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

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| Proceeding | 91163556 |
| Party | Plaintiff TARGET BRANDS, INC. , |
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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

Target Brands, Inc. ,

Opposer,

v.

Shaun N.G. Hughes,

Applicant.

Opposition No. 91163556

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

The Applicant, unable to identify any legitimate basis for distinguishing between in-house and outside counsel in its proposed protective order, as required under U.S. Steel v. United States, 730 F.2d 1465 (Fed. Cir. 1984), and unable to articulate any potential harm that could come to it by entry of the Opposer's proposed protective order terms, has extraordinarily sought to *substitute its judgment*, for that of Target Brands, regarding what the scope and nature of the retention of Target Brands' outside and in-house counsel should be, how many attorneys Target Brands may assign to this matter, and which attorneys should be allowed to form a legal opinion regarding the single most import issue in this case. Inappropriately injecting itself into Target Brands' attorney-client relationships, the Applicant erroneously presumes to know "precisely the work for which outside counsel has been retained" and that if Target Brands determines that a second opinion regarding the strength of the Applicant's secondary meaning claim is warranted, it could only be "duplicative of outside counsel's opinion and unnecessary." App. Br. at 2. To the contrary, of course, it is solely within Target Brands' discretion to decide who and for what purpose to employ legal counsel in this matter -- and certainly not -- within the province of Target Brand's *adversary* to dictate how many attorneys, and which attorneys, are necessary to evaluate the Applicant's claims. Absent any demonstration of good cause for

denying Target Brands' right to the unencumbered advice of its chosen counsel -- and the Applicant has made no such showing -- there is no basis for excluding in-house counsel from participating equally in evaluating the strength of the Applicant's secondary meaning claim -- which necessitates in-house counsel having access to the Applicant's sales and advertising data.

While it is commonplace for protective orders to broadly provide for "attorneys eyes only" confidentiality to be maintained by *any* attorney of the client's choosing, Target Brands has taken the extraordinary step of only seeking access for a limited number of specifically identified in-house attorneys that could *possibly* need to view the information. As reflected in the Declaration of Toni Dembski-Brandl, Esq. ("Dembski Decl."), Ms. Dembski-Brandl is the "in-house attorney principally responsible for this matter" and she and outside counsel may very well review the evidence in this case without the assistance of other in-house attorneys. The stated reason for requesting that a few other attorneys be authorized to view the information was solely in the event that Ms. Dembski-Brandl needed to seek guidance from more senior attorneys at Target Brands, or in the event she were out of the office for an extended period of time. Dembski Decl. ¶¶ 7-9.

The Applicant has distorted Target Brands' limited request to preauthorize four specifically identified in-house attorneys to view the Applicant's evidence of secondary meaning by misrepresenting that Target Brands wishes to have "every in-house attorney . . . review every document." App. Br. at 2. To the contrary, Target Brands simply needs to permit the in-house attorney principally responsible for this matter to access the information and allow for reasonable back-up by the other in-house attorneys in the chain-of-command. If Target Brands had requested that Ms. Dembski-Brandl be the sole in-house attorney authorized to access the information, it would be left in the awkward position of having to *request permission* of the Applicant and/or the Board any time Ms. Dembski-Brandl needs to consult with her own superiors regarding the specifics of this matter -- a burden that would unjustifiably interfere with Target Brands' attorney-client relationships.

Moreover, contrary to the Applicant's misreading of the Federal Circuit's U.S. Steel decision, no where in that opinion does the court ever state that whether or not outside counsel have been retained is a factor in the determination of whether in-house counsel should be permitted to access confidential documents. Indeed, just the opposite is true, since the Federal Circuit stated that "access should be denied or granted on the basis of *each individual counsel's actual activity and relationship with the party represented, without regard to whether a particular counsel is in-house or retained.*" U.S. Steel, 730 F.2d at 1469 (emphasis added).¹ Notably, other courts, following the Federal Circuit, have looked to the factors emphasized in the U.S. Steel decision, e.g., each individual in-house counsel's involvement in competitive decision making, and gave no weight or mention to the fact that the party seeking discovery had also retained outside counsel. See Carpenter Technology Corp. v. Armco, Inc., 132 F.R.D. 24 (E.D. Pa. 1990); United States v. Dentsply International, Inc., 187 F.R.D. 152 (D. Del. 1999). Here, the Applicant is requesting exactly what the U.S. Steel court expressly prohibited, the "denial of access sought by in-house counsel on the sole ground of their status as in-house counsel . . ." 730 F.2d at 1469.

Here it is undisputed that the in-house counsel at issue are not involved in competitive decision making at Target Brands (see Dembski Decl., ¶ 10), and pose no risk to the Applicant whatsoever, particularly in light of the undeniable fact that Target and the Applicant *are not competitors*. Indeed, the Applicant's entire claim of potential harm is based upon the fanciful speculation that Target will, someday, "be a competitor in the future." The Applicant's

¹ Notably, while the Applicant relies upon the Federal Circuit's commentary about "Inadvertence" not "respect[ing] . . . its victims," it takes this statement out-of-context by omitting the preceding three sentences:

Like retained counsel, however, in-house counsel are officers of the court, are bound by the same Code of Professional Responsibility, and are subject to the same sanctions. In-house counsel provide the same services and are subject to the same pressures as retained counsel. The problem and importance of avoiding inadvertent disclosure is the same for both. U.S. Steel, at 1468.

unspecified and vague assertion that disclosure of its sales and advertising expenditures to “potential competitors such as Target, would be highly damaging to [the Applicant]” (Declaration of Shaun N.G. Hughes, ¶ 4) is legally insufficient to obtain the exceedingly broad protection that it has requested. As a number of courts recognize, “[g]ood cause exists when disclosure will result in a clearly defined and serious injury . . . [and] [t]he litigant seeking the protective order must articulate the injury with specificity.” See Dentsply, 187 F.R.D. at 158 (citing Pansy v. Borough of Stroudsburg, 23 F.3d 772, 778 (3d Cir. 1994)). Therefore, “[b]road allegations of harm, unsubstantiated by specific examples, do not support a showing of good cause.” Id. (citing Cipollone v. Liggett Group, Inc., 785 F.2d 1108 (3d Cir. 1986)).

Moreover, notwithstanding the Applicant’s contention that it would be subject to the same disadvantage as Target Brands in this matter, (App. Br. at 4), this is simply not the case. The resolution of this entire dispute hinges upon the strength of the Applicant’s claim of secondary meaning for “Ultimate Polo.” All of the evidence of the Applicant’s secondary meaning contention, including the sales and advertising data at issue, are within the exclusive control of the Applicant. Thus, the Applicant and his outside counsel, and any other attorney he should choose to hire, are free to discuss the strengths and weaknesses of this case without restriction. While the Applicant has asked for Target Brands’ sales and advertising information, and Target Brands may produce this information pursuant to the protective order simply to avoid further disputes, it simply has no relevance to whether the Applicant’s applied for mark has acquired secondary meaning, or any other issue in this Opposition proceeding. Target Brands does not claim a trademark in “Ultimate Polo” -- it only claims that the term is descriptive, cannot be trademarked, and is free to be used by anyone. Accordingly, only the Applicant’s evidence of distinctiveness is relevant to these proceedings, and Target Brands should be free to consult with the attorneys of its choosing on this issue, absent the Applicant coming forward with some compelling reason to exclude particular attorneys. The Applicant has utterly failed to come forward with any such reasons.

CONCLUSION

For the reasons set forth above, and the reasons set forth in Opposer's Opposition To Applicant's Motion For Entry of Protective Order and Cross-Motion For Entry of a Protective Order and Other Relief, 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,

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ATTORNEYS FOR TARGET BRANDS,
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By: Michael A. Norwick/
Michael A. Norwick, Esq.

Dated: August 29, 2005

Certificate of Transmission

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

On August 29, 2005 
Michael A. Norwick

Certificate of Service

I hereby certify that a true and complete copy of the Opposer's Reply to Applicant's Opposition to Cross-Motion for Entry of a Protective Order and Other Relief has been served on James R. Uhlir, Esq., by mailing said copy on August 29, 2005, via facsimile and First Class Mail, postage prepaid to:

James R. Uhlir, Esq.
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1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347

On August 29, 2005 
Michael A. Norwick