

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 17, 2012

**Opposition No. 91171281
(parent case)**

Opposition No. 91171283

Opposition No. 91171284

Opposition No. 91173117

Opposition No. 91173118

Opposition No. 91186414

Opposition No. 91191995

Opposition No. 91194226

PomWonderful LLC

v.

Jarrow Formulas, Inc.

Jennifer Krisp, Interlocutory Attorney:

These consolidated opposition proceedings are before the Board for consideration of the parties' filings of their respective motions for the Board's acceptance of a proposed protective order. The parties have filed oppositions to the respective motions and proposed protective orders.¹

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a). On October 15, 2012, the Board convened a telephone conference to resolve the issue(s) presented in

¹ Opposer's change of correspondence, filed October 9, 2012, is noted and is entered.

the motion. Participating were opposer's counsel Michael Vasseghi, Esq., applicant's counsel Mark Giarratana, Esq., and the assigned interlocutory attorney.

The Board has reviewed the parties' arguments and submissions, but for efficiency does not restate them herein. This order summarizes the Board's determinations based on the briefs, and any clarifications provided by respective counsel during the conference.

Having previously sought settlement during several sequential periods of suspension, the parties agree that proceedings are to resume, and that discovery is to be reset for a six month period. Each party asserts that a modification of the Board's standard protective is desired, and each has filed for the Board's approval a proposed protective order which is, in certain respects, an alternative to the Board's standard protective order (SPO).

The applicable rule, Trademark Rule 2.116(g) provides, in pertinent part:

The Trademark Trial and Appeal Board's standard protective order is applicable during disclosure, discovery and at trial in all opposition, cancellation, interference and concurrent use registration proceedings, unless the parties, by stipulation approved by the Board, agree to an alternative order, or a motion by a party to use an alternative order is granted by the Board ... No material disclosed or produced by a party, presented at trial, or filed with the Board, including motions or briefs which discuss such material, shall be treated as confidential or shielded from public view unless designated as protected under the Board's standard protective order, or under an alternative order stipulated to by the parties and

approved by the Board, or under an order submitted by motion of a party granted by the Board.

Counsel clarified that the parties have not previously addressed the issue of a protective order in any other terminated or pending Board proceeding or civil action. With respect to the issues before the Board, central to its analysis is whether good cause has been demonstrated to amend the SPO in either of the manners proposed. Two interrelated provisions of the proposed orders are contested.

Under the SPO, information and documents designated as trade secret/commercially sensitive are to be "restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties" (SPO, para. 1). In these consolidated proceedings, applicant raises the issue of the definition of in-house counsel and in particular whether Roll Law Group, PC is in-house counsel to opposer, such as to limit opposer's attorneys' access to documents and information designated or to be designated by applicant as trade secret/commercially sensitive (or a similar outside-counsel-only designation). Applicant asserts that Roll Law Group, PC effectively functions as in-house counsel for opposer.

On the basis of the briefs of record, declarations of counsel, and clarifications provided during the conference, applicant has not shown good cause on which the Board can find that Roll Law Group, PC is in-house counsel to opposer, PomWonderful LLC. Opposer's counsel has made a satisfactory showing and explanation that Roll Law Group, PC and its attorneys function independently from and are not under common control with opposer, have no common interests with opposer, do not have ownership interest in opposer, are not affiliates of opposer, and do not hold a position of employment (regular or otherwise) or any other position with opposer.²

In view thereof, the Board declines to accept applicant's proposed definition of in-house counsel which would include and encompass Roll Law Group, PC.

With respect to the second contested issue, which is the various manners under which either party can opt to designate information and documents during these consolidated proceedings, it is initially noted that the SPO provides for three such designations: "confidential," "highly confidential" and "trade secret/commercially sensitive."

² In view of the Board's findings, it need not resolve the issue of whether Roll law Group, PC is involved in employer-litigant's "competitive decision making," or is otherwise restricted access to information and materials which may carry a designation under which access is limited to outside counsel. *See U.S. Steel Corp. v. United States*, 730 F.2d 1465 (Fed. Cir. 1984). *See also* TBMP § 412.02(b). Nonetheless, discussion was held on this point during the conference.

Related in part to its assertion that Roll Law Group, PC is or functions as in-house counsel to opposer, applicant proposes that the parties adopt a protective order whereunder they may designate information and documents as either "confidential" or "trade secret/commercially sensitive," to provide more clarity than the designation "highly confidential" with respect to the threshold of sensitivity. For its part, opposer proposes that the designation "highly confidential information" be available for information that is highly sensitive (in place of the "trade secret/commercially sensitive" category).

The Board finds that neither party has demonstrated good cause to alter the SPO in the manner it proposes, and neither has shown that elimination or substitution of the middle-tier "highly confidential" designation is warranted for these proceedings. The SPO defines such material as "Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys." The Board provided various examples of information and documents which typically are properly designated as such in inter partes proceedings, and referred counsel to relevant case law on this point.

Accordingly, the three possible designations set forth in the SPO stand: confidential, highly confidential, and trade secret/commercially sensitive. As noted during the conference,

it is ultimately the extent to which the parties cooperate with each other during discovery - a component of which is the accuracy of the designations themselves - which determines whether any restrictions or limitations on access to information and documents are appropriately formed.

In view of the Board's findings, applicant's motion is denied. Opposer's motion is granted to the extent that the protective order filed by opposer on September 21, 2012, at docket entry #62 herein, and appendices, shall govern these consolidated proceedings, with the exception that the first three sentences of Paragraph 9 thereof shall read as follows:

At the conclusion of the Action, all Confidential, Highly Confidential or Trade Secret/Commercially Sensitive information under this Order and not received in evidence, and all copies thereof, shall be returned to the originating Party within ninety (90) calendar days. If the Parties so stipulate, the materials may be destroyed and certified destroyed instead of being returned. Counsel for the parties may only retain one copy of pleadings filed for archival purposes, but may not otherwise keep any other Confidential, Highly Confidential or Trade Secret/Commercially Sensitive information...

Schedule

Proceedings are deemed to have been suspended as of September 21, 2012, and are now resumed. The parties are allowed until thirty (30) days from the date of the conference in which to serve responses to any outstanding discovery.

As noted in the December 10, 2009 order, all proceedings except Opposition Nos. 91186414, 91191995 and 91194226 are

governed by the Trademark Rules of Procedure that were in place prior to November 1, 2007. For the proceedings governed by the more recent (current) Rules of Procedure, the parties are to be mindful of the reciprocal duties of disclosure imposed by said Rules (see schedule below, insofar as it sets disclosure deadlines). Discovery and trial dates are reset as follows:³

Expert Disclosures Due	3/13/2013
Discovery Closes	4/12/2013
Plaintiff's Pretrial Disclosures due	5/27/2013
Plaintiff's 30-day Trial Period Ends	7/11/2013
Defendant's Pretrial Disclosures due	7/26/2013
Defendant's 30-day Trial Period Ends	9/9/2013
Plaintiff's Rebuttal Disclosures due	9/24/2013
Plaintiff's 15-day Rebuttal Period Ends	10/24/2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

³ In view of the parties' indications that they anticipate possibly taking extensive further discovery, the Board, in its discretion, resets the expert disclosures deadline.

In the event that the parties file a motion to suspend or extend any of these dates, they remain under obligation to support any such motion with a detailed report of the reasons therefor, including details of settlement efforts, if any. For

further explanation of this requirement, the parties are referred to the Board order issued December 7, 2010.