

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

Mailed: May 4, 2009

Opposition No. 91184529

Georgia-Pacific Consumer
Products LP

v.

Global Tissue Group, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceedings is before the Board for consideration of (1) opposer's motion (filed January 16, 2009) for protective order, (2) opposer's motion (filed January 21, 2009) to extend discovery, and (3) applicant's motion (filed January 30, 2009) to compel discovery. The motions are fully briefed.

Opposer's motion for protective order

Opposer seeks an order entering and making applicable to this proceeding its modified standard protective order entitled Stipulated Confidentiality and Protective Order ("Proposed Order"), which differs from the Board's standard protective order inasmuch as it defines "attorneys" as including specific named in-house counsel for each of the parties, identified by name and title, and support staff operating under the direction of said in-house counsel. Opposer submitted a declaration of each of its two identified in-house counsels attesting, among other things, that neither engages in competitive decisionmaking for opposer and neither engages in business

decisions relating to the pricing, marketing or technical design of opposer's products.

Applicant asserts, *inter alia*, that opposer's Proposed Order is a significant departure from the Board's standard order, that opposer has failed to demonstrate that its in-house counsel are so removed from opposer's competitive decisionmaking process as to warrant their access to trade secret or commercially sensitive information of applicant, a direct competitor, and that applicant's trade secret or commercially sensitive information is wholly outside the scope of the merits of this proceeding.

As the parties are aware, by operation of Trademark Rule 2.116(g), the Board's standard protective order has been applicable in this proceeding since its commencement, and remains applicable 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. See Trademark Rule 2.116(g); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044 (TTAB 2008). At issue is an alternative order, presented in the context of a motion for protective order, which defines "attorneys for parties" so as to allow named in-house counsel for both parties to access all documents produced in discovery.

Upon holding that status as in-house counsel cannot alone create a probability of serious risk to confidentiality and cannot therefore serve as the sole basis for determining the opportunity for inadvertent disclosure of or denial of access

to confidential information, the United States Court of Appeals for the Federal Circuit adopted an approach whereby the issue can be determined "by the facts on a counsel-by-counsel basis." See *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed. Cir. 1984). Specifically, the court stated that whether a litigant's in-house counsel may gain access to confidential documents turns on whether that in-house counsel is involved in the litigant's competitive decisionmaking, and defined "competitive decisionmaking" as "counsel's activities, association, and relationship with a client that are such as 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." *Id.*

Inasmuch as a presumption-based approach, namely, one which would exclude certain counsels merely on the basis of their status as in-house counsel as opposed to retained counsel, has not been advanced by our reviewing court, the Board must look to the record before it for an indication of each in-house counsel's actual activity and relationship with its relevant party. See *U.S. Steel, supra*, at 1469. In particular, the Board looks for a sufficient showing that in-house counsel are not involved in the competitive decisionmaking process. Cf. *Georgia Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1953 (TTAB 2006).

In this proceeding opposer, as movant, by making of record the declarations under oath of each of its in-house counsel named in the Proposed Order, has provided sufficient information from which the Board is able to conclude that said in-house counsels do not engage in competitive decisionmaking for opposer and do not engage in business decisions related to the pricing, marketing or technical design of opposer's products.

In view thereof, opposer's motion for protective order is granted. Opposer's Proposed Order, to which the parties have otherwise agreed to be bound, is approved and is applicable in this proceeding as of the mailing date of this order.¹

Applicant's motion to compel

Applicant seeks an order compelling more complete responses to certain discovery requests in applicant's First Set of Interrogatories and First Request for the Production of Documents, served by mail on September 30, 2008. Applicant asserts that opposer refused to produce confidential documents and things which may be responsive thereto unless applicant provided consent to modify the Board's standard protective order to allow in-house counsel access to documents which applicant has classified as trade secret or commercially sensitive. Applicant further argues, *inter alia*, that the

¹ Counsel for applicant is encouraged to provide to counsel for opposer, and for inclusion in the Proposed Order, the name(s) of its in-house counsel, as appropriate, who it wishes to be recognized and defined under "attorneys for parties" in this proceeding.

Board's standard protective order has been applicable throughout discovery, and that opposer's proposal to modify that order more than one month after opposer's deadline to respond to discovery indicates opposer's intent to delay this proceeding.

In response, opposer asserts that it has only refrained from producing its confidential documents in view of pending resolution of the parties' dispute regarding modification of the standard protective order, and that it will promptly produce its confidential responsive documents once the underlying issue is resolved.

Applicant's motion to compel does not include a copy of the discovery requests at issue in its motion, and thus fails to comply with Trademark Rule 2.120(e)(1), in pertinent part, insofar as the Rule requires as follows:

A motion to compel discovery shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying.

In view thereof, applicant's motion to compel is denied without prejudice.²

² While the email communications of January 13-14, 2009 between counsels lack specificity with respect to which discovery responses applicant finds to be insufficient or in need of supplementation, given that the dispute, as evident from the parties' briefs on opposer's motion for protective order, encompasses a number of documents (and/or things) designated as confidential and/or trade

Opposer's motion to extend discovery

By the Board's institution order of June 11, 2008, discovery was set to close February 16, 2009. Opposer moved, on January 21, 2009, for a sixty-day extension of the current discovery schedule, from expert disclosures forward, citing the parties' inability to complete discovery due to their "dispute over access to confidential documents, which is the subject of a Motion for Protective Order," as well as other reasons, including opposer's change of counsel, and the availability of witnesses.

Applicant explains its position with respect to opposer's request for an extension, clarifying that applicant consents to an extension for the limited purpose of scheduling two previously noticed depositions, but objects to an extension of discovery for all purposes, asserting, among other things, that opposer's change of counsel cannot excuse opposer from its obligation to respect discovery deadlines and that opposer's request is for purposes of delay at applicant's expense.

Pursuant to Fed. R. Civ. P. 6(b), applicable to Board proceedings by operation of Trademark Rule 2.116(a), a party may file a motion for an enlargement of the time in which an act is required or allowed to be done. If the motion is filed

secret/commercially sensitive, the record generally supports applicant's compliance with Trademark Rule 2.120(e)(1) insofar as it requires that a movant make a good faith effort, by conference or correspondence, to resolve the issues presented in the motion, and state that the parties were unable to resolve their differences. The Board notes, however, that an affirmative statement regarding such effort on the part of applicant was not included in applicant's motion, as required by the Rule.

prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend, and the moving party need only show good cause for the requested extension. A party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor. See TBMP § 509.01 (2d ed. rev. 2004).

Inasmuch as the record amply indicates the nature of the genuine dispute which stalled the continuation of discovery and does not point to a lack of diligence or unreasonable delay on the part of either party, and for good cause shown, opposer's motion to extend is granted.

Proceedings herein are resumed. The parties are allowed thirty (30) days from the mailing date of this order in which to respond to any outstanding discovery requests.

Expert disclosure, close of discovery, and trial dates are reset as follows:

Expert Disclosures Due	6/10/2009
Discovery Closes	7/10/2009
Plaintiff's Pretrial Disclosures	8/24/2009
Plaintiff's 30-day Trial Period Ends	10/8/2009
Defendant's Pretrial Disclosures	10/23/2009
Defendant's 30-day Trial Period Ends	12/7/2009
Plaintiff's Rebuttal Disclosures	12/22/2009
Plaintiff's 15-day Rebuttal	1/21/2010

Period Ends

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.

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>