed in accordance with Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.l29.

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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

[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.,

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.

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4 USPQ2d 1552, 1555 (TTAB 1987). *See also*, Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

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

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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 _____.
[insert signature date]

_____	_____
[print or type name and title of individual signing for plaintiff]	[print or type name and title of individual signing for defendant]
_____	_____
[print or type name and law firm of attorney for plaintiff]	[print or type name and law firm of attorney for defendant]

By Order of the Board, effective March 14, 2005

___/jstaylor/_____
Jyll S. Taylor