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

Proceeding	91163556
Party	Plaintiff TARGET BRANDS, INC. ,
Correspondence Address	Vanessa A. Ignacio, Esq. Lowenstein Sandler PC 65 Livingston Avenue Roseland, NJ 07068-1791 UNITED STATES lstrademark@lowenstein.com
Submission	OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR ENTRY OF PROTECTIVE ORDER AND CROSS-MOTION FOR ENTRY OF A PROTECTIVE ORDER AND OTHER RELIEF
Filer's Name	Michael A. Norwick
Filer's e-mail	lstrademark@lowenstein.com
Signature	/Michael A. Norwick/
Date	07/27/2005
Attachments	TargetOPP.PDF (31 pages)

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

Opposition of Application Serial No. 78/170,846

Target Brands, Inc. ,

Opposer,

v.

Shaun N.G. Hughes,

Applicant.

Opposition No. 91163556

**OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR ENTRY OF
PROTECTIVE ORDER AND CROSS-MOTION FOR ENTRY OF A PROTECTIVE
ORDER AND OTHER RELIEF¹**

PRELIMINARY STATEMENT

There is only one issue that must be decided in order to resolve the Applicant's motion and the Opposer's cross-motion for a protective order: Should the Board enter a protective order that prohibits the parties' in-house counsel from viewing documents and information, where (1) the information at issue is sales and advertising expenditures which are directly relevant to the Applicant's claim that its applied-for mark has attained secondary meaning; (2) the Applicant and Opposer are not competitors and there is no reasonable basis to conclude that the information, if inadvertently disclosed, could be used competitively; (3) the in-house counsel who would have access to the confidential documents and information are not involved in competitive decision-making for their employers; and (4) there is no evidence that the in-house counsel are any more likely to breach their obligations to honor a protective order than any other person subject to its mandate for strict confidentiality. Opposer Target Brands, Inc. ("Target Brands") respectfully submits that there is no basis for such a protective order in

¹ In addition to the brief embodied herein, the Opposer relies upon the attached Declarations of Toni Dembski-Brandl, Esq. and Michael A. Norwick, Esq., and exhibit attached thereto.

this case. The Applicant's motion, while nominally made to seek the entry of the Board's suggested protective order (found in the Appendix of the TBMP), is in actuality, made for the specific purpose of taking advantage of that suggested order's language that "Trade Secret/Commercially Sensitive" material may be accessed by "Outside Counsel, but not in-house counsel" TBMP, Appendix of forms, 692-93. While this form provides "Terms of *Suggested Protective Agreement upon Stipulation*" (TBMP, Appendix of Forms at 691 (emphasis added)), there is nothing in the TBMP that mandates that the Board enter this precise form of order, particularly when one of the parties comes forward with evidence that one of its terms is unnecessary and interferes with its ability to obtain the unencumbered advice of counsel.

It is the Applicant's stated intention to designate documents and information related to sales and advertising expenditures as "trade secret/commercially sensitive" to shield such information from Target Brands' in-house counsel, even though such information is not a "trade-secret" and is not "commercially sensitive" (at least in relation to the Opposer) -- and even though the Applicant has not come forward with any evidence demonstrating good cause that its sales and advertising expenditures are entitled to such a burdensome measure of protection. Importantly, as will be explained, *infra*, a protective order that indiscriminately excludes in-house counsel from access to relevant documents and information is inconsistent with a controlling Federal Circuit precedent, U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed Cir. 1984). Accordingly, Target Brands respectfully requests that the Board enter a protective order that does not unnecessarily prohibit the access of in-house counsel to relevant documents and information, and preferably, enter the protective order that the parties have already negotiated with respect to every issue except for the one issue currently before the Board in these motions. See Declaration of Michael A. Norwick, Esq. ("Norwick Decl."), ¶¶ 4-5 & Ex. A.

BACKGROUND

Target Brands, Inc. (“Target Brands”)² instituted this Opposition proceeding against Shaun N.G. Hughes’s (the “Applicant”) application to register ULTIMATE POLO for sun-protective shirts. Target Brands believes that the Applicant’s registration of this mark would be detrimental to Target Brands’ right to use the same words in connection with its shirts. Target Brands uses the term “Ultimate Polo” in connection with its polo shirts (as do numerous other companies), and asserts that the term is laudatory and merely descriptive and, as a result, cannot be registered in connection with shirts by anyone.

On or about May 2, 2005, Target Brands served discovery requests upon the Applicant, including document requests and interrogatories that seek discovery on the Applicant’s claim that its ULTIMATE POLO name has acquired distinctiveness and has attained secondary meaning. Norwick Decl. ¶ 3. Several weeks later, the Applicant’s attorney advised counsel for Target Brands that the Applicant required a protective order to produce certain of the responses to Target Brands’ discovery requests. *Id.* ¶ 4. On June 1, 2005, counsel for the Applicant sent Target Brands’ counsel a draft protective order. *Id.* On June 6, 2005, Target Brands’ counsel forwarded a revised draft to the Applicant’s counsel. *Id.* Among the changes made to the document were (i) what types of documents could be designated “CONFIDENTIAL-ATTORNEYS ONLY;” (ii) how much of any document could be marked “CONFIDENTIAL-ATTORNEYS ONLY;” and (iii) which attorneys could review documents designated “CONFIDENTIAL-ATTORNEYS ONLY.” *Id.* A copy of the draft protective order is attached to the Norwick Decl. as Exhibit A.

Based upon the discussions of the attorneys, the Applicant’s only objection to the negotiated form of protective order (Norwick Decl., Ex. A) is that it provides for specific in-house attorneys at Target Brands to view documents designated as “CONFIDENTIAL-

² Target Brands is the intellectual property holding company for Target Corporation (“Target Corp.”), the entity that runs the well known discount retail stores and internet business, target.com. Declaration of Toni Dembski-Brandl, Esq. (“Dembski Decl.”) ¶ 2.

ATTORNEYS ONLY.” Norwick Decl. ¶ 5. After this dispute arose, the Applicant took the position (which is the position of the Applicant’s motion) that the parties should use the Suggested Protective Order upon Stipulation provided in the Appendix of the TBMP. Id. ¶ 6. That form of order identifies one category of information “Trade Secret/Commercially Sensitive” that only outside counsel may access, although it does not define with specificity what types of information fall into this category. Id.

Based upon the discussions of counsel, there are two categories of information that the Applicant seeks to shield from Target Brands’ in-house counsel: sales and advertising expenditures for the Applicant’s “Ultimate Polo” shirts. Norwick Decl. ¶ 7. This information is highly relevant to the Applicant’s claim that its name has obtained secondary meaning. Accordingly, it is essential that Target Brands’ inside and outside counsel be able to discuss this important information in order to advise the client on the strength of the Applicant’s claim. Id.; Dembski Decl. ¶¶ 6-9. There is no dispute that this information should be kept confidential, (Norwick Decl. ¶ 7; Dembski Decl. ¶ 11) and Target Brands agrees that access may be limited to outside counsel and four of its in-house attorneys.³ Dembski Decl. ¶ 11.

³ Several weeks after Target Brands served its discovery requests, it received discovery requests from the Applicant, which called for Target Brands to produce its sales and advertising expenditures. Norwick Decl. ¶ 8. Although this information is only marginally relevant -- if at all -- to this Opposition proceeding -- which only involves the distinctiveness of the Applicant’s proposed mark -- Target Brands agrees that if this information is to be produced, it should be produced subject to a protective order which maintains confidentiality, such as the negotiated protective order attached to the Norwick Decl. as Exhibit A.

LEGAL ARGUMENT

A. THE APPLICANT HAS FAILED TO DEMONSTRATE GOOD CAUSE FOR A PROTECTIVE ORDER THAT EXCLUDES IN-HOUSE COUNSEL FROM ACCESS TO RELEVANT DISCOVERY.

Section 412.01 of the TBMP provides, in relevant part, “[o]n motion, *showing good cause*, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense . . .” TBMP, § 412.01 (emphasis added). Here, the Applicant has failed to include with his motion any argument or evidence demonstrating good cause for the entry of any protective order whatsoever. However, as explained above, and in the accompanying Norwick Declaration, there is only one issue in dispute: namely, whether in-house counsel should have access to confidential documents, and even more specifically, whether Target Brands’ in-house counsel should be entitled to access the Applicant’s sales and advertising expenditure information. Thus, it is the Applicant’s failure to demonstrate good cause with respect to this particular issue that warrants denial of his motion for the entry of a protective order.

On the other hand, Target Brands has demonstrated good cause for the entry of a protective order that, while maintaining confidentiality of proprietary information, allows access to only those attorneys who, for the purposes of this Opposition, need to evaluate and analyze the information. It is undisputed that the Applicant’s sales and advertising expenditures are relevant to the most important issue in this Opposition proceeding, namely secondary meaning of the Applicant’s chosen mark. Norwick Decl. ¶ 7; Dembski Decl. ¶¶ 5-6; TBMP §414(18) (“Annual sales and advertising figures, stated in round numbers, for a party’s involved goods or services sold under its involved mark are proper matters for discovery”). Moreover, Target Brands’ in-house counsel have a legitimate need to, with the assistance of outside counsel, evaluate the strength and/or weakness of this critical evidence of secondary meaning. See Dembski Decl. ¶¶ 6-9; Norwick Decl. ¶ 7. The Applicant has failed to come forward with any evidence suggesting that there is some legitimate reason why Target Brands’ in-house counsel must be excluded from

access to this evidence. The Applicant's lack of evidence is not only dispositive of whether he has demonstrated *good cause* under the TBMP for the entry of his preferred protective order, it is further dispositive that the Applicant has failed to meet the burden established by the Federal Circuit for such an order in U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed Cir. 1984).⁴

In U.S. Steel, the Federal Circuit adopted a case-by-case balancing approach for determining which attorneys may access confidential discovery in a particular case, and concluded that it was "error" to deny "access sought by in-house counsel on the sole ground of their status as in-house counsel." Id. at 1469. Indeed, the Court noted that "Denial or grant of access . . . cannot rest on a general assumption that one group of lawyers are more likely or less likely to inadvertently breach their duty under a protective order." Id. at 1468. Rather, the Federal Circuit indicated that all of the various facts and circumstances should be reviewed in each case, including: (1) the extent of opportunity for and risk of inadvertent disclosure (id. at 1468-69); (2) the relationships and activities that the attorneys are involved in the matter (id. at 1468); (3) the extent to which the attorney are involved in competitive decision making for the client, i.e., advising on decisions about pricing or design made in light of similar or corresponding information about a competitor. Id. & fn.3; see also Matsushita Electric Industrial Co. v. United States, 929 F.2d 1577, 1580 (Fed Cir. 1991) (adding that it is insufficient to deny in-house counsel access to confidential information "merely because they have regular 'contact' with those who are involved in competitive decision making."). The facts of this case overwhelmingly mitigate in favor of allowing in-house counsel to access confidential information.

⁴ Significantly, the Federal Circuit's U.S. Steel decision has been widely followed by a number of courts around the country, and has been cited as "the leading authority on protective orders distinguishing between outside and in-house counsel." Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1470 (9th Cir. 1992); accord United States v. Sungard Data Systems, Inc., 173 F. Supp.2d 20, 23-24 (D.D.C. 2001); see also, e.g., Carpenter Technology Corp. v. Armco, Inc., 132 F.R.D. 24, 27 (D. Penn. 1990).

First, Target Brands and its related companies sell regular polo shirts, not sun-protective shirts like the Applicant sells, and accordingly, the parties to this Opposition proceeding are not competitors. Dembski Decl. ¶¶ 3, 11. The notion that the Applicant's sales and advertising expenditures, if inadvertently disclosed within Target Brands or Target Corp., could cause some competitive damage to the Applicant is, thus, highly speculative. Second, none of the in-house attorneys for whom access is sought are involved in product development, marketing or competitive decision making. Dembski Decl. ¶¶ 1, 7-10. The in-house attorney most directly involved in this matter, Ms. Toni Dembski-Brandl, Esq., is solely involved with intellectual property matters. Id. ¶ 7. Accordingly, there is no evidence that there is any heightened risk of disclosure, and the U.S. Steel case prohibits any presumption that there is such a risk, merely because the attorneys at issue happen to be in-house counsel. See U.S. Steel, 730 F.2d at 1468. As observed by the Federal Circuit, “[I]f 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. All of the relevant in-house attorneys have agreed to be bound by a protective order entered by the Board (Dembski Decl. ¶ 11), and there is no reasonable basis for presuming that they will not honor their legal and ethical obligations to maintain confidentiality.

B. THE BOARD'S SUGGESTED PROTECTIVE ORDER SHOULD NOT BE ENTERED UNDER THE CIRCUMSTANCES PRESENTED HERE.

Given the particularly narrow dispute between the parties, explained in detail above, it would be inappropriate for the Board to simply enter, without modification, the protective order from the Appendix to the TBMP, as the Applicant proposes, without regard to all of the facts and circumstances here. First, the TBMP does not mandate the entry of that particular order, but merely notes that the “standard” protective order is but one of several options, including entry of an order submitted by one of the parties or an order mutually agreeable to the parties. See TBMP, § 412.02(a). Second, mere entry of the protective order

from the TBMP Appendix will not resolve the issues that are actually in dispute here, namely, whether it is permissible for in-house counsel to access the Applicant's sales and advertising expenditures.

As set forth in the Norwick Declaration, the Applicant's counsel has already indicated that he would, if the Board's protective order was entered, designate documents and information related to sales and advertising expenditures under the "Trade Secret/Commercially Sensitive" category. Norwick Decl. ¶ 7. The Applicant's proposed designation of such materials would only trigger another dispute -- and another motion pursuant to Section 14 of the suggested protective order -- regarding whether the designation of sales and advertising expenditures in the "Trade Secret/Commercially Sensitive" category is appropriate.⁵ As part of resolving these motions, the Board should conclude that, in light of all the circumstances identified above, that this is an inappropriate category for the Applicant's sales and advertising figures. This information, while confidential, is certainly not a secret formula, compilation, or process that one could, under any definition, deem to be a "trade secret." Moreover, the Opposer has not requested information related to profits, which most businesses deem far more sensitive. Furthermore, particularly in light of the fact that the parties do not sell the same category of goods, and are not competitors, it is difficult to view this information as the type of "commercially sensitive" information that could even be used by one party to the detriment of the other.

Even if there were some third-party -- perhaps another seller of sun-protective clothing -- in relation to whom sales and advertising data could be deemed "commercially sensitive" -- the mere existence of such a company that might have some commercial interest in

⁵ During the June 28, 2005 telephone conference with the interlocutory attorney assigned to this matter, Mr. Thomas Wellington, the Board made it clear that any motion(s) brought before the Board in connection with this dispute should resolve *all* of the issues in dispute, including the designation of the particular materials that the Applicant seeks to shield from in-house counsel.

the Applicant's confidential information does not support the Applicant's insistence upon distinguishing between outside and in-house counsel of a non-competitor, Target Brands, with respect to the protective order in dispute.

Finally, since the parties have already negotiated a protective order (attached to the Norwick Declaration as Exhibit A), in which the parties have resolved all disputes, with the exception of the issue of in-house counsel access (which should be resolved by these motions), (Norwick Decl. ¶¶ 4-5) it is far more appropriate to enter the parties' negotiated protective order, which incorporates the language desired by both the Applicant and the Opposer.⁶

⁶ Notably, the protective order originally proposed by the Applicant was revised by the Opposer's counsel to incorporate additional terms, including a term which specifies that: entire documents would not necessarily be confidential but rather, the confidential information contained in documents could be protected by "marking specific information or data in the document that is designated as such." See Norwick Decl, ¶ 4 & Ex. A, p.2. While Target Brands is not aware of any objection that Applicant has to this or any other provision added to this negotiated protective order, other than in-house counsel access, comparable terms are not included in the order from the TBMP Appendix that the Applicant now seeks to implement.

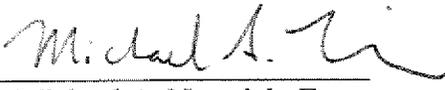
CONCLUSION

For the reasons set forth above, the Board should deny Shaun N.G. Hughes's motion for a protective order, and grant Target Brands, Inc.'s motion for a protective order, and enter the form of order attached to the Declaration of Michael A. Norwick, Esq. as Exhibit A. In the alternative, the Board should enter an Order declaring that all otherwise discoverable materials produced in this matter may be accessed by any parties' in-house counsel and directing the parties to negotiate a protective order consistent with that directive.

Respectfully submitted,

By: LOWENSTEIN SANDLER PC
65 Livingston Avenue
Roseland, New Jersey 07068
(973) 597-2500

ATTORNEYS FOR TARGET BRANDS,
INC.

By: 
Michael A. Norwick, Esq.

Dated: July 27, 2005

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

Opposition of Application Serial No. 78/170,846

Target Brands, Inc. ,

Opposer,

v.

Shaun N.G. Hughes,

Applicant.

Opposition No. 91163556

**DECLARATION OF
MICHAEL A. NORWICK, ESQ.**

MICHAEL A. NORWICK, ESQ. declares as follows:

1. I am an attorney with Lowenstein Sandler PC, outside counsel for Target Brands, Inc. ("Target Brands") in this Opposition proceeding against Shaun N.G. Hughes's (the "Applicant") application to register ULTIMATE POLO for sun-protective shirts. As such, I am fully familiar with the facts set forth herein.

2. Target Brands uses the term "Ultimate Polo" in connection with shirts, but believes that the term is laudatory and merely descriptive and, as a result, cannot be registered in connection with shirts by anyone.

3. On or about May 2, 2005, Target Brands served discovery requests upon the Applicant, including document requests and interrogatories that seek discovery on the Applicant's claim that its ULTIMATE POLO name has acquired distinctiveness and has attained secondary meaning.

4. Several weeks later, the Applicant's attorney, James Uhlir, advised me that his client required a protective order to produce certain of the responses to Target Brands' discovery request. To that end, on June 1, 2005, Mr. Uhlir sent me a draft protective order. After I made a few changes to the document, on June 6, 2005, I forwarded a revised draft to Mr. Uhlir. Among the changes I made to the document were (i) what types of documents could be

designated "CONFIDENTIAL-ATTORNEYS ONLY;" (ii) how much of any document could be marked "CONFIDENTIAL-ATTORNEYS ONLY;" and (iii) which attorneys could review documents designated "CONFIDENTIAL-ATTORNEYS ONLY." A copy of my revision of Mr. Uhlir's draft protective order is attached hereto as Exhibit A.

5. Based upon my discussions with Mr. Uhlir, the Applicant's only objection to this negotiated form of protective order (Ex. A) is that it provides for specific in-house attorneys at Target Brands to view documents designated as "CONFIDENTIAL-ATTORNEYS ONLY."

6. After this dispute arose, the Applicant took the position (which is the position of the Applicant's motion) that the parties should use the Suggested Protective Order upon Stipulation provided in the Appendix of the TBMP. That form of order identifies one category of information "Trade Secret/Commercially Sensitive" that only outside counsel may access, although it does not define with specificity what types of information fall into this category.

7. During the course of my discussions with the Applicant's counsel, I learned that there were two categories of information that the Applicant sought to shield from Target's in-house counsel: sales and advertising expenditures for the Applicant's "Ultimate Polo" shirts. This information is highly relevant to the Applicant's claim that its name has obtained secondary meaning. Accordingly, it is essential that I be able to consult with and collaborate with Target Brands' in-house counsel regarding this important information in order to advise the client on the strength of the Applicant's claim. While this information should certainly be kept confidential, and Target Brands agrees to limit access to outside counsel and four of its in-house attorneys, the Applicant has failed to demonstrate that sales and advertising expenditures rise to the level of the "Trade Secret/Commercially Sensitive" category contemplated by the Board's suggested order. Nevertheless, the Applicant's counsel has indicated his intention to designate sales and advertising expenditures in this "Trade

Secret/Commercially Sensitive” category. Importantly, Target Brands, and its related companies, do not even sell sun-protective shirts, and thus, the parties are not even competitors.

8. Several weeks after Target Brands served its discovery requests, it received discovery requests from the Applicant, which called for Target Brands to produce its sales and advertising expenditures. Although this information is only marginally relevant -- if at all -- to this Opposition proceeding -- which only involves the distinctiveness of the Applicant’s proposed mark -- Target Brands agrees that if this information is to be produced, it should be produced subject to a protective order which maintains confidentiality, such as the negotiated protective order attached hereto as Exhibit A.

9. However, Target Brands strongly objects to any confidential information being shielded from any attorney involved in this opposition proceeding, as it is extremely important that all of Target Brands’ chosen counsel be entitled to fully examine and evaluate the critical evidence in this matter. The Applicant has failed to provide the Board with any good cause for excluding in-house counsel from access to any discovery materials to be produced in this matter.

DECLARATION

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.



Michael A. Norwick

Dated: July 27, 2005

EXHIBIT A

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

Opposition of Application Serial No. 78/170,846

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v.

Shaun N.G. Hughes,

Applicant.

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**PROTECTIVE ORDER AND AGREEMENT TO MAINTAIN
CONFIDENTIALITY**

12 WHEREAS, each party believes that some of the discovery and testimony provided or to
13 be provided by either party would involve disclosure of trade secrets or other confidential
14 research, development, or commercial information (collectively, "Confidential Information")
15 within the meaning of Rule 26(c) F.R.Civ.P., as applied by 28 C.F.R. § 2.120; and

16 WHEREAS, each party believes that it will serve the interests of the parties to conduct
17 discovery and testimony periods under a Protective Order and Agreement to Maintain
18 Confidentiality (hereinafter "Order and Agreement");

19
20 IT IS HEREBY ORDERED AND AGREED That:

21 1. For purposes of this Order and Agreement, the expression, "disclosing party",
22 means the party to this Opposition that provides "Confidential Information" within its
23 possession, custody or control, regardless of whether the Confidential Information relates to the
24 disclosing party's operations or those of any third party; and the expression, "receiving party"
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1 means the party to this Opposition whose attorneys receive or are otherwise apprised of the
2 confidential information provided by the disclosing party, as well as those individuals identified
3 in paragraphs 3-4; and independent experts who have been separately retained by the party for
4 the purposes of this litigation, and who, pursuant to paragraph 4(d), have acknowledged their
5 duty to maintain confidentiality by signing the Acknowledgement and Agreement attached
6 hereto and identified as Exhibit I.

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8 2. Any producing party from whom discovery is sought in this Opposition
9 proceeding, may designate as "CONFIDENTIAL" any documents, testimony or other discovery
10 material that contains confidential information. Any producing party from whom discovery is
11 sought in this Opposition proceeding, may designate as "CONFIDENTIAL - ATTORNEYS
12 ONLY" any proprietary technical, marketing, financial, sales or other confidential business
13 information or data, by marking each page that contains such information with the label
14 "CONFIDENTIAL - ATTORNEYS ONLY" and by marking the specific information or data in
15 the document that is designated as such. The parties shall not designate information or data as
16 "CONFIDENTIAL-ATTORNEYS ONLY" unless it comprises or contains technical,
17 marketing, financial, sales or other confidential business information which could be used by
18 the receiving party to obtain a business advantage over the producing party.
19 "CONFIDENTIAL - ATTORNEYS ONLY" and "CONFIDENTIAL" material, as used in this
20 Order and Agreement, shall refer to any so designated documents or parts of documents,
21 deposition testimony or other discovery material and all copies thereof, and shall also refer to the
22 information contained in such material. Designated documents shall bear the label designation
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1 "CONFIDENTIAL" or "CONFIDENTIAL - ATTORNEYS ONLY," as appropriate under this
2 Order and Agreement at the time of their production. Neither designation shall be made unless
3 the producing party believes in good faith that the designated material is entitled to protection
4 under the Federal Rules of Civil Procedure. Deposition testimony may be designated either
5 "CONFIDENTIAL" or "CONFIDENTIAL-ATTORNEYS ONLY" by counsel for the witness
6 providing the relevant testimony either on the record at such deposition or within fifteen (15)
7 days following counsel's receipt of a copy of the transcript of such depositions. Until the
8 expiration of such fifteen (15) day period, the entirety of any transcript of any deposition taken in
9 this action shall be deemed "CONFIDENTIAL-ATTORNEYS ONLY."
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11 3. Material marked or otherwise designated as "CONFIDENTIAL" shall be
12 maintained in confidence by the receiving party and shall not be disclosed to any person except
13 those listed below, and solely for purposes of this proceeding only:

14 (a) the TTAB and its staff;

15 (b) outside counsel of record, in-house counsel, their successors and their
16 respective staff;

17 (c) employees and officers of the parties who are directly involved in this
18 Opposition proceeding and need to have access to the material in order to assist, advise or direct
19 counsel;
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21 (d) translators, duplicating services, and auxiliary services of a like nature,
22 routinely engaged by counsel;
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(e) experts, who are not employees, representatives or agents of either party and are not potential fact witnesses in this action, engaged by counsel or the parties to assist in this litigation, provided that any such third party has signed an Acknowledgement and Agreement in the form of Exhibit I attached hereto. A copy of the signed Acknowledgement and Agreement, a curriculum vitae of the proposed expert and an identification of any past or present employment or consulting relationship with the party or any related company shall be served on all counsel of record ten (10) business days before the confidential discovery material may be shown to such expert. If the other party objects in writing to such disclosure within that ten (10) day period stating the reasons for such objection, no disclosure of confidential discovery material shall be made to that expert until the matter is resolved by the TTAB or agreement of the parties.

4. Material marked or otherwise designated as "CONFIDENTIAL – ATTORNEYS ONLY" shall be maintained in strict confidence by the receiving party and shall not be disclosed to any person except those listed below, and solely for purposes of this proceeding only:

- (a) the TTAB and its staff;
- (b) outside counsel of record, their successors and their respective staff;
- (c) in-house counsel, specifically, Target Brand, Inc.'s intellectual property attorneys, the Vice President of Law, and the General Counsel, who shall not disclose the information or documents containing the information to any other person at Target Brands, Inc. or Target Corporation or any of their affiliates;

- 1 (d) translators, duplicating services, and auxiliary services of a like nature,
2 routinely engaged by counsel;
- 3 (e) experts who are not employees, representatives or agents of either party
4 and are not potential fact witnesses in this action, engaged by counsel or
5 the parties to assist in this litigation, provided that any such third party has
6 signed an Acknowledgement and Agreement in the form of Exhibit I
7 attached hereto. A copy of the signed Acknowledgement and Agreement,
8 a curriculum vitae of the proposed expert and an identification of any past
9 or present employment or consulting relationship with the party or any
10 related company shall be served on all counsel of record ten (10) business
11 days before the confidential discovery material may be shown to such
12 expert. If the other party objects in writing to such disclosure within that
13 ten (10) day period stating the reasons for such objection, no disclosure of
14 confidential discovery material shall be made to that expert until the
15 matter is resolved by the TTAB or agreement of the parties.
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19 5. At the conclusion of the Opposition Proceeding, the receiving party shall disclose
20 the "CONFIDENTIAL" and "CONFIDENTIAL - ATTORNEYS ONLY" materials that were
21 provided to each expert. The parties agree to complete all obligations under this paragraph 5
22 within fifteen (15) days from the earliest date of the following occurrences: a final ruling by the
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1 Board, or execution by both parties of a settlement agreement, or the filing of a motion
2 dismissing the proceeding.

3 6. If either the "CONFIDENTIAL" or "CONFIDENTIAL - ATTORNEYS ONLY"
4 designation (hereinafter collectively referred to as "Confidential Identification") is inadvertently
5 omitted from any document, thing, interrogatory, answer, deposition testimony or other item
6 containing Confidential Information, the disclosing party shall notify the receiving party
7 promptly upon discovery of the omission, and the receiving party will promptly apply the
8 "CONFIDENTIAL" or "CONFIDENTIAL - ATTORNEYS ONLY" label and thereafter treat
9 the information, document, thing, interrogatory answer, deposition testimony or other item in the
10 manner set forth in this Order and Agreement.

12 7. Subject to the exceptions expressed in this Section 7, the receiving party shall
13 strictly limit its use of the Confidential Information of the disclosing party to the proceedings in
14 this Opposition, and shall not use any of the Confidential Information of the disclosing party for
15 any business purpose or for any other purpose whatsoever, and shall not disclose any of the
16 Confidential Information of the disclosing party to anyone else. The parties shall, for business
17 purposes, not contact the other party's customers revealed and identified during this litigation, but
18 nothing prevents either party from making contact with customers of the other party based upon
19 identification of those customers from other sources outside this proceeding. During this
20 proceeding counsel for the parties shall be permitted to contact any customers so identified solely
21 for the purposes of conducting discovery in this proceeding.

24 Exceptions:

1 None of the foregoing obligations apply to Confidential Information that is (1)
2 public knowledge or generally known to the trade; (2) rightfully communicated to the receiving
3 party by a third party who does not obligate the receiving party to keep it confidential; (3) known
4 to the receiving party prior to disclosure, as can be demonstrated by written documents; or (4)
5 permitted to be disclosed or used by the receiving party, said permission being in the form of a
6 written release signed by the disclosing party. If only a portion of the Confidential Information
7 falls within any of the foregoing exceptions, the remainder will continue to be subject to the
8 prohibitions and restrictions contained in this Order and Agreement.

9 8. The Confidential Information of either party may accompany any affidavit, brief,
10 deposition transcript or other paper filed in this Opposition; however, the portions of papers
11 containing Confidential Information shall be sealed in an envelope labeled with the case caption,
12 the title of the document to which it is attached and the following notice:

13 CONFIDENTIAL

14 FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER

15 The materials contained in this envelope have been designated
16 confidential, pursuant to a protective order, and are not to be disclosed or
17 revealed except to the Trademark Trial and Appeal Board and counsel for the
18 parties, or by order of a court.

19 The contents of the envelope will not be made available to the public for inspection or copying
20 unless and until ordered by the Trademark Trial and Appeal Board or Court of competent
21 jurisdiction.

22 9. The receiving party shall treat the Confidential Information of the disclosing
23 party with the same security and care that it provides to its own Confidential Information. If
24 either party to this Opposition has reason to believe that any of the Confidential Information has
25 been or is about to be disclosed or used in a manner inconsistent with this Order and Agreement,
26 the party possessing such belief shall promptly notify the other party of its concerns, and the
27

1 receiving party shall promptly take proper action to prevent or limit the nonconforming
2 disclosure or use attributable to it.

3 10. Upon termination of this Opposition and any appeal thereof, the receiving party
4 shall, at the request of the disclosing party, destroy or return to the disclosing party all originals
5 and all copies of the disclosing party's Confidential Information. In the event that any documents
6 covered by this paragraph contain materials or information added to them by the receiving party,
7 the receiving party has the option of destroying them. In this event, the receiving party shall
8 provide the disclosing party with written confirmation of destruction.
9

10 11. Nothing in this Order and Agreement constitutes a finding or an admission that
11 any of the Confidential Information is in fact confidential, nor does the receiving party waive any
12 right to later contend that any Confidential Information of the disclosing party is not confidential
13 or falls within any of the exceptions expressed in Section 7 above.
14

15 12. The production of any Confidential Information pursuant to this Order and
16 Agreement will not constitute a waiver, either in whole or in part, of any attorney-client privilege
17 or attorney work product or Fifth Amendment privilege which may be applicable to any material
18 not so produced.

19 13. Nothing in this Order and Agreement shall prevent either party from raising
20 objections on any ground (except confidentiality) to the production of documents or responses or
21 the admission of evidence in this Opposition.
22

23 14. The obligations expressed in this Order and Agreement and Exhibit I will survive
24 the conclusion of this Opposition and will continue to be binding upon the parties, their officers,
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1 directors, successors, and assigns, as well as upon those who execute the Acknowledgment and
2 Agreement as set forth in Exhibit I hereto.

3 15. The parties represent that this Protective Order and Agreement is executed by
4 duly authorized representatives and officers of the respective companies and their respective
5 counsel. To expedite the discovery in this proceeding, counsels' and the parties' signatures on
6 this Order and Agreement acts as an undertaking on their part to comply with the terms of this
7 Order and Agreement as if it were entered by the Board, and to comply with this Order and
8 Agreement with respect to all discovery received prior to the time that notice is received that the
9 Board will not enter this proposed Order and Agreement in the form in which it is being
10 presented.
11

12 16. The parties recognize that this document represents an Agreement between the
13 parties, separate and apart from the Protective Order, and the terms can be enforced in any court
14 of competent jurisdiction.
15

16 **SO AGREED.**

TARGET BRANDS, INC. , Opposer

17
18 Date: _____

By: _____
Name

19
20 _____
Title

21 Date: _____

22 By: _____
Michael A. Norwick, Esq.
Attorney for Opposer

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24 SIIAUN N.G. HUGHES, Applicant
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Date: _____

Shaun N.G. Hughes

Date: _____

By: _____
James R. Uhlir, Esq.
Attorney for Applicant

SO ORDERED.

Date: _____

Trademark Trial and Appeal Board

1 **EXHIBIT I**

2 **ACKNOWLEDGEMENT AND AGREEMENT**

3 Target Brands, Inc. and Shaun N.G. Hughes are engaged in Opposition
4 Proceeding No. 91163556 before the Trademark Trial and Appeal Board of the U.S. Patent
5 and Trademark Office. Each of these parties has agreed to protect the confidential
6 information provided to it by the other party and to label this information
7 CONFIDENTIAL or CONFIDENTIAL – ATTORNEYS ONLY (hereinafter
8 "Confidential Information") as defined in the Protective Order and Agreement to
9 maintain confidentiality between the parties (hereinafter "Order and Agreement"), and
10 incorporated by reference. One of the conditions of the Order and Agreement between the
11 parties is that independent experts engaged by either party receiving the Confidential
12 Information of the other party, (hereinafter "Disclosing Party") and exposed to that
13 Confidential Information in order to accomplish their assignments, agree to be legally
14 bound to keep the promises expressed below.

15
16
17 1. I acknowledge that I have conducted a thorough investigation for any
18 possible conflict of interest with regard to the Disclosing Party and that I have no conflicts
19 of interest.

20
21 2. I will not disclose any of the Confidential Information of the other
22 party to anyone unless that person needs to be exposed to the Confidential Information for
23 the purpose of engaging in the Opposition and that person is covered by Paragraph One of
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1 the Order and Agreement or is an expert who has signed the Acknowledgment and
2 Agreement substantially identical to this one.

3 3. I will not use the Confidential Information of the other party for any
4 purpose other than engaging in the Opposition.

5 4. Upon request, I will promptly return to the attorney for the party by
6 whom I am employed or engaged all documents and other items (originals and copies) that
7 are labeled CONFIDENTIAL or CONFIDENTIAL-ATTORNEYS ONLY and that were
8 provided to me in connection with the Opposition.

9 5. My obligations expressed in Sections 1 through 3 above are binding
10 upon me even after the Opposition is completed, and I am legally liable for any damages
11 incurred by the Disclosing Party for any breach of this Agreement by me.
12

13 SO ACKNOWLEDGED AND AGREED.

14 Date: _____

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16 _____
17 (Printed Name)

18 _____
19 (Signature)

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CERTIFICATE OF MAILING

I hereby certify that this Protective Order and Agreement to Maintain Confidentiality is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on the below date.

Date: _____

CERTIFICATE OF SERVICE

I hereby certify that on the ____ day of June, 2005, a true copy of Protective Order and Agreement to Maintain Confidentiality was served in the manner listed below.

Via U.S. Mail to:

Vanessa A. Ignacio, Esq.
Michael A. Norwick, Esq.
Lowenstein Sandler PC
65 Livingston Avenue
Roseland, NJ 07068

Attorneys for Target Brands, Inc.

Executed on _____, 2005.

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

Opposition of Application Serial No. 78/170,846

Target Brands, Inc. ,

Opposer,

v.

Shaun N.G. Hughes,

Applicant.

Opposition No. 91163556

**DECLARATION OF
TONI DEMBSKI-BRANDL, ESQ.**

TONI DEMBSKI-BRANDL, ESQ. declares as follows:

1. I am Senior Counsel for the Opposer, Target Brands, Inc. ("Target Brands"), and am the in-house attorney principally responsible for this matter. As such, I am fully familiar with the facts set forth herein.

2. Target Brands is the intellectual property holding company for Target Corporation ("Target Corp."), the entity that runs the well known discount retail stores and internet business, target.com.

3. I am responsible for maintaining and protecting a variety of Target Brands' trademark and intellectual property rights, including its right to use the laudatory and descriptive term "Ultimate" in connection with clothing, and more specifically, Target Brand's right to use "Ultimate Polo" in connection with polo shirts.

4. In connection with my responsibilities, I directed our outside counsel, Lowenstein Sandler PC, to institute this Opposition proceeding against the applicant, Shaun N.G. Hughes (the "Applicant"), to prevent the Applicant from registering ULTIMATE POLO as a trademark for sun-protective shirts. Target Brands believes that the Applicant's registration of this merely descriptive mark would be detrimental to Target Brands' right to use the same terminology in connection with its shirts.

5. In connection with this Opposition proceeding, I have learned that the Applicant claims that its ULTIMATE POLO designation has acquired distinctiveness and secondary meaning sufficient to entitle it to federal trademark registration. I also understand that the Applicant is seeking to prove distinctiveness and secondary meaning on the basis of having made a large number of sales and advertising expenditures over a number of years.

6. It is, thus, essential that I be able to consult with both my outside counsel, and the attorneys that I work with at Target Brands, regarding the specifics of the Applicant's evidence of secondary meaning, and the overall strength of its claim. Nevertheless, I understand that the Applicant has insisted that no attorneys employed by Target Brands be entitled to review this critical evidence.

7. As in-house counsel for Target Brands, I provide counsel only with respect to intellectual property matters and international trade and customs matters. In addition, I work with Mr. Stephen Lee, also Senior Counsel for Target Brands, who concentrates on both trademark and patent matters. If I were out of the office for an extended period of time, Mr. Lee would be expected to assume all of my responsibilities in this matter.

8. Further, my supervisor is Michael Wahlig, the Vice President of Law of at Target Corp and Secretary of Target Brands. Mr. Wahlig reports to Mr. Tim Baer, the President of Target Brands and Senior Vice President and General Counsel of Target Corp.

9. Although Mr. Wahlig and Mr. Baer have, thus far, not been directly involved in the management of this Opposition proceeding, their advice may be necessary when important decisions need to be made, e.g., whether Target Brands should agree to settle this case. It would be highly unusual (and interfere with Target Brands' attorney-client relationship with its counsel) for me to not be able to fully consult with my superiors in the handling of this matter, should it be necessary to do so.

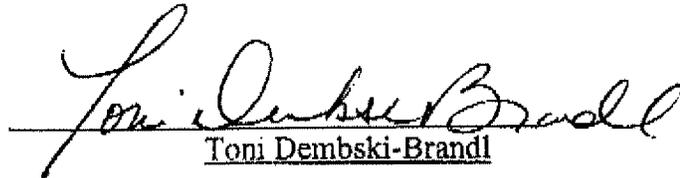
10. Mr. Wahlig, Mr. Baer and Mr. Lee serve exclusively in the role of attorneys, providing legal advice for both Target Brands and Target Corp. The only "business" responsibilities that I have, beyond my primary role as counsel, is that I am responsible for the

acquisition and disposition of intellectual property. Neither I, nor my colleagues identified above, have any responsibility for marketing, pricing, product development, design, or any other type of competitive decision-making.

11. Neither Target Corp., nor Target Brands sells (nor has any current plant to sell) sun-protective clothing, and thus, we are not competitors of the Applicant. Nevertheless, Mr. Wahlig, Mr. Baer, Mr. Lee and I are fully prepared to keep the Applicant's designated information confidential and not disclose the information in accordance with the protective order negotiated by our outside counsel, or by any other protective order entered by the Board.

DECLARATION

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

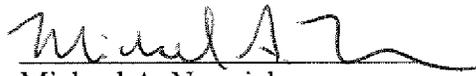

Toni Dembski-Brandl

Dated: July 27, 2005

Certificate of Transmission

I hereby certify that Opposer's Opposition to Applicant's Motion For Entry of Protective Order and Cross-Motion for Entry of a Protective Order and Other Relief are being electronically transmitted to the United States Patent and Trademark Office

On July 27, 2005


Michael A. Norwick

Certificate of Service

I hereby certify that a true and complete copy of the Opposer's Opposition to Applicant's Motion For Entry of Protective Order and Cross-Motion for Entry of a Protective Order and Other Relief has been served on James R. Uhlir, Esq., by mailing said copy on July 27, 2005, via facsimile and First Class Mail, postage prepaid to:

James R. Uhlir, Esq.
Christensen, O'Connor, Johnson, Kindness, LLC
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347

On July 27, 2005


Michael A. Norwick