

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

Mailed: December 22, 2008

Opposition No. 91181969

Fetch, Inc.

v.

Societe des Produits Nestle
S.A.

Linda Skoro, Interlocutory Attorney

This case now comes up on opposer's motion challenging applicant's designation as "Trade Secret/Commercially Sensitive" information to five interrogatory responses.¹ Opposer contends that these designations are inappropriate because the answers basically do not contain any competitive information.² In response, applicant contends that it will be entering the market, will be a direct competitor of opposer and disclosure would cause competitive harm to applicant.

¹ Responses to Interrogatories numbered 8-10, 15 and 17. The trade secret designation was withdrawn as to interrogatory number 3.

² Opposer states the interrogatory responses either mirror applicant's recitation of services; that because no use of the mark has been made yet, there are no marketing materials; or advertising expenditures at this time.

It is important to note that the Board's standard protective order governs this proceeding.³ The Board's standard protective order allows both in-house and retained (outside) attorneys for the parties to have access to information designated as "confidential or highly confidential", but only retained attorneys are granted access to information designated as "trade secret/commercially sensitive."⁴ The Board's standard order provides for a three-tiered classification system with in-house counsel having access to all "confidential or highly confidential" information and only being shielded from trade secrets and commercially sensitive information. If applicant classifies its documents properly, it should be comfortable that its "most sensitive" information is protected, and at the same time opposer will be provided

³ Parties are free to agree to a substitute protective order or to supplement or amend the standard order, subject to Board approval, but modification is not required.

⁴ Applicant may wish to review Section 414 of the Trademark Trial and Appeal Board Manual of Procedure (2d ed. rev. 2004) for examples of items found to be discoverable. For instance, names of customers are confidential information and generally are not discoverable, even under a protective order. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). A party's plans for expansion may be discoverable under a protective order, *id.* at 233, and while annual sales and advertising figures are proper matters for discovery, if the responding party considers such information to be confidential, disclosure may be made under a protective order. See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985).

with the discovery it needed, only keeping a small, select⁵ category of information from its in-house counsel.

In this case both parties are being represented by competent outside counsel from the inception of this proceeding.⁶ Outside counsel should be fully able to understand the issues and convey the same to their client to allow them to sufficiently evaluate an offer of settlement and make the appropriate recommendations, without disclosing sensitive business information.⁷

Having reviewed applicant's claimed "trade secret/commercially sensitive" interrogatory responses, the Board does not see that the information provided at this point rises to the level of "confidential" let alone "trade secret". If and when there are responsive documents or

⁵ The parties are reminded that genuine trade secrets form a very narrow category of records. See Section 1(4) of the Uniform Trade Secret Act (UTSA), which defines a trade secret as:

information, including a formula, pattern, compilation, program device, method, technique, or process, that: (i) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and (ii) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.

⁶ See *Intel Corp. v. VIA Technologies, Inc.*, 198 F.R.D. 525, 528-29 (N.D. Cal. 2000).

⁷ Applicant seems to contend that the standard agreement allows for sensitive business information to be easily exploited by opposer. If applicant is concerned about opposer not abiding by the terms of the agreement, it should have both parties execute

information that is "confidential", e.g., advertising expenditures or marketing materials, they would not be properly classified as trade secret, but rather "confidential" or "highly confidential". Should there be "corporate plans" or license agreements which may conceivably be considered commercially sensitive, they are still covered by the protective agreement and would be allowed to be seen only by outside counsel.

Accordingly, proceedings are resumed and the remaining trial dates are reset as indicated below:

Expert Disclosures Due	March 14, 2009
Discovery Closes	April 13, 2009
Plaintiff's Pretrial Disclosures	May 28, 2009
Plaintiff's 30-day Trial Period	
Ends	July 12, 2009
Defendant's Pretrial Disclosures	July 27, 2009
Defendant's 30-day Trial Period	
Ends	September 10, 2009
Plaintiff's Rebuttal Disclosures	September 25, 2009
Plaintiff's 15-day Rebuttal Period	
Ends	October 25, 2009

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.

the agreement so it may pursue a potential breach of contract in

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NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

district court.