

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

Lykos

Mailed: December 1, 2006

Cancellation No.92043985

Wella Aktiengesellschaft

v.

Lisane Aesthetics, Inc.

Angela Lykos, Interlocutory Attorney

This case now comes up for consideration of respondent's combined motion filed on April 13, 2006 (1) for an order protecting respondent from responding to petitioner's interrogatories and document production requests served March 31, 2006,¹ and (2) to quash petitioner's notice of deposition of Mr. Zeid Zu'bi (served March 31, 2006) and petitioner's amended notice of deposition and document production (served April 11, 2006). Petitioner filed a responsive brief in opposition thereto on April 25, 2006.

¹ The Board construes respondent's objections to petitioner's written discovery requests simply as a motion for protective order

By way of background, on September 2, 2005, following the filing of several stipulations to extend the discovery and testimony dates for this case, the Board *sua sponte* suspended proceedings to allow the parties to pursue settlement negotiations. The parties' most recent stipulation had been filed on the previous day, and provided for discovery to close on September 15, 2005. Shortly thereafter, on October 6, 2005, respondent filed a motion for summary judgment. On February 24, 2006, the Board, noting that proceedings were suspended "subject to the right of either party to request resumption in any time" determined that respondent's motion for summary judgment was properly filed and gave the motion full consideration on the merits. In that same order, the Board denied the motion, and reset the discovery and testimony periods for this case, with discovery re-scheduled to close May 1, 2006. Subsequent thereto, respondent filed the motion which is the subject of this order.

I. *Respondent's Motion for Protective Order*

Respondent argues that because it had voluntarily provided to petitioner documentation regarding use of its registered mark prior to suspension of the case, it should not be required to respond to petitioner's written discovery requests. Respondent also contends that the Board, when it resumed proceedings on February 24, 2006 after denying the

motion for summary judgment, improperly extended the close of discovery to May 1, 2006. Respondent further asserts that since petitioner had not previously sought formal discovery prior thereto, petitioner should not be afforded another opportunity to take discovery.

In response thereto, petitioner contends that no "unfairness" exists in permitting petitioner to pursue discovery that it earlier did not pursue.

In Board proceedings, motions for a protective order are governed by Trademark Rule 2.120(f) which provides as follows:

Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party provide or permit discovery.

It is generally inappropriate for a party to respond to requests for discovery by filing a motion for protective order.

Respondent has not claimed that it has suffered "annoyance, embarrassment, oppression, or undue burden or expense" from the service of petitioner's written discovery requests. Rather, respondent objects to petitioner's

written discovery requests on the grounds of fairness. Such a reason does not warrant the imposition of a protection order. The Board exercised its discretion to extend the close of discovery to May 1, 2006 when it denied petitioner's motion for summary judgment. Petitioner's service of discovery requests on March 28, 2006 therefore took place within the permissible time period for discovery. Moreover, respondent's voluntary production of documentation regarding the use of its mark does not in any way preclude petitioner from formally serving respondent with discovery requests.

Accordingly, respondent's motion for protective order is denied.

II. *Respondent's Motion to Quash*

We now turn to respondent's motion to quash. Respondent moves to quash the deposition on the grounds of insufficient notice. Specifically, respondent notes that Mr. Zeid Zu'bi was personally served on March 31, 2006 for a deposition was scheduled to take place on April 17, 2006.²

Petitioner contends that contrary to respondent's assertions, respondent received sufficient notice of the

² Respondent also contends that the notice of deposition was improperly served on Mr. Zeid Zu'bi instead of counsel for respondent since "Mr. Zeid Zu'bi is a party to this case." Respondent did not submit copies of the notice and amended notice of deposition with its motion. The Board can only assume that Mr. Zu'bi was noticed as a Rule 30(b)(6) witness, and named in

the notice as the person to be deposed. As such, personal service on Mr. Zu'bi was entirely proper.

deposition of Mr. Zeid Zu'bi.

A motion to quash may be filed on a variety of grounds, including but not limited to situations in which: (1) the proposed deposition is untimely (see *Marshall Field & Co. v. Mrs. Field's Cookies*, 17 USPQ2d 1652 (TTAB 1990), and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372 (TTAB 1978)); (2) the proposed deposition constitutes harassment (see *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); or (3) the proposed deposition was not properly or reasonably noticed (see 37 CFR §§ 2.123(c); Fed. R. Civ. P. 30(b); and TBMP §§ 404.04 and 521). A party need only provide reasonable notice for its depositions. See Trademark Rule 2.133(c).

In this case, the Board finds petitioner's eighteen-day notice of deposition as reasonable. Indeed, the Board has previously determined that three days written notice for a deposition is not unreasonable and the Board does not usually distinguish between calendar days and business days. See *Duke University v. Haggart Clothing Co.*, 54 USPQ2d 1443 (TTAB 2000); see also *Hamilton Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 804 n.6 (TTAB 1982) (two day notice was not unreasonable)

Accordingly, respondent's motion to quash is denied.³

³ The Board further notes that petitioner's motion for sanctions is premature and as such, has been given no consideration.

In view the foregoing, the Board hereby orders the following: (1) the parties are ordered to reach an agreement on the date for the discovery deposition of Mr. Zubi to take place. The deposition must take place no later than **TWENTY (20) DAYS** from the mailing date of this order; and (2) respondent is ordered to respond to petitioner's interrogatories and document production requests served March 31, 2006, in full and without objections, **TWENTY (20) DAYS** from the mailing date of this order.⁴

In the interest of facilitating the discovery process in this proceeding, the Board is hereby imposing the attached standardized protective order on the parties to govern the disclosure of confidential information.⁵

Proceedings herein are resumed and trial dates are reset as follows:

| | |
|--|----------|
| THE PERIOD FOR DISCOVERY TO CLOSE: | 12/23/06 |
| 30-day testimony period for party in position of plaintiff to close: | 3/23/07 |
| 30-day testimony period for party in position of defendant to close: | 5/22/07 |

⁴ In the event of noncompliance with the Board's order, petitioner may file a motion for sanctions pursuant to Trademark Rule 2.120(g)(1).

⁵ The Board has promulgated a standardized protective order for the exchange of confidential information and materials. The Board's standardized order may be used as a template upon which to base a more particularized agreement. See 125 TMOG 70 (June 20, 2000).

15-day rebuttal testimony period for
party in position of plaintiff
to close:

7/06/07

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Wella Aktiengesellschaft

v.

Cancellation

No. 92043985

Lisane Aesthetics, Inc.

**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. 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

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.

By Order of the Board, effective December 1, 2006

