

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

Mailed: June 29, 2006

Opposition No. 91166949

Target Training International,
Inc.

v.

Totally Coached, Inc.

Cheryl Goodman, Interlocutory Attorney:

This case now comes up on opposer's motion to compel, filed, February 16, 2006, and applicant's motion to strike or alternative motion to extend time to respond to the motion to compel, filed March 7, 2006.

Turning first to the motion to strike or to extend, applicant argues that the motion to compel should be stricken due to opposer's failure to serve a copy on applicant. Alternatively, applicant seeks an extension of time to respond to the motion.

In response to the motion to strike, opposer admits that an oversight by clerical staff resulted in the failure of its motion to be served on applicant; and that it has no objections to extending applicant's time to respond to its motion.

The Board finds good cause for the extension request. Accordingly, applicant's motion to extend is granted and

applicant's response thereto is timely. In view thereof, applicant's motion to strike is moot.

We turn next to the motion to compel. Opposer seeks better responses to Interrogatory nos. 6, 7, 9-14 and Document Request nos. 4-9 and 11-21, advising that it made a good faith effort to resolve the discovery dispute.

In response, applicant advises it has supplemented discovery responses and the motion to compel should be denied.

It is unclear to the Board whether opposer finds these supplemental responses acceptable because it has not filed a reply pointing to particular deficiencies in applicant's supplemental responses.

Nevertheless, in the interests of expediency and to forestall further motions on these matters, the Board will consider whether applicant's supplemental discovery responses are sufficient.

Interrogatory nos. 6, 7 and 9(a) and Document Request nos. 4, 5, 6, 7, 17 and 19

The Board finds applicant's supplemental responses to these requests sufficient and applicant need not provide a further response. Accordingly, opposer's motion to compel is denied with respect to these requests.

Interrogatory no. 9(b)-(c)

Information regarding applicant's first use is discoverable; therefore, to the extent that opposer seeks information regarding applicant's first customer (singular),

applicant's objections are overruled. See TBMP Section 414(3) and 414(5) (2d ed. rev. 2004) (name of first customer is discoverable; information regarding first use is discoverable). Accordingly, opposer's motion to compel is granted to the extent that applicant must provide any receipts, the name, and any agreements with regard to its *first customer* (singular) that establishes its first use of the involved mark. If any of these documents do not exist, applicant should so state.

Interrogatory nos. 10, 11 and 12

Applicant's objection to these discovery requests is sustained. These discovery requests seek specific customer information, and the names of customers are confidential and, generally, not discoverable even under protective order. See TBMP Section 414(3). Accordingly, opposer's motion to compel is denied as to this request.

Interrogatory no. 13¹

To the extent that this interrogatory seeks the names of applicant's customers, applicant's objection is sustained. To the extent this discovery request seeks information regarding applicant's knowledge of third party users of the INTRINSIC COACH mark, applicant's objection is overruled. Accordingly, opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY

¹ Applicant did not submit its supplemental responses to interrogatory nos. 13 and 14. Therefore, the Board will consider applicant's objections and original responses to these requests.

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DAYS from the mailing date of this order to provide information regarding its knowledge of use of the INTRINSIC COACH mark by parties other than applicant's customers.

Interrogatory no. 14

To the extent this interrogatory seeks the names of applicant's customers, applicant's objection is sustained. To the extent this discovery request seeks the geographic location of applicant's customers, applicant's objections are overruled. See TBMP Section 414(16). Accordingly, opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide the general geographic location of customers who have used applicant's mark.

Document Request nos. 8 and 9

Applicant's objections to these document requests are overruled. Consumer identity and strength of applicant's mark are relevant, and applicant has not met its burden in establishing that these discovery requests are overbroad or burdensome. In view thereof, opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to serve responses to these document requests.

Document Request no. 11

Applicant's supplemental response appears incomplete in that none of the referenced documents relate to advertising

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expenditures. Accordingly, opposer's motion to compel is granted to the extent that applicant must provide responsive documents relating to its costs of advertising, marketing, display and promotion, to the extent it has not already done so, within THIRTY DAYS of the mailing date of this order. Such disclosure may be made under a protective order.

Document Request No. 12 and No. 15

Applicant's objections to these document requests are overruled. Applicant's use of its mark in connection with its services is relevant. *See e.g., Double J of Broward Inc. v. Saklony Sportswear GmbH*, 21 USPQ2d 16009, 1613 (TTAB 1991) (use or intended use of applicant's mark in commerce with U.S. is relevant).

Accordingly, opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide a representative sample of its advertising and promotional material used in connection with its products and services and to provide all documents referring or relating to the media through which applicant has promoted its goods and services.

Document Request No. 13

Applicant's relevance objection is sustained and opposer's motion to compel is denied as to this request. *See Neville Chemical Company v. The Lubrizol Corporation*, 183 USPQ 184, 189 (TTAB 1974) (correspondence between opposer and advertising agency not relevant to issue of likelihood of confusion).

Document Request no. 14

Applicant's objections to this discovery request are overruled. See TBMP Section 414(15). Opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide a substantive response to this document request.

Document Request no. 16

To the extent this request seeks documents which specifically identify applicant's customers, applicant's objection is sustained. To the extent that this request seeks documents which refer to a class of customers, applicant's objections are overruled. See TBMP Section 414(3). Accordingly, opposer's motion to compel is granted to the extent that applicant is allowed until THIRTY DAYS from the mailing date of this order to provide any documents which relate or refer to the class of customers ("consumers") to which applicant has sold or distributed its products or services.

Document Request no. 18

Applicant's supplemental response to this request indicates that responsive documents relate to the identity of specific customers as the only person(s) who use applicant's mark are subscribers. Accordingly, because opposer has not argued otherwise, the Board concludes that this document request seeks to obtain specific customer

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names and locations, which are generally not discoverable. In view thereof, opposer's motion to compel is denied as to this request. *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618, 621 (TTAB 1974) (the names of applicant's customers are indeed confidential information);

Varian Associates v. Fairfield

Noble Corporation, 188 USPQ 581, 583 (TTAB 1975) the (Board's policy not to require the disclosure of customer and mailing lists) applicant's objection is sustained. See TBMP Section 414(3).

Document Request no. 20

In response to this request, applicant references its response to Interrogatory no. 10 which states, among other things, that applicant's customers are the ones who "sell retail or produce" its services. Because opposer has not argued otherwise, the Board concludes that this document request seeks documents which provide the identity of specific customers who sell, contract or accept applicant's services. Inasmuch as the identity of applicant's customers is generally not discoverable, opposer's motion to compel is denied as to this request. TBMP Section 414(3).

Document Request 21

Applicant's supplemental response is unresponsive to this document request inasmuch as applicant's response does not address whether applicant has documents in its possession that reflect licensing agreements with third

parties. Accordingly, opposer's motion to compel is granted to the extent that applicant should provide any licensing agreements between itself and third parties responsive to this request. If no licensing agreements exist, it should so state.

In summary, opposer's motion to compel is denied as to Interrogatory nos. 6, 7, 9(a), 10, 11 and 12 and Document Request nos. 4, 5, 6, 7, 13, 17, 18, 19, and 20; opposer's motion to compel is granted as to Interrogatory nos. 9(b)-(c), 13 and 14 and Document Request nos. 8, 9, 11, 12, 14, 15, 16, and 21 to the extent indicated above. Applicant is allowed until THIRTY DAYS from the mailing date of this order to supplement its responses to the discovery requests identified above.

Lastly, to facilitate discovery, and because the parties are unable to come to agreement on the handling of confidential matters, the Board hereby imposes the attached standardized protective agreement on the parties. The provisions of the attached agreement now bind the parties.²

Proceedings are resumed.

Discovery and trial dates are reset as follows:

² As the parties can see from the terms of the protective agreement, they are free to agree to modifications or seek modifications by motion to the Board. If the parties wish the terms of the protective agreement to extend beyond the conclusion of this proceeding, the parties should sign the agreement and file a copy thereof with the Board.

DISCOVERY PERIOD TO CLOSE:	September 29, 2006
30-day testimony period for party in position of plaintiff to close:	December 28, 2006
30-day testimony period for party in position of defendant to close:	February 26, 2007
15-day rebuttal testimony period for party in position of plaintiff to close:	April 12, 2007

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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**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 Board hereby orders that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

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 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 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 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 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.

The foregoing provisions are hereby entered as an order of the Board, and shall be effective upon the mailing date indicated above.

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