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

Proceeding	91171281
Party	Plaintiff PomWonderful LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

POMWONDERFUL LLC

Opposer,

v.

JARROW FORMULAS, INC.,

Applicant.

Opposition No.: 91171281

**OPPOSER’S OPPOSITION TO
APPLICANT’S MOTION TO MODIFY
THE STANDARD PROTECTIVE
ORDER**

Marks and Related (Consolidated) Proceedings:

Opp. No. 91171281 (Parent) re POM~~MAZING~~

Opp. No. 91191283 re POME GREAT

Opp. No. 91171284 re POME SYNERGY

Opp. No. 91173117 re POME OPTIMIZER

Opp. No. 91173118 re POME GUARD

Opp. No. 91186414 re POME ZOTIC

Opp. No. 91191995 re PRICKLYPOM

Opp. No. 91194226 re POM and POM

**OPPOSER’S OPPOSITION TO APPLICANT’S MOTION TO MODIFY THE
STANDARD PROTECTIVE ORDER**

Jarrow Formulas Inc.’s (“Jarrow”) sole purpose for wanting the Panel to adopt *its* version of the Protective Order is to prevent the Roll Law Group (“RLG”) from reviewing its confidential material. If Jarrow is successful, Opposer POM Wonderful LLC (“POM”) will be forced to retain new counsel for purposes of reviewing Jarrow’s documents, driving up POM’s costs and making this matter prohibitively expensive for POM. That is exactly what Jarrow hopes for. However Jarrow’s Motion to Modify the Standard Protective Order (“Motion”) must be denied. Jarrow’s Motion is premised on the fact that because RLG is POM’s in-house counsel, it should be limited to reviewing only certain kinds of Jarrow’s confidential information.

First, RLG is not POM’s in-house lawyers. Nonetheless, RLG’s designation is

immaterial. The only time counsel—be they in-house or outside counsel—can be precluded from reviewing confidential material is if they are “competitive decisionmakers.” The attorneys of record at RLG are not competitive decisionmakers. Similarly Jarrow wants to have new designations for its confidential material (“Trade Secret/Commercially Sensitive” as opposed to “Highly Confidential”), for purposes of precluding RLG from reviewing such material. Again, what the designation of a document is does not help Jarrow’s Motion. Whether RLG is a “competitive decisionmaker” determines whether Jarrow’s Motion must be granted or not. For the reasons set forth below, Jarrow’s Motion should be denied and its version of the Proposed Protective Order should be rejected by this Panel.

I. NONE OF RLG’S COUNSEL ARE “DECISIONMAKERS”, THEREFORE THEY CANNOT BE PRECLUDED FROM REVIEWING JARROW’S CONFIDENTIAL INFORMATION

Jarrow argues that RLG should not be able to see Jarrow’s confidential documents because “RLG effectively functions as in-house counsel” for POM (Motion p. 2) Jarrow points to almost no authority in support of its position, and the authority it does cite, actually supports a *denial* of its Motion. Jarrow seeks to broaden the meaning of “in-house counsel” to include not only those who are employed by a party, but also those who are also “affiliates” of a party. (See Motion . 2) In support of its Motion, Jarrow points to two protective orders in other cases, where the parties decided that in-house counsel should be defined as “any attorney who is an employee of a party, or of an entity under common control of a party, who is responsible for managing litigation for the party.” Based on this definition, which Jarrow approvingly cites, RLG would not be considered in-house counsel. The counsel of record at RLG are not employees of POM. Nor is RLG under the common control of POM. RLG is licensed by the State Bar of California as a law firm, which is independently owned and managed from POM and which provides services to third parties. (See Declaration of Danielle Criona filed in Support of POM’s Motion Requesting Entry of Opposer’s Proposed Protective Order)

Even though these protective orders undermine Jarrow's Motion, the Panel should not be looking at samples of other protective orders to determine whether RLG is an in-house counsel or not in order to decide whether RLG can review Jarrow's confidential documents. There is well established precedent on whether an attorney is able to review an opposing party's confidential documents. Either intentionally or as a result of inadequate research, Jarrow has not cited to any of these cases, all of which are fatal to Jarrow's Motion.

In the seminal case dealing with the issue of who can review confidential documents of an opposing party, the U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed. Cir. 1984) court held "that status as in-house counsel cannot alone create that probability of serious risk to confidentiality and cannot therefore serve as the sole basis for denial of access." Id. at 1468. Therefore whether POM's attorneys of record at RLG are in-house counsel or outside counsel or something in between does not determine what documents they can review. Rather "the factual circumstances surrounding each individual counsel's activities, association, and relationship with a party, whether counsel be in-house or retained, must govern any concern for inadvertent or accidental disclosure." U.S. Steel Corp., at 1467-68.

Moreover, "[t]he counsel-by-counsel determination should turn on the extent to which counsel is involved in 'competitive decisionmaking' with its client." ActiveVideo Networks, Inc. v. Verizon Communications, Inc., 274 F.R.D. 576, 579 (E.D. Va. 2010) *citing In Re Deutsche Bank Trust Co. Ams.*, 605 F.3d at 1373, 1378 (Fed. Cir. 2010); U.S. Steel, *supra* at 1468. Simply put, if the attorney seeking to review confidential documents of opposing counsel is a competitive decision maker, they cannot review such documents, otherwise they are not prohibited from doing so.

"Competitive decisionmaking is shorthand for a counsel's activities, association, and relationship with a client that are such as [sic] to involve counsel's advice and participation in any or all of the client's decisions (pricing, product design, etc.) made in light of similar or corresponding information about a competitor." ActiveVideo Networks, Inc., at 579, citing to

U.S. Steel, 730 F.2d at 1468 n. 3. (internal quotes omitted). U.S. Steel defined competitive decisionmaking as “in-house counsel’s role, if any, in making company decisions that affect contracts, marketing, employment, pricing, product design or any or all of the client’s decisions...made in light of similar or corresponding information about a competitor.” (See e.g. Amgen, Inc. v. Elanex Pharmaceuticals, Inc., 160 F.R.D. 134, 139 (W.D. Wash. 1994) in-house counsel for party could examine documents covered by protective order even though that party had a sizeable cadre of outside lawyers allegedly making in-house review unnecessary, but opposing party conceded that in-house counsel did not participate in any competitive decisionmaking; Carpenter Tech. Corp. v. Armco Inc., 132 F.R.D. 24, 27–28 (E.D. Penn. 1990) one in-house attorney could examine documents covered by protective order when he averred that he “had absolutely no involvement” in competitive decisionmaking; Glaxo Inc. v. Genpharm Pharmaceuticals, Inc., 796 F.Supp. 872, 874 (N. Carolina 1992) party's in-house counsel of twenty-eight years could examine documents covered by protective order when he attested that he gave no advice to party on “competitive decisions such as pricing, scientific research, sales or marketing”).

None of the counsel of record at RLG are competitive decision makers. (See Declaration of Danielle Criona submitted concurrently herewith.) The attorneys who will be reviewing Jarrow’s documents do not make decisions that affect contracts, marketing, employment, pricing or product design. Id. Nor do they make any corresponding decisions about POM or its competitors. Id.

The bar for what actually constitutes “competitive decisionmaking” is high. For example in ActiveVideo Networks, Inc., *supra*, an in-house counsel that opposing party wanted to exclude from reviewing its confidential material was John Thorne, Verizon’s Senior Vice President and Deputy General Counsel responsible for litigation of anti-trust, intellectual property and telecommunication cases. Id. at 580. Thorne was also an officer and director of two Verizon affiliates. Id. Thorne provided an affidavit indicating that he had no competitive

decision making responsibilities. ActiveVideo offered evidence that Thorne was involved in corporate mergers on behalf of Verizon, and argued that such involvement amounted to competitive decisionmaking. Id. The court found that “although by its very nature, Mr. Thorne’s role as an antitrust lawyer involves advice and participation in decisions *about competition*, it does not necessarily implicate his involvement in ‘competitive decisionmaking’ – i.e. ‘decisions...made in light of similar or corresponding information about a competitor.’” Id. (italics in original).

Activision also offered evidence of Thorne making a PowerPoint presentation in which Thorne participated with another individual in presenting a report on intellectual property rights management. Id. While the content of the presentation was redacted, the Court found that such a presentation, without more did not constitute competitive decision making. Id.

Finally Activision offered correspondence which Thorne was copied on, appearing to concern agendas for a Motorola Executive Meeting and a “network council meeting”. ActiveVideo argued this was evidence that Thorne was involved in “sourcing and strategic planning regarding competition in the cable market.” Id. at 581. The court found that while the authors of the correspondence may have been decisionmakers, nothing in the email correspondence suggested that Thorne was as well. “Mere correspondence with competitive decisionmakers or attendance at competitive decisionmaking meetings does not itself constitute competitive decisionmaking.” Id.

None of RLG’s attorneys of record in this case are as senior as Thorne, have nearly as much authority as Thorne apparently did, or are as close to decisionmakers as Thorne was. If the Court found Thorne not to be a decisionmaker, a finding that RLG’s attorneys are not decisionmakers is an inescapable and logical conclusion.

While competitive decisionmaking is the *sine qua non* of whether in-house counsel can review competitor’s confidential material, other factors also favor a denial of Jarrow’s Motion. POM’s only counsel is RLG. POM does not have additional outside counsel who can review

Jarrow's confidential material. If this Panel were to find that RLG's attorneys are competitive decisionmakers and therefore cannot review Jarrow's confidential documents, this would force POM to hire additional outside counsel specifically for this purpose. Simply because POM can hire outside counsel to act as an intermediary is irrelevant. "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." ActiveVideo, *supra* at 579.

Even if POM already had outside counsel, this should not impact the Panel's decision. Simply because a party has "retained a sizable cadre of outside lawyers does not support barring in-house attorneys from accessing protected confidential information." See ActiveVideo, *supra* at 584; Amgen, Inc., *supra* 137-138.

Jarrow's Motion requesting this Panel to change the language of the Protective Order such that the definition of "in-house counsel" includes RLG is completely irrelevant to the issue of whether RLG is able to review Jarrow's documents. As such Jarrow's proposed language in its Proposed Protective Order should not be adopted by this Panel.

II. JARROW SEEKS TO RE-LABEL THE CONFIDENTIALITY LEVEL OF DOCUMENTS SO AS TO PREVENT RLG FROM REVIEWING THEM

Jarrow's proposed Protective Order also seeks to have two different types of confidentiality – one, "Confidential Information" and the other "Trade Secret/Commercially Sensitive Information" instead of the customary "Highly Confidential" designation. (See Jarrow's Proposed Protective Order p. 2) Jarrow's Motion explains that the reason for this change is because "the Standard Protective Order draws no distinction between the designations 'Confidential' and 'Highly Confidential' except as may be agreed upon by the parties." (Motion p. 4) However, this explanation is a red herring – there will be just as much disagreement between POM and Jarrow over what constitutes a "Trade Secret/Commercially Sensitive Information" as to what constitutes "Highly Confidential" information. Therefore Jarrow's proposal does not provide any clarity to the alleged ambiguity that it believes exists.

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**DECLARATION OF DANIELLE M.
CRIONA IN SUPPORT OF OPPOSER'S
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**DECLARATION OF DANIELLE M. CRIONA IN SUPPORT OF OPPOSER'S
OPPOSITION TO APPLICANT'S MOTION TO MODIFY THE STANDARD
PROTECTIVE ORDER**

I, Danielle M Criona, hereby declare as follows:

1. I am counsel of record for Opposer POM Wonderful LLC ("POM") and a member in good standing of the State Bar of California.
2. The facts set forth below are of my personal knowledge or on information contained in the company's business records made and maintained in the usual course of business to which I have access. If called as a witness, I could and would testify competently to such facts under oath.
3. I am the primary and most senior attorney at Roll Law Group who is handling this matter. I am not involved in competitive decision making at POM or any affiliated entities.

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

At the time of service, I was over 18 years of age and not a party to this action. I am employed in the County of Los Angeles, State of California. My business address is 11444 West Olympic Boulevard, Los Angeles, CA 90064-1557.

On October 8, 2012, I served true copies of the following document(s) described as

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO MODIFY THE STANDARD PROTECTIVE ORDER;

DECLARATION OF DANIELLE M. CRIONA IN SUPPORT OF OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO MODIFY THE STANDARD PROTECTIVE ORDER

on the interested parties in this action as follows:

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BY MAIL: I enclosed the document(s) in a sealed envelope or package addressed to the persons at the addresses listed in the Service List and placed the envelope for collection and mailing, following our ordinary business practices. I am readily familiar with Roll Law Group PC's practice for collecting and processing correspondence for mailing. On the same day that the correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service, in a sealed envelope with postage fully prepaid.

BY E-MAIL OR ELECTRONIC TRANSMISSION: I caused a copy of the document(s) to be sent from e-mail address estratte@roll.com to the persons at the e-mail addresses listed in the Service List. The document(s) were transmitted at approximately 5:30 p.m. I did not receive, within a reasonable time after the transmission, any electronic message or other indication that the transmission was unsuccessful.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on October 8, 2012, at Los Angeles, California.

/s/ Erin Stratte

Erin Stratte