

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

LABELTEX MILLS, INC.)
)
Opposer,)
)
v.)
)
)
LABELTEX S.R.L.)
)
)
Applicant)

76/154,474

Opposition No. 91161944

APPLICANT'S MOTION FOR PROTECTIVE ORDER PROHIBITING DISCLOSURE OF
CONFIDENTIAL INFORMATION BY OPPOSING COUNSEL

Pursuant to Paragraph 5 of the Stipulated Protective Order filed with the Board on April 12, 2005, Applicant Labeltex S.r.l. ("Applicant") hereby objects to the disclosure by opposing counsel of information designated as "CONFIDENTIAL- -- ATTORNEY'S EYES ONLY" to officers of Opposer Labeltex Mills, Inc. ("Opposer").

Both parties served discovery requests, and both parties served their answers and produced documents. Among the documents produced by Applicant are hundreds of invoices to Applicant's US customers, shipping receipts to the same customers, and other documents that contain the names and addresses of Applicant's customers. To prevent the disclosure of such sensitive confidential business information to a self declared competitor, Applicant labeled these documents as CONFIDENTIAL-ATTORNEY'S EYES ONLY".

On November 17, 2008, after commencement of testimony, Opposer's counsel sent a letter to Applicant's counsel asking for a stipulation that the CONFIDENTIAL-ATTORNEY'S EYES ONLY designation be applied only to documents dated after August 30, 2004 and that the documents labeled as CONFIDENTIAL-ATTORNEY'S EYES ONLY dated prior to August 30.



2004 be treated as CONFIDENTIAL only. Opposer's counsel also indicated that he wanted to show these CONFIDENTIAL-ATTORNEY'S EYES ONLY documents Opposer's CEO and to "no more than 5 of Opposer's other key employees, whose identities are presently unknown". Applicant's counsel objected to this request in his letter of November 24, 2008. Counsel for Applicant and Counsel for Opposer also discussed this matter by phone on November 26, 2008, in an effort to resolve this matter. Unfortunately, no agreement was reached. Because the protective order imposes a burden on the producing party to seek a protective order preventing disclosure, Applicant has no alternative but to file this motion.

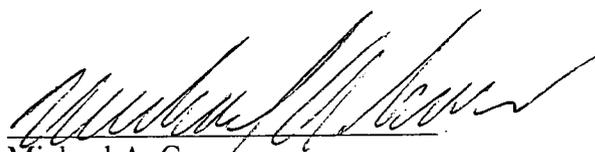
Applicant objects to the disclosure of critical confidential information to officers of Opposer, because such disclosure is likely to harm Applicant. Moreover, Opposer's counsel does not need to disclose the information to prepare Opposer's case. Indeed, Opposer's counsel has already been in contact with some of the Applicant's customers.

Although opposing counsel did not specifically identify by Bates numbers the documents he would like to make available to Opposer's CEO and to other officers, he indicated that those documents consist of invoices, shipping receipts and other documents labeled as CONFIDENTIAL-ATTORNEY'S EYES ONLY. Such documents contain names and addresses of all of Applicant's customers in the United States. Opposer has repeatedly alleged that the parties to this opposition are direct competitors. Thus, the disclosure of Applicant's customer list to Opposer's CEO could obviously cause significant harm to Applicant, while it does not appear to be necessary for the preparation of Opposer's case. It is well settled that a party cannot be compelled to disclose its customer list to the other party, and that a party's client list is generally not discoverable, even under a protective order. *See* TBMP §414(3).

Applicant agreed to produce documents containing information concerning the identity of its U.S. clients only after the parties entered into a Stipulated Protective Order identifying a category of highly confidential information documents that can be reviewed only by outside counsel.

Applicant's counsel does not intend to make the corresponding documents received from Opposer available to Applicant's officer. Moreover, as Paragraph 25 of the Stipulated Protective Order expressly acknowledges, counsel for a party is not restricted from rendering advice to his client in this proceeding, and in doing so to rely or refer to his examination of documents or other materials designated CONFIDENTIAL ATTORNEY'S EYES ONLY, provided that counsel does not disclose to the client such information. Thus, Opposer's counsel should be able to advise his client and prepare for testimony without disclosing the identity of Applicant's customers.

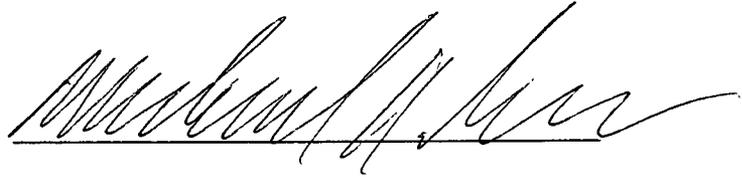
Respectfully submitted,



Michael A. Grow
Arent Fox LLP
1050 Connecticut Ave. NW
Washington DC 20036
202 857-6389

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing has been served upon Applicant's counsel Robert Louis Finkel, 5215-2 White Oak Ave., Encino, CA 91316, P.O. Box 19276, Encino, CA 91416, by first class mail, postage prepaid, this first day of December 2008.

A handwritten signature in cursive script, written in black ink, positioned above a horizontal line. The signature is difficult to decipher but appears to be a name.

CERTIFICATE OF MAILING

It is hereby certified that the attached Applicant's Motion For Protective Order Prohibiting Disclosure of Confidential Information (Re: Opposition No. 91161944) is being deposited with the United States Postal Service, first class mail postage prepaid, addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313, on December 1, 2008.

Chloe Gulien
