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28 March 2019

The Honorable Gerard F. Rogers
Chief Administrative Trademark Judge
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313–1451

VIA EMAIL ONLY (cheryl.butler@uspto.gov)

Re: Additional Discussion of TTAB's Standard Protective Order

Dear Chief Judge Rogers:

Intellectual Property Owners Association (“IPO”) appreciates the opportunity to provide comments in connection with the additional discussion of the TTAB’s Standard Protective Order (“SPO”). We incorporate the posted questions below, followed by our answers and comments.

1. Please describe the entity or individual submitting the comments (i.e., a law firm, a private practice attorney, a corporation or other business entity, in-house counsel, a trade association, a legal or policy association, professor/academia, other).

Answers and Comments:

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO’s membership includes about 200 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO membership spans over 30 countries.

IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

2. The SPO currently provides for the protection of information and documents designated as (1) Confidential or (2) Confidential – For Attorneys’ Eyes Only (trade secret/ commercially sensitive) (AEO). Under the SPO, AEO material is only available for review by outside counsel, not in-house counsel. Absent agreement by the parties or Board order, in-house counsel currently cannot access AEO information and documents.

Should the SPO be amended so that the default is to allow for in-house counsel access to AEO information and documents? YES or NO, and please explain the reason for your response.

Answers and Comments:

Yes, the SPO should be amended so that the default is to allow for in-house counsel access to AEO information and documents.

The current SPO assumes that in-house counsel, solely because of their status as in-house counsel, should be treated differently than outside counsel. This distinction is unwarranted and inconsistent with the Federal Circuit's opinion in *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1469 (Fed. Cir. 1984), which stated, "denial of access sought by in-house counsel on the sole ground of their status as in-house counsel is error" and vacated and remanded the lower court's decision denying in-house counsel's access to confidential information. The Court went on to say, "[I]like retained counsel, in-house counsel are officers of the court, are bound by the same Code of Professional Responsibility, and are subject to the same sanctions." *Id.* at 1468; *see Helene Curtis Inc. v. Derma-Cure Inc.*, 43 U.S.P.Q.2d 1316 (T.T.A.B. July 9, 1996) ("[R]espondent has not persuaded the Board that access to confidential information by in-house counsel would result in inadvertent disclosure or substantial harm.").

Although the Federal Circuit acknowledged there might be some circumstances that make denial of access appropriate—for example, where in-house attorneys are involved in competitive decision-making – it explained that the facts should still be weighed "on a counsel-by-counsel basis" by reviewing "the particular counsel's relationship and activities." *U.S. Steel Corp.*, 730 F.2d at 1468; *see Matsushita Elec. Indus. Co. v. United States*, 929 F.2d 1577, 1579 (Fed. Cir. 1991) (finding reversible error where in-house counsel, who also held the titles "Senior Vice President" and "Secretary," but who was not involved in competitive decision-making, was barred access to confidential documents). Moreover, the cases indicate the threshold showing is high: the party seeking to deny access must prove there is a "serious risk" of disclosure or even that access "would result in" disclosure. *See, e.g., U.S. Steel Corp.*, 730 F.2d at 1469; *Helene Curtis*, 43 U.S.P.Q.2d 1316 (emphasis added).¹

Although the current SPO may be revised upon stipulation of the parties, a party without in-house counsel might demand a concession in return, believing they are giving something up, or they might refuse the request altogether. If a party refuses to stipulate, the party seeking to amend the SPO has the burden to file a motion with the Board, which (unnecessarily, in our view) takes up resources of the parties and the Board.

It is important for outside and in-house counsel to work as a team serving their mutual client, with a free flow of information and documents between them to facilitate their collaboration. The current SPO creates a situation where outside counsel might be required to withhold documents or

¹ There is at least one recent example of such a dispute. *See, e.g., Cullen/Frost Bankers, Inc. v. BiFrost Capital Partners, Inc.*, Opp. No. 91234595 Dkt. No. 9 (TTAB 2017) (granting motion to amend SPO and stating "it is not appropriate ... to deny the proposed amendment to the Board's standard protective order solely on the basis that [in-house counsel] is Opposer's in-house counsel. Such a bright-line rule is not supported by relevant case law.").

information from their in-house counterpart, potentially impairing the representation. This also can interfere with the ability to have candid settlement discussions, and thereby can make it more difficult to resolve disputes.

If the TTAB removes the in-house/outside counsel distinction from the SPO, the revised SPO could include language encouraging the parties to discuss at the discovery conference the role of any in-house counsel and consider seeking amendment to the default position if appropriate.² Such a discussion could include questions relating to the in-house counsel's title(s) and decision-making authority within the business, and whether the in-house attorney is a U.S. or foreign attorney.

3. If your answer to question 2 is yes, should it matter if the in-house counsel is domestic or foreign? Please explain.

Answers and Comments:

No, it should not matter if the in-house counsel is domestic or foreign, but the TTAB could encourage parties to discuss whether adjustment of the SPO's default position is appropriate in such a case at the discovery conference. The parties could discuss whether their respective in-house attorneys are subject to the Board's jurisdiction and to ethical obligations and, if not, whether they would be willing to provide further assurances to address any reasonable concerns. If they are not subject to such obligations, and are not willing to provide such assurances, amendment would likely be appropriate.

4. When a party requests that in-house counsel be entitled to access AEO information in a particular case, the TTAB currently relies on the test set forth in *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471, 1484, 1 USPQ2d 1241 (Fed. Cir. 1986) to make that determination. The factors to be balanced are:

- (1) Whether the party seeking to gain access to AEO information for in-house counsel has "need for the confidential information sought in order to adequately prepare its case."
- (2) Any showing of "harm that disclosure would cause the party submitting the information."
- (3) The forum's interest in maintaining the confidentiality of the information sought."

Do you believe that this test is still appropriate for assessing in-house counsel access to AEO information? YES or NO, and please explain the reason for your response.

Answers and Comments:

No. The more appropriate test is found in *U.S. Steel* as reflected in section 412.02(b) of the Trademark Trial and Appeal Board Manual of Procedure. The TBMP accurately and appropriately

² This language could be similar to that in the current SPO which encourages the parties to sign the SPO so that the terms are enforceable after the conclusion of the board proceeding.

reflects *U.S. Steel*'s holding in this context that "the determining factor is whether in-house counsel is involved in its employer-litigant's 'competitive decision making.'" TBMP § 412.02(b); *see Helene Curtis* (applying *U.S. Steel* and stating, "access to confidential information cannot be denied to in-house counsel solely because of their 'general position'... respondent has not persuaded the Board that access to confidential information by in-house counsel would result in inadvertent disclosure or substantial harm.").

IPO notes that the second factor of *Akzo* is likely overlapping with the *U.S. Steel* inquiry, and the first factor requires knowledge of facts often unknown to the affected party at the beginning of a TTAB proceeding (*i.e.*, what information the other party will be producing and under which designations) at the time the parties must discuss any adjustments to the protective order.³ *See, e.g.*, Fed. R. Civ. P. 26(f)(3)(D), Trademark Rule 2.120(a)(2)(i), and TBMP §§ 401.01 (protective order should be discussed at discovery conference which occurs early in the proceeding). The third factor might not be particularly weighty in this context, as the TTAB would likely be best served by an outcome balancing the parties' interests.

5. If your answer to question 2 is no, and you do not think the SPO should be amended so that the default is to allow for in-house counsel access to AEO material, should the SPO instead be amended to incorporate the Akzo test described in question 4. YES or NO, and please explain the reason for your response.

Answers and Comments:

N/A

6. In addition to the issue of access to AEO material, the USPTO is interested in comments on the SPO's levels of confidentiality for protected information and documents. The previous version of the SPO included three levels: Confidential, Highly Confidential, and Trade Secret/Commercially Sensitive, with a presumption that in-house counsel would not have access to information or documents in the last category. Should the current SPO be amended to re-introduce the "Highly Confidential" tier? Please explain.

Answers and Comments:

No, the current SPO should not be amended to re-introduce the "Highly Confidential" tier. Three tiers can be confusing, as the differences between information that should be subject to the second tier versus the third tier would often be subjective and difficult to distinguish, and such distinctions are, in any event, often unnecessary in Board proceedings. Again, however, if the parties believe their particular case warrants a third tier, they may seek to adjust the SPO.

³ By contrast, the parties have information at that stage about their in-house counsels' roles and would be in a position to discuss and propose adjustments at that time.

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We again thank you for permitting IPO to provide comments and would welcome any further dialogue or opportunity to provide additional information.

Sincerely,



Mark Lauroesch
Executive Director