

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

February 10, 2021

Cancellation No. 92070823

*ICware Systems, Inc. dba BatchTest
Corporation and BatchTest Corporation*

v.

Ikonix USA LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Respondent's motion (filed November 2, 2020) to amend standard protective order in this proceeding and to extend time to serve discovery responses.¹ The motion has been fully briefed.

Under Trademark Rule 2.116(g), the Board's standard protective order is automatically operative in this proceeding.² The terms of the Board's standard protective order, however, may be modified, upon motion or upon stipulation

¹ To facilitate review of the proposed amended protective order, Respondent should have included a red-lined version of the proposed amended protective order, along with a clean copy of the proposed amended protective order. *Cf.* TBMP §§ 507.01 (2020) (motion for leave to amend pleading should be accompanied by a red-lined version of the proposed amended pleading) and 514.01 (motion to amend application or registration should be accompanied by a red-line version of the proposed amendment).

² Contrary to Respondent's assertion, the standard protective order is not based on both parties being represented by attorneys. Although the standard protective order precludes parties appearing *pro se* from receiving information designated as trade secret/commercially sensitive, it is applicable regardless of whether parties are represented by attorneys. See Trademark Rule 2.116(g).

approved by the Board, to govern the exchange of “Confidential” or “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive)” information. *See* Trademark Rule 2.116(g); TBMP § 412.02 (2020). Parties should confer in good faith before seeking Board intervention regarding a protective order. *See Emilio Pucci Int’l BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016) (lack of good faith effort); TBMP § 412.06.

The record indicates that Respondent waited until October 29, 2020 -- more than a year after the parties’ October 3, 2019 discovery conference -- to initiate contact with Petitioner to propose amending the standard protective order. Respondent then filed its motion to amend the standard protective order on November 2, 2020 -- only four days later and on the due date for responses to interrogatories that Petitioner served on October 2, 2020. *See* Trademark Rules 2.120(a)(3) and 2.196. In view of the short amount of time between attempting to commence discussions regarding the proposed amendment and the filing of Respondent’s motion, the Board finds that Respondent failed to make a good faith effort to resolve issues regarding the proposed amended protective order prior to seeking Board intervention. Although Petitioner’s president requested in an October 29, 2020 e-mail “that all conversations between us be kept in writing, preferably through emails,” 33 TTABVUE 23 and 34 TTABVUE 95, that request did not end communications between the parties and did not relieve Respondent of its duty to make a greater effort to reach agreement with Petitioner with regard to the proposed amended protective order prior to seeking Board

intervention.³ See *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014).

Moreover, Respondent's motion indicates that such motion is in response to Petitioner's interrogatory no. 2, wherein Petitioner seeks information regarding, among other things, goods that Respondent "intends to sell in the United States" under the involved mark, 33 TTABVUE 3 and 34 TTABVUE 27.⁴ It is generally inappropriate for a party to respond to a discovery request for discovery by filing a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request that it believes to be proper, and stating its objections to those which it believes to be improper. See *Luemme Inc. v. D. B. Plus Inc.*, 53 USPQ2d 1758, 1761 (TTAB 1999). Thus, Respondent should have provided responsive, non-trade secret/commercially sensitive information, leaving responsive trade secret/commercially sensitive information for supplementation, if necessary.

Notwithstanding the foregoing, the Board, in the interest of moving this proceeding forward, finds as follows. To the extent that Respondent seeks to amend the protective order to state that it is not required to disclose to Petitioner certain

³ Respondent's attorney's incorrectly asserts in an October 30, 2020 e-mail to Petitioner's president that its service of discovery requests on October 2, 2020 was proper, notwithstanding that Respondent had not served initial disclosures concurrently with or prior to service of those discovery requests, 34 TTABVUE 94. Although discovery opens prior to the due date for initial disclosures, a party may not seek discovery unless it has served initial disclosures. See Trademark Rule 2.120(a)(3); *Dating DNA, LLC v. Imagini Holdings, LLC*, 94 USPQ2d 1889, 1893 (TTAB 2010) (service of initial disclosures is a prerequisite to taking discovery); TBMP § 403.02.

⁴ See TBMP § 414 regarding the discoverability of various types of information in Board proceedings.

information that it contends is “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive)” as long as Petitioner is appearing *pro se*, such information need not be disclosed directly to a party appearing *pro se* under the standard protective order. Under the standard protective order, information so designated is “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 paragraphs 4 and 5, by independent experts or consultants for the parties.” TBMP § 412 (emphasis added). That is, *pro se* parties are already precluded from receiving information designated “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive)” under the Standard Protective Order, and this proposed amendment is unnecessary.⁵

To the extent that the parties disagree regarding whether information concerning goods on which it intends to use its involved mark are properly designated “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive),” Respondent need only provide discovery regarding its use of the involved mark on the goods identified in its involved registration⁶ and its use of the involved mark on any

⁵ If an attorney appears on behalf of Petitioner herein, Respondent will be expected to supplement its discovery responses to produce documents designated as “Confidential - Attorneys’ Eyes Only (Trade Secret/Commercially Sensitive)” in accordance with the Standard Protective Order. *Cf. Amazon Techs., Inc. v. Wax*, 95 USPQ2d 1865, 1867 n.6 (TTAB 2010) (applicant retained an outside attorney solely to review opposer's “trade secret/commercially sensitive” information and documents pursuant to the protective order).

⁶ Applicant’s identified goods are “Software for use in testing electrical safety products to ensure compliance with regulations, and to set up electrical safety products for their intended use, and to analyze the results of the tests of electrical safety products; computer software for recording test data, archiving test data, importing test data into a spreadsheet or database, logging test data, statistically analyzing test data, and reviewing test data” in International Class 9.

of Opposer's additional pleaded goods not identified in that registration. *See TBC Corp. v. Grand Prix Ltd.*, 16 USPQ2d 1399, 1400 (TTAB 1990) (where goods of parties differ, determining whether parties market goods of same type is relevant to establishing relationship between goods); TBMP § 414(11). Further, information regarding a party's plans to expand its business are properly designated as "Confidential – For Attorneys' Eyes Only (trade secret/commercially sensitive)." *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675-76 (TTAB 1988); TBMP § 414(8). *See also* Standard Protective Order at § 1 (**"Material designated as Confidential - Attorneys' Eyes Only (Trade Secret/Commercially Sensitive) may include ... competitive business information, including** non-public financial and marketing analyses, media scheduling, comparisons of competitor's products or services, and **strategic product/service expansion plans"** (emphasis added)). Thus, information regarding goods on which Respondent intends to use the involved mark is properly designated as trade secret/commercially sensitive.

To the extent that Respondent seeks to require Petitioner to sign the protective order, it is unclear as to whether the Board can so require. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42251 (August 1, 2007); TBMP § 412.03. Accordingly, the Board declines to so require.

Based on the foregoing, the motion for a protective order is granted to the extent that information concerning goods on which Respondent intends to use the involved

mark is properly designated as “Confidential – For Attorneys’ Eyes Only (trade secret/commercially sensitive).” The motion is otherwise denied.

The Board deems the filing of Respondent’s motion to have tolled the running of dates herein. Proceedings are resumed. Respondent is allowed until thirty days from the date of this order to serve responses to Petitioner’s discovery requests.⁷ Discovery is open. Remaining dates are reset as follows.

Initial Disclosures Due	3/11/2021
Expert Disclosures Due	7/9/2021
Discovery Closes	8/8/2021
Plaintiff's Pretrial Disclosures Due	9/22/2021
Plaintiff's 30-day Trial Period Ends	11/6/2021
Defendant's Pretrial Disclosures Due	11/21/2021
Defendant's 30-day Trial Period Ends	1/5/2022
Plaintiff's Rebuttal Disclosures Due	1/20/2022
Plaintiff's 15-day Rebuttal Period Ends	2/19/2022
Plaintiff's Opening Brief Due	4/20/2022
Defendant's Brief Due	5/20/2022
Plaintiff's Reply Brief Due	6/4/2022
Request for Oral Hearing (optional) Due	6/14/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for

⁷ Respondent’s motion to extend time to serve discovery responses is moot.

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submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).