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

Proceeding	91184529
Party	Plaintiff Georgia-Pacific Consumer Products LP
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Date	01/16/2009
Attachments	Opposer's Motion for Protective Order.Exhibits A - E.pdf ( 33 pages )(510366 bytes )

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

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529  
Serial No.: 77/364,616

**OPPOSER'S MOTION FOR PROTECTIVE ORDER**

OPPOSER GEORGIA-PACIFIC CONSUMER PRODUCTS LP ("Georgia-Pacific") moves the Board to enter Georgia-Pacific's proposed Protective Order, showing as follows:

Georgia-Pacific moves the Board to enter the proposed Protective Order attached as **Exhibit A** ("Proposed Order"). The Proposed Order differs from the Board's Standard Protective Order in that it allows in-house counsel for both parties to access all relevant documents, even those that involve trade secret or "commercially sensitive" information.

Georgia-Pacific's in-house counsel must have access to all information produced in discovery by Applicant Global Tissue Group, Inc. ("GTG"), including trade secret/commercially sensitive information, in order for them to provide informed legal advice to their client. Because Georgia-Pacific's in-house counsel are not involved in "competitive decision-making," but instead act in virtually identical roles to Georgia-Pacific's outside counsel, they should have equal access to such information. *See U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed Cir. 1984).

The parties have agreed to all terms of the Proposed Order except for the provision authorizing in-house counsel to access trade secret or commercially sensitive information. But,

GTG objects to this provision on the ground that the parties are competitors and it does not want trade-secret information made available to any employees of Georgia-Pacific, even its attorneys. GTG's objection misunderstands the nature and role of Georgia-Pacific's in-house counsel, whose primary responsibilities are legal, separate and apart from the operations of the company.

This motion is not for the purpose of delay, but to resolve this legitimate discovery dispute. For the reasons discussed further below, Georgia-Pacific respectfully requests that its Motion be granted and the Board approve its Proposed Order, so that discovery may continue without further delay.

### **STATEMENT OF RELEVANT FACTS**

To protect its federally registered trademark rights in its QUILTED NORTHERN® Mark, Georgia-Pacific filed the instant opposition proceeding against GTG's application for the confusingly similar mark QUILTY on June 11, 2008. Both parties served and responded to written Interrogatories and Requests for Production of Documents in November, but no documents have yet been exchanged due to the dispute between the parties regarding the terms of a protective order (and Georgia-Pacific's intervening substitution of counsel). Georgia-Pacific presented a proposed Protective Order to GTG on December 10, 2008, which largely follows the Board's standard protective order by providing for three classes of protected information: confidential, highly confidential, and trade secret/commercially sensitive. *See Ex. A*, at ¶ 1 .

Georgia-Pacific's proposed Protective Order differs from the Board's standard order in only one respect: It provides for in-house counsel for both parties to have access to information designated as trade secret/commercially sensitive. *See id.* ¶ 3.8. Specifically, the Proposed Order defines "attorneys" as "including outside counsel for the parties in this proceeding, and support staff operating under outside counsel's direction, such as paralegals or legal assistants,

secretaries, and any other employees or independent contractors operating under counsel's instruction," and "the following named in-house counsel for the parties in this proceeding, as well as the support staff operating under the direction of these named in-house counsel: for Opposer -- Emily K. Boss, Chief Counsel, Consumer Products and Christine M. Cason, Senior Trademark Counsel," and allows for GTG to specify in-house counsel as well. *See id.* ¶ 3.4.

This in-house counsel access provision is extremely important to Georgia-Pacific. Boss, a lawyer licensed by the state bars of Georgia and Virginia, and Cason, a lawyer licensed by the state bar of Georgia, are Georgia-Pacific's trademark counsel. Just as it is critical that Georgia-Pacific's outside counsel have full access to discovery in this matter, it is critical that Georgia-Pacific's *inside* trademark counsel have full access to discovery in Georgia-Pacific's trademark enforcement matters, so that they can provide informed legal advice to their client, including advice as to trial strategy and as to the assessment of settlement proposals. Declaration of Emily K. Boss, at ¶ 8, attached as **Exhibit B**. Neither Ms. Boss nor Ms. Cason engage in competitive decision-making for Georgia-Pacific, or engage in decisions relating to the pricing, marketing, or technical design of Georgia-Pacific's products. *Id.* ¶ 5-6; Declaration of Christine Cason, at ¶ 5-6, attached as **Exhibit C**.

GTG has agreed to Georgia-Pacific's proposed Protective Order with the exception of the in-house counsel provision, which it has objected to on the grounds that the parties were competitors and that trade secret information was not relevant to the matter. *See* correspondence of December 16, 2008, attached as **Exhibit D**. Counsel for Georgia-Pacific attempted to resolve this matter through telephone calls and email correspondence with counsel for GTG, explaining the importance of this provision to Georgia-Pacific and reasserting that its in-house counsel would treat any such trade secret information as confidential. *See* correspondence of December

19, 2008, attached as **Exhibit E**. However, the parties have been unable to reach agreement on this issue and discovery remains stalled as a result.

### **ARGUMENT AND CITATION OF AUTHORITY**

**A. The Board's New Standard Protective Order is Not Mandatory.**

Georgia-Pacific is permitted under the Board's rules to modify the standard protective order. The Board has made clear that its new Standard Protective Order is not mandatory in any proceeding, as the language in the Board's new Standard Protective Order explicitly states that parties may either agree to be bound by the terms of the order in its standard form, or may modify the order by agreement. *See* New Standard Protective Order, entitled, "*Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding.*" In addition, 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." *See* Order (January 23, 2008). Therefore, the Board anticipates that parties will adopt protective orders that vary from the terms of its new Standard Protective Order.

**B. Access to Confidential Information Cannot be Denied Solely because of Counsel's In-house Status.**

There is no basis for the Board to distinguish between in-house and outside counsel, as GTG attempts to do. As the Federal Circuit has held:

Denial or grant of access [to confidential information] . . . cannot rest on a general assumption that one group of lawyers are more likely or less likely inadvertently to breach their duty under a protective order. . . . 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. In-house counsel provide the same services and are subject to the same types of pressures as retained counsel. The problem and importance of avoiding inadvertent disclosure is the same for both.

*U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed Cir. 1984) (holding that there was no basis for denying access to in-house counsel where in-house counsel not involved in “competitive decision-making” for their client).

Despite the Federal Circuit’s clear guidelines on this issue, GTG’s argument for modifying the Protective Order to prevent Boss and Cason from accessing its trade secret information rests improperly on its concern that the parties are competitors and that its trade secret information could be accessed by Georgia-Pacific. However, *U.S. Steel* makes clear that status as in-house counsel alone does not inherently create any significant risk of a breach of confidentiality and cannot serve by itself, as a basis for denial of access. *Id.* at 1469. Rather, access can be denied only if the in-house counsel are involved in “competitive decision-making” for their client. *Id.* at 1468; *see also Matsushita Electric Industrial Co. v. United States*, 929 F.2d 1577, 1579 (Fed. Cir. 1991) (finding it improper to deny access to General Counsel, Senior Vice President, and Secretary who was not involved in competitive decision-making, even though he had regular contact with other corporate officials who were involved in competitive decision-making).

In support of its objection, GTG has cited (in correspondence) the case of *Georgia-Pacific Corp. v. Solo Cup. Co.*, 80 U.S.P.Q.2d 1953 (T.T.A.B. 2006), in which the Board previously denied a request for the entry of a similar protective order by Georgia-Pacific. However, in addition to not being citable precedent of the Trademark Trial and Appeal Board, the case is factually distinguishable. In *Solo Cup*, the Board followed the *U.S. Steel* standard, explaining that its primary reviewing factor in any analysis relating to the restriction of access by in-house counsel is “whether in-house counsel is involved in its employer-litigant’s ‘competitive decision-making.’” *Solo Cup*, 80 U.S.P.Q.2d at 1952 (citing *U.S. Steel Corp.*, 730 F.2d at 1468).

However, the Board in *Solo Cup* determined that Georgia-Pacific had not demonstrated the lack of competitive decision-making by the in-house counsel at issue. *Solo Cup*, 80 U.S..PQ.2d at 1953 (citing *Matsushita Elec. Indus. Co., Ltd. v. The United States*, 929 F.2d 1577, 1579-1580 (Fed. Cir. 1991)).

By contrast, Georgia-Pacific now submits the Declarations of its two in-house counsel, Emily K. Boss and Christine M. Cason, attesting to the fact that neither is engaged in competitive decision-making for Georgia-Pacific. *See* **Ex. B**, ¶ 5; **Ex. C**, ¶ 5. Neither engages in decisions relating to the pricing, marketing, or technical design of Georgia-Pacific's products as well. **Ex. B**, ¶ 6; **Ex. C**, ¶ 6. In *Matsushita*, in-house counsel submitted an affidavit attesting to the fact that he was not involved in competitive decision-making activities for the corporation, and that was sufficient to permit access to highly confidential information. *See Matsushita*, 929 F.2d at 1580. The Boss and Cason Declarations clearly meet (and exceed) the standard set forth in *Matsushita* and followed in *Solo Cup*, demonstrating that Georgia-Pacific's two in-house counsel are not engaged in competitive decision-making and should thus be permitted access to all levels of confidential information produced by GTG in discovery.

Georgia-Pacific therefore requests that its Motion for Protective Order be granted and the Board approve the Proposed Order submitted with this Motion.

This 16<sup>th</sup> day of January, 2009.

/s/ Charlene R. Marino

R. Charles Henn Jr.

Charlene R. Marino

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Attorneys for Opposer Georgia-Pacific  
Consumer Products LP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Applicant.

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date, January 16, 2009, a copy of this paper has been served upon Applicant, by email and by U.S. mail, to Applicant's current identified counsel, as set forth below:

Andrew B. Katz  
Chernow Katz, LLC  
721 Dresher Road, Suite 1100  
Horsham, Pennsylvania 19044  
akatz@chernowkatz.com

/s/ Charlene R. Marino  
Charlene R. Marino

# **EXHIBIT A**



1.3 Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access and available for review by attorneys for the parties subject to paragraphs 3.4 and 3.8, and available for review by independent experts or consultants pursuant to paragraphs 3.9, 4, and 5.

**2. Information Not To Be Designated as Protected.**

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this Order; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non designating party with the approval of the designating party.

**3. Access to Protected Information.**

3.1 The provisions of this Order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

3.2 Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this Order. Court reporters, stenographers, video technicians or others who may be employed by the parties or

their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

3.3 Parties are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.

3.4 Attorneys for parties are defined as including outside counsel for the parties in this proceeding, and support staff operating under outside counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction. Attorneys for parties are defined as also including the following named in-house counsel for the parties in this proceeding, as well as the support staff operating under the direction of these named in-house counsel: for Opposer -- Emily K. Boss, Chief Counsel, Consumer Products and Christine M. Cason, Senior Trademark Counsel; for Applicant -- \_\_\_\_\_

3.5 Independent experts or consultants include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.

3.6 Non-party witnesses include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

- 3.7 Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions.
- 3.8 Outside counsel and in-house counsel for the parties named in paragraph 3.4 shall have access to information designated as trade secret/commercially sensitive.
- 3.9 Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this Order may be afforded access to confidential or highly confidential information in accordance with the terms that follow in paragraph 4. Further, independent experts or consultants may have access to trade secret/commercially sensitive information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 5.

**4. Disclosure to Any Individual.**

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this Order, the individual shall be informed of the existence of this Order and provided with a copy to read. The individual will then be required to certify in writing that the Order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this Order. The party or attorney receiving the completed form shall retain the original.

**5. Disclosure to Independent Experts or Consultants.**

- 5.1 In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.
- 5.2 The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

**6. Responses to Written Discovery.**

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the

error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

**7. Production of Documents.**

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

**8. Depositions.**

8.1 Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

8.2 During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

8.3 The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

**9. Filing Notices of Reliance.**

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

**10. Briefs.**

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this Order.

**11. Handling of Protected Information.**

Disclosure of information protected under the terms of this Order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this Order is obligated to maintain the confidentiality

of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

**12. Redaction; Filing Material With the Board.**

- 12.1 When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.
- 12.2 Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal.
- 12.3 Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The

envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form :

**CONFIDENTIAL**

*This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.*

**13. Acceptance of Information; Inadvertent Disclosure.**

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

**14. Challenges to Designations of Information as Protected.**

14.1 If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

14.2 A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

14.3 The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

**15. Board's Jurisdiction; Handling of Materials After Termination.**

15.1 The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

15.2 The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

**16. Other Rights of the Parties and Attorneys.**

This Order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the Order preclude the filing of any motion with the Board for relief from a particular provision of this Order or for additional protections not provided by this Order.

SO ORDERED, this \_\_\_ day of November, 2008.

Stipulated by:

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R. Charles Henn Jr.  
Charlene R. Marino  
Lauren S. Ralls  
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*Counsel for Opposer*  
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*Counsel for Applicant*  
*Global Tissue Group Inc.*

# **EXHIBIT B**

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

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

Opposer,

v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529  
Serial No.: 77/364,616

**DECLARATION OF EMILY K. BOSS**

I, Emily K. Boss, pursuant to 28 U.S.C. § 1746, declare under penalty of perjury under the laws of the United States of America that the following is true and correct:

1. I am Chief Counsel, Consumer Products, for Georgia-Pacific Consumer Products LP (“Georgia-Pacific”). I am submitting this Declaration pursuant to 37 C.F.R. § 2.120, in connection with Georgia-Pacific’s Reply Memorandum in Support of its Motion to Compel Discovery in the above-styled action.

2. I have personal knowledge of the facts stated herein.

3. I am licensed to practice law by the state bars of Georgia and Virginia and abide by all professional rules promulgated by the same.

4. In my position as Chief Counsel, my primary responsibilities at Georgia-Pacific are legal in nature.

5. I have reviewed the *Matsushita* and *U.S. Steel* cases and I can state that I do not engage in “competitive decision-making” for Georgia-Pacific.

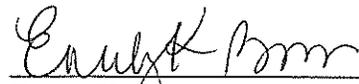
6. I do not engage in business decisions relating to the pricing, marketing, or technical design of Georgia-Pacific’s products.

7. My professional dealings with the operating personnel at Georgia-Pacific’s mills, and in the marketing and sales departments are always in the context of legal issues and advice.

8. It is critical that Georgia-Pacific’s inside trademark counsel have full access to discovery in Georgia-Pacific’s trademark enforcement matters, so that we can provide informed legal advice to our client, including advice as to trial strategy and as to the assessment of settlement proposals.

I, Emily K. Boss, pursuant to 28 U.S.C. § 1746, declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 16<sup>th</sup> day of January, 2009.

  
\_\_\_\_\_  
Emily K. Boss

# **EXHIBIT C**

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

GEORGIA-PACIFIC CONSUMER  
PRODUCTS LP,

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v.

GLOBAL TISSUE GROUP, INC.

Applicant.

Opposition No.: 91184529

Serial No.: 77/364,616

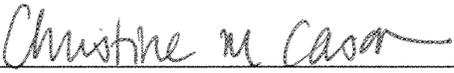
**DECLARATION OF CHRISTINE M. CASON**

I, Christine M. Cason, pursuant to 28 U.S.C. § 1746, declare under penalty of perjury under the laws of the United States of America that the following is true and correct:

1. I am Senior Trademark Counsel for Georgia-Pacific Consumer Products LP (“Georgia-Pacific”). I am submitting this Declaration pursuant to 37 C.F.R. § 2.120, in connection with Georgia-Pacific’s Reply Memorandum in Support of its Motion to Compel Discovery in the above-styled action.
2. I have personal knowledge of the facts stated herein.
3. I am licensed to practice law by the state bar of Georgia and abide by all professional rules promulgated by the same.
4. In my position as Senior Trademark Counsel, my primary responsibilities at Georgia-Pacific are legal in nature.
5. I have reviewed the *Matsushita* and *U.S. Steel* cases and I can state that I do not engage in “competitive decision-making” for Georgia-Pacific.
6. I do not engage in decisions relating to the pricing, marketing, or technical design of Georgia-Pacific’s products.
7. Any contact that I make with the operating personnel at Georgia-Pacific’s factories and in the branding and marketing departments is always in the context of legal issues and advice.

I, Christine M. Cason, pursuant to 28 U.S.C. § 1746, declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 16<sup>TH</sup> day of January, 2009.

  
\_\_\_\_\_  
Christine M. Cason

## **EXHIBIT D**

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**From:** Andrew B. Katz [mailto:[akatz@chernowkatz.com](mailto:akatz@chernowkatz.com)]  
**Sent:** Tuesday, December 16, 2008 2:39 PM  
**To:** Marino, Charlene  
**Cc:** Henn, Charlie; Ralls, Lauren  
**Subject:** RE: Georgia-Pacific Consumer Products v. Global Tissue Group  
Opposition No. 91184529 to QUILTY

Charlene—

I attach our revisions to the draft protective order which are shown in the document titled "compared protective order." As I said to you on the phone I have no problem with in-house counsel reviewing/having access to highly confidential materials. I did not consent to allowing in-house counsel to review/have access to trade secret or commercially sensitive materials and have thus edited your draft accordingly. Given that our respective clients are direct competitors and could be in adverse positions on other matters down the road (including matters not simply related to trademark rights), such access to trade secrets and commercially sensitive information is not warranted here. Further, I do not see any reason why your client's in-house counsel would need to have access to my client's trade secrets or commercially sensitive information—as such information, even if discoverable, would have little bearing on the merits of this matter before the TTAB.

I have signed the attached document in pdf format and ask that you do the same. Once signed, we will need to arrange for the exchange of documents in response to our respective production requests.

Kind regards,

Andy

**Andrew B. Katz**  
Chernow Katz LLC  
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# **EXHIBIT E**

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**From:** Marino, Charlene  
**Sent:** Friday, December 19, 2008 4:53 PM  
**To:** 'Andrew B. Katz'  
**Cc:** Henn, Charlie  
**Subject:** RE: Georgia-Pacific Consumer Products v. Global Tissue Group  
Opposition No. 91184529 to QUILTY

Andy,

Thank you for your comments. Perhaps we miscommunicated in our earlier conversation, but I thought I had expressed that Georgia-Pacific's in-house counsel, including Ms. Cason, must insist on having access to all levels of confidential documents, including those that your client might designate as trade secret materials. As I mentioned before, it is crucial for them to be able to review these materials in order to properly assess the case and advise their client, the corporation.

We certainly understand your client's concern about confidentiality since the parties are competitors. Please be assured, however, that in-house counsel cannot and will not disclose to the corporation any documents or information designated as trade secret under the terms of the protective order. As members of the bar, they are subject to the same ethical rules regarding confidentiality and can even be sanctioned for any disclosure of trade secret information. Moreover, the in-house attorneys have no involvement with competitive decision-making for Georgia-Pacific. The in-house lawyers have signed sworn affidavits to this effect in other cases, which we would be happy to share if your client requests.

The Federal Circuit has held that access to confidential information cannot be denied solely because of counsel's in-house status. See *Matsushita Elec. Indus. Co. v. U.S.*, 929 F.2d 1577, 1578 (Fed. Cir. 1991). The court found that where in-house counsel does not advise or participate in the client's decisions made in light of the competitor, then such access should not be restricted. *Id.* (relying on *U.S. Steel Corp. v. United States*, 730 F.2d 1465 (Fed. Cir. 1984)). Under this authority, we believe that the Board would allow Georgia-Pacific to review this type of information if we are required to bring this issue before it.

We hope that in light of this information, your client will re-consider its position on this issue. Perhaps it would be useful to discuss this in terms of the particular

documents that your client intends to designate as "trade secret" in response to our document requests, rather than in the hypothetical.

Thanks,  
Charlene

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**From:** Andrew B. Katz [mailto:akatz@chernowkatz.com]  
**Sent:** Tuesday, December 16, 2008 2:39 PM  
**To:** Marino, Charlene  
**Cc:** Henn, Charlie; Ralls, Lauren  
**Subject:** RE: Georgia-Pacific Consumer Products v. Global Tissue Group  
Opposition No. 91184529 to QUILTY

Charlene—

I attach our revisions to the draft protective order which are shown in the document titled "compared protective order." As I said to you on the phone I have no problem with in-house counsel reviewing/having access to highly confidential materials. I did not consent to allowing in-house counsel to review/have access to trade secret or commercially sensitive materials and have thus edited your draft accordingly. Given that our respective clients are direct competitors and could be in adverse positions on other matters down the road (including matters not simply related to trademark rights), such access to trade secrets and commercially sensitive information is not warranted here. Further, I do not see any reason why your client's in-house counsel would need to have access to my client's trade secrets or commercially sensitive information—as such information, even if discoverable, would have little bearing on the merits of this matter before the TTAB.

I have signed the attached document in pdf format and ask that you do the same. Once signed, we will need to arrange for the exchange of documents in response to our respective production requests.

Kind regards,

Andy

**Andrew B. Katz**  
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