

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

Mailed: October 4, 2005

Opposition No. **91159046**

NCE RESOURCES GROUP INC.

v.

RESMARK EQUITY PARTNERS, LLC

Peter Cataldo, Interlocutory Attorney

This case now comes before the Board for consideration of opposer's motion to compel, to test the sufficiency of applicant's responses to admission requests, and to allow opposer additional time in which to serve follow-up discovery.¹ Applicant filed an untimely brief in response thereto along with a cross-motion to reopen discovery. See Trademark Rule 2.127(a). Nonetheless, in order to come to a more complete determination of the parties' discovery dispute, the Board will exercise its discretion to consider applicant's untimely response.² In addition, opposer filed

¹ Opposer's motion to suspend the instant proceeding pending the Board's disposition of the foregoing was granted in a Board order issued on July 26, 2005.

² Accordingly, opposer's motion to strike applicant's response and cross-motion is denied. Further, opposer's request that the Board order applicant to aver that its discovery responses were mailed on the date asserted therein will be given no consideration. However, applicant is reminded that failure to adhere to applicable rules of procedure and deadlines in this proceeding may result in such matters being decided by default.

a reply brief which the Board has entertained.³

The Board has carefully considered the arguments of both parties with regard to the above motions. However, an exhaustive review of those arguments would only serve to delay the Board's disposition of these matters.

Motion to Compel

The Board turns to opposer's motion to compel.⁴ In this instance, the Board finds that the motion to compel fails to comply with the special requirements of Trademark Rule 2.120(e) which provides, in part, as follows:

The motion shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement.

See Trademark Rule 2.120(e). See also *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); and

³ Consideration of reply briefs is discretionary on the part of the Board. See Trademark Rule 2.127(a).

⁴ As a preliminary matter, the motion is timely inasmuch as it was filed prior to the opening of opposer's first testimony period. See Trademark Rule 2.120(e).

Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979).

In this case, opposer fails to state in its motion to compel that its counsel has made a good faith effort to resolve with applicant's attorney the instant discovery dispute and has been unable to reach agreement. In addition, opposer fails to include with its motion to compel copies of either the discovery responses at issue or its second and third "meet and confer letters" referenced therein.⁵ As such, opposer's motion to compel is procedurally defective.

On the other hand, the Board finds that by making the blanket assertion that all of opposer's discovery requests are "overly broad, burdensome and harassing, are outside the scope of the issue here and not submitted in good faith," applicant has disregarded its discovery obligations in this proceeding.

It is clear from the total number of discovery requests in dispute that the parties have failed to make a substantial effort to resolve by agreement the issues raised in opposer's motion to compel. See Trademark Rule 2.120. At least some of the problems herein should be resolved without Board intervention, and the Board suggests that the

⁵ It is noted that opposer enclosed the referenced discovery responses and "meet and confer letters" with its reply brief.

parties make a greater effort to avoid or resolve such controversies.

In view of the foregoing, opposer's motion to compel is denied without prejudice.

Motion to Test Sufficiency of Admissions

With regard to opposer's motion to test the sufficiency of applicant's responses to its admission requests, the Board again finds that opposer has not satisfied the special requirements of Trademark Rule 2.120(h), which provides, in part, as follows:

The motion shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement.

See Trademark Rule 2.120(h).

In this case, opposer fails to include either the required statement concerning its good faith effort to resolve the issues under consideration or a copy of applicant's answers to its admission requests. As such, opposer's motion to test the sufficiency of applicant's admission responses is procedurally defective. In addition, the Board again finds that applicant's blanket objections to opposer's admission requests indicate that applicant has disregarded its discovery obligations in this proceeding.

In view of the foregoing, and in accordance with the above analysis regarding opposer's motion to compel, opposer's motion to test the sufficiency of applicant's answers to its admission requests is denied without prejudice.

Motion to Extend Time for Opposer's Follow-Up Discovery

Based upon the showing made therein, opposer's motion for additional time in which to conduct follow-up discovery is granted to the extent that the close of the discovery period is reset at the end of this order.⁶

In view thereof, applicant's cross-motion to reopen discovery is moot.

Discovery Reminders

The parties are reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints.⁷ To this end, both parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986), and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved

⁶ Opposer's request that discovery be extended solely for opposer is denied.

⁷ The parties are directed to carefully review TBMP §414 (2d ed. rev. 2004) for the discoverability of a variety of matters of relevance to this proceeding.

in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

The parties are directed to work together to resolve their discovery problems, in the spirit of good faith and cooperation which is required of all litigants in Board proceedings.

The parties are reminded of their duty to supplement discovery responses in proceedings before the Board in accordance with Fed. R. Civ. P. 26(e)(2). See Trademark Rule 2.116(a), and "*Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings*," 1159 TMOG 14 (February 1, 1994). Under that rule, a party which has responded to a request for discovery with a response is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2).

The parties are cautioned that if proper discoverable matter is withheld during discovery, the withholding party may be precluded from relying on such information and from adducing testimony with regard thereto during its testimony period. See *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980); and *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, at fn.5 (TTAB 1988).

Protective Order

The Board published in the Official Gazette of June 20, 2000 a standard protective order that may be imposed in an appropriate situation. In order to facilitate the orderly completion of discovery in this proceeding, it is adjudged appropriate for the standard Board protective order to be imposed herein, and accordingly, an executed order is attached.

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of Trademark Rule 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Dates Reset

Trial dates, beginning with the close of discovery, are reset as indicated below. The parties are allowed thirty days from the mailing date of this order in which to serve responses to any outstanding discovery requests.⁸

Discovery period to close: January 31, 2006

Testimony period for party in
position of plaintiff to close: May 1, 2006
(open for thirty days)

Testimony period for party in
position of defendant to close: June 30, 2006
(open for thirty days)

Rebuttal testimony period to close: August 14, 2006
(open for fifteen days)

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.

⁸ The parties must note that this is not an order compelling discovery. A party seeking an order compelling discovery must file a motion to compel in accordance with Trademark Rule 2.120(e). Thus, the Board will not entertain a motion for discovery sanctions under Trademark Rule 2.120(g) based upon a party's failure to comply with the above provision.

NCE Resources Group Inc.

v.

Resmark Equity Partners, LLC

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Opposition No. 91159046

**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.⁹ 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.

⁹ 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).

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 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 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 September 30, 2005

**/Peter Cataldo/
Interlocutory Attorney**

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

NCE Resources Group Inc.	:	
	:	
v.	:	Opposition No. 91159046
	:	
Resmark Equity Partners, LLC	:	
	:	

**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]