

ESTTA Tracking number: **ESTTA189055**

Filing date: **01/28/2008**

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

Proceeding	92047816
Party	Defendant MacDermid Acumen, Inc.
Correspondence Address	Jennifer A. Calcagni Carmody & Torrance LLP 50 Levenworth Street, P.O. Box 1110 Waterbury, CT 06702 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Arthur G. Schaier
Filer's e-mail	aschaier@carmodylaw.com, lfreed@carmodylaw.com, flahnin@carmodylaw.com, jcalcagni@carmodylaw.com
Signature	/Arthur G. Schaier/
Date	01/28/2008
Attachments	macder~1.pdf (11 pages)(368462 bytes)

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

Atotech Deutschland GmbH,

Petitioner,

v.

MacDermid Acumen, Inc.,

Registrant.

Cancellation No.: 92047816

Registration No.: 3,106,449

Mark: TRIBLACK

MOTION FOR PROTECTIVE ORDER

Pursuant to Fed. Rule Civ. Pro. 26(c), the Registrant, MacDermid Acumen, Inc. (“MacDermid”), hereby moves for a protective order with respect to the Deposition Notice dated January 18, 2008, requesting the undersigned registrant appear on Tuesday, January 29, 2008 at 9:00 a.m. at the Law Offices of Frommer Lawrence & Haug, LLP, 745 Fifth Avenue, New York, NY, 10151 (See Exhibit A).

Fed. Rule Civ. Pro. 30(b)(1) requires parties to give each other reasonable notice of taking oral deposition of any person. See Fed.R.Civ.P. 30(b)(1) (“A party desiring to take the deposition of any person upon oral examination shall give reasonable notice in writing to every other party to the action.”). Petitioner Atotech Deutschland GmbH (“Atotech”) sent its Notice of Rule 30(b)(6) Deposition to MacDermid on Friday, January 18, 2008 after 7:00 pm. MacDermid did not receive the Notice until the following Monday, January 21, 2008. Therefore, MacDermid

would have only one week to designate a representative to testify on its behalf and prepare for that testimony.

Fed. Rule Civ. Pro. 26(c)(1) provides that a protective order may issue to protect a party upon whom discovery is sought “from annoyance, embarrassment, oppression, or undue burden or expense.” Here, Atotech attached to its Notice a two-page list of matters about which MacDermid’s representative would be expected to testify.¹ One week is simply not enough time for MacDermid to adequately and carefully prepare for the deposition. Such short notice clearly constitutes an undue burden on MacDermid. Moreover, Atotech improperly seeks to require MacDermid to produce the exact same documents it has sought through written discovery. Specifically, on December 20, 2007, Atotech propounded twenty-five interrogatories and thirty-one requests for productions seeking the same information it seeks by way of its Deposition

¹ MacDermid also objects to Atotech’s Notice of Deposition in that it seeks information that is not only irrelevant but also patently overbroad and unduly burdensome. Specifically, Atotech’s sole basis for seeking the cancellation of MacDermid’s trademark is its alleged first use of the mark CORRO TRIBLACK. Atotech’s request for documents and testimony, however, seek information regarding wholly irrelevant topics. For example, Atotech seeks information regarding the selection process of the mark TRIBLACK, consumer marketing surveys, all media used to advertise goods bearing the TRIBLACK mark, the trade channels for goods bearing the TRIBLACK mark, the intended customers for goods bearing the TRIBLACK mark, the identity of all customers at any time for goods bearing the TRIBLACK mark, all sales information, and information concerning customer confusion. See Exhibit A, ¶¶ 1-7, 10-15, 17-18. The only relevant issue in this cancellation is Atotech’s alleged first use of the mark CORRO TRIBLACK. Therefore, MacDermid objects to Atotech’s attempt to seek information wholly irrelevant to the only ground for its cancellation.

Notice. Instead of waiting for MacDermid's responses to the discovery requests which are due by agreement on February 8, 2008,² Atotech seeks to unduly and unfairly burden MacDermid.

Rule 402.01 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) states each party has a duty "to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding." In addition Rule 402.2 states that "the right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, inter alia, it is unreasonably cumulative or duplicative; or is unduly burdensome or obtainable from some other source that is more convenient, less burdensome, or less expensive... (emphasis added). Here, Atotech, through written discovery, has already asked MacDermid for the information it seeks in its Notice of Deposition. Obtaining information through written discovery is clearly less burdensome and less expensive than requiring a MacDermid representative to appear in New York City and to do so on such short notice.³ Moreover, the information it seeks from MacDermid in its Notice of Deposition is

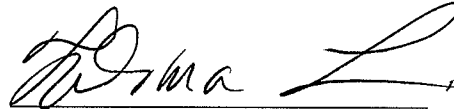
² Atotech's responses to MacDermid's discovery requests were due on January 16, 2008. Atotech sought to extend the time for it to respond to discovery propounded by MacDermid. MacDermid agreed to a two week mutual extension.

³ Pursuant to 37 CFR § 2.120(b) "the deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. ..." Atotech clearly violates this rule by noticing the deposition in New York City where its attorneys are located.

duplicative of the requests it has already propounded on MacDermid.⁴ Therefore, MacDermid respectfully requests that its Motion for a Protective Order be granted.

Respectfully submitted,

MACDERMID ACUMEN, INC.
By its Attorneys,



Fatima Lahnin
Carmody & Torrance LLP
195 Church Street
P.O. Box 1950
New Haven, CT 06509-1950
Telephone: (203) 784-3116
Facsimile: (203) 784-3199

⁴ Atotech's actions in this regard are questionable. Discovery has been open in this case since August 6, 2007. On December 11, 2007, MacDermid propounded discovery requests on Atotech. Nine days later, Atotech propounded its discovery requests on MacDermid. On Monday, January 15, 2008, Atotech sought MacDermid's consent to an extension of one month to respond to its discovery requests which were due on January 16, 2008. Because the discovery period is set to close on February 2, 2008, MacDermid only agreed to a two week mutual extension. Three days after MacDermid agreed to a two week extension for written discovery responses, Atotech sent via e-mail and fax on Friday, January 18, 2008 at 7:10 pm its Rule 30(b)(6) Notice of Deposition. Notably, MacDermid's responses to written discovery, which are duplicative of the information it seeks in its Notice of Deposition, are due after Atotech's responses to MacDermid's discovery requests. Atotech noticed MacDermid's deposition for a date and time that was both before the due date for MacDermid's written responses and, more importantly, before the due date for Atotech's responses. Based on these facts, it appears that Atotech is attempting to circumvent its obligations to respond to written discovery while at the same time attempting to force MacDermid to provide the same information that has already been propounded via written discovery requests. Atotech's misuse of a discovery tool in noticing a deposition in this manner should not be countenanced. In the event that such tactics are allowed, MacDermid has responded by issuing a similar Notice of Deposition to Atotech.

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing **MOTION FOR PROTECTIVE ORDER** was served by facsimile, email and U.S. First-Class Mail, postage prepaid, on this 28th day January 2008 as follows:

James K. Stronski
Barbara Z. Morrissey
Deena Levy Weinhouse
Frommer Lawrence & Haug, LLP
745 Fifth Avenue
New York, NY 10151
212-588-0500 (fax)
JStronski@flhlaw.com
BMorrissey@flhlaw.com
DWeinhouse@flhlaw.com



Fatima Lahnin
Carmody & Torrance LLP
195 Church Street
P.O. Box 1950
New Haven, CT 06509-1950
Telephone: (203) 784-3116
Facsimile: (203) 784-3199

EXHIBIT A

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

-----X	:	
Atotech Deutschland GmbH	:	
.	:	
	:	
Petitioner,	:	
v.	:	Cancellation No.: 92047816
	:	
	:	
MacDermid Acumen, Inc	:	
	:	
Registrant	:	
-----X	:	

NOTICE OF RULE 30(b)(6) DEPOSITION

PLEASE TAKE NOTICE that commencing at 9:00 A.M. on Tuesday January 29, 2008, and continuing from day to day until completed, Petitioner Atotech Deutschland GmbH. ("Petitioner" or "Atotech"), will take the deposition of Registrant MacDermid Acumen, Inc ("Registrant" or "MacDermid"). The deposition will be taken at the offices of Frommer Lawrence & Haug LLP, 745 Fifth Avenue, New York, NY 10151, or at such other location as is mutually agreeable.

In accordance with Rule 30(b)(6) of the Federal Rules of Civil Procedure, MacDermid is advised that it is required to designate one or more officers, directors, managing agents, or other persons who consent to testify on its behalf with respect to the matters set forth in attached Exhibit A. By January 25, 2008, MacDermid should inform Atotech of the person(s) designated to testify on its behalf with respect to the matters set forth in attached Exhibit A.

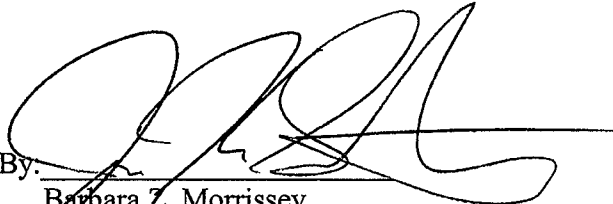
The deposition will be taken in accordance with the Federal Rules of Civil Procedure and the Trademark Rules of Practice before an official authorized by law to administer oaths. The

testimony will be recorded by stenographic and/or videographic means.

Atotech requests that any documents used by MacDermid in connection with the noticed deposition be produced prior to the deposition.

You are invited to attend and cross-examine.

ATOTECH DEUTSCHLAND GMBH

By: 

Barbara Z. Morrissey

James K. Stronski

Deena Levy Weinhouse.

FROMMER LAWRENCE & HAUG LLP

745 Fifth Avenue

New York, New York 10151

212-588-0800

212-588-0500 (fax)

Attorneys for Petitioner

ATOTECH DEUTSCHLAND GMBH

Exhibit A

1. How, when, and by whom the decision to use TRIBLACK as a trademark was made.
2. The selection process for product design, packaging, marketing and advertising for MacDermid's goods bearing the TRIBLACK mark.
3. Any consumer marketing surveys or other marketing tools regarding use of the mark TRIBLACK.
4. All goods and services in which MacDermid has used, uses or intends to use the mark TRIBLACK in the United States.
5. All media in which MacDermid has advertised, advertises or intends to advertise its goods bearing the TRIBLACK mark, all trade journals or other industry related publications where MacDermid has marketed, markets or intends to market its goods bearing the TRIBLACK mark, and all trade shows or other industry sponsored events where MacDermid has marketed, markets or intends to market goods bearing the TRIBLACK mark.
6. The trade channels for MacDermid's goods bearing the TRIBLACK mark and the intended customers for MacDermid's goods bearing the TRIBLACK mark.
7. The identity of all customers (at any time) for MacDermid's goods bearing the TRIBLACK mark and of any sales representatives, brokers, middlemen or agent involved (at any time) involved in the sales of MacDermid's goods bearing the TRIBLACK mark.
8. The dates of first use for all products sold, offered for sale, advertised and/or promoted in the United States under the mark TRIBLACK.
9. The launch of MacDermid's goods bearing the mark TRIBLACK.
10. MacDermid's wholesale and retail sales in the United States of all goods bearing the mark TRIBLACK and MacDermid advertising expenditures in the United States for goods bearing the TRIBLACK mark.
11. Instances in which any person, firm, corporation, association or other entity has been confused (at any time) or has indicated by correspondence or otherwise that she, he or it has been confused, deceived, or mistaken (at any time) as to the source of origin of Atotech or MacDermid's goods.
12. The geographic scope of sales of MacDermid's goods bearing the TRIBLACK mark.
13. Any nationwide or regional interruption in the sale of MacDermid's goods bearing the TRIBLACK mark including any facts that may support the conclusion that MacDermid's use of the TRIBLACK mark was, or for a period of time had been, abandoned.

14. Identification of all customers or third-parties that could corroborate the date of first use in commerce by MacDermid of the TRIBLACK mark.
15. The organizational structure of MacDermid, including those primarily responsible for the adoption of the TRIBLACK mark, and the marketing and sales of goods bearing the TRIBLACK mark.
16. MacDermid's prosecution of U.S. Application No. 78/634,137 for the TRIBLACK mark.
17. Any license and/or a contract and/or order from MacDermid to manufacture, distribute, sell, any products bearing the mark TRIBLACK.
18. The background or qualifications of the person or persons who testify on MacDermid's behalf regarding the preceding matters, including how such person was prepared to testify on these categories.

CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of January 2008, a copy of the foregoing **NOTICE OF RULE 30(b)(6) DEPOSITION** was served by facsimile and email upon:

Fatima Lahnin, Esq.
Carmody & Torrance LLP
195 Church Street
P.O.Box 1950
New Haven, CT 06509-1950
flahnin@carmodylaw.com

Jennifer A. Calcagni, Esq.
Carmody & Torrance LLP
50 Leavenworth Street
P.O. Box 1110
Waterbury, CT 06702
jcalcagni@carmodylaw.com

Attorneys for Registrant MacDermid Acumen, Inc.