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

Proceeding	91193398
Party	Plaintiff GP Harmon Recycling LLC
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Date	10/01/2010
Attachments	Motion for Protective Order [as filed].PDF (41 pages)(1498528 bytes)

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

GP Harmon Recycling LLC, a Georgia
limited liability company,
Opposer,

v.

Waste Management, Inc., a Delaware
corporation,
Applicant.

Opposition No.: 91193398
Application Serial Nos.: 77/725,583;
77/725,585; and 77/725,578

Date of Publication: September 15, 2009
Mark: Circular design mark

OPPOSER'S MOTION FOR PROTECTIVE ORDER

Opposer, GP Harmon Recycling, LLC, ("Opposer") moves the Board to enter Opposer's proposed Protective Order, showing as follows:

Opposer 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.

Opposer's in-house counsel must have access to all information produced in discovery by Applicant Waste Management, Inc. ("Applicant"), including trade secret/commercially sensitive information, in order for her to provide informed legal advice to her client. Because Opposer's in-house counsel is not involved in "competitive decision-making," but instead acts in a role virtually identical to Opposer's outside counsel, she should have equal access to such information. *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1468 (Fed Cir. 1984).

The parties have discussed the terms of the Proposed Order and disagree on the provision authorizing in-house counsel to access trade secret or commercially sensitive information. Applicant 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 Opposer, even its attorneys. Applicant's objection misunderstands the nature and role of Opposer'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, Opposer 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 the GP Design Mark, Opposer filed the instant opposition proceeding against Applicant's multiple applications confusingly similar design marks on January 13, 2010. Both parties served and responded to written Interrogatories and Requests for Production of Documents in September, but no documents have yet been exchanged due to the dispute between the parties regarding the terms of a protective order. On August 27, 2010, Opposer provided Applicant with a proposed Protective Order, which largely follows the Board's standard protective order in providing separate classes of protected information: "Confidential" and "Highly Confidential - Attorney's Eyes Only." See **Ex. A**, at ¶¶ 1-2.

Opposer's proposed Protective Order differs from the Board's standard order in that it allows in-house counsel for both parties to have access to information designated as "Highly Confidential - Attorney's Eyes Only." *See id.* ¶ 2. Specifically, the Proposed Order provides access to outside counsel, as well as "In-house counsel for the Parties and their staff to whom it is necessary that materials be disclosed for purposes of this Opposition action, including secretaries, paralegals, and document clerks." *See id.* ¶ 6(b).

This in-house counsel access provision is extremely important to Opposer. Christine Cason, a lawyer licensed by the state bar of Georgia, is Opposer's trademark and copyright counsel. Just as it is critical that Opposer's outside counsel have full access to discovery in this matter, it is critical that Opposer's *inside* trademark counsel has full access to discovery in Opposer's trademark enforcement matters, so that she can provide informed legal advice to her client, including advice as to trial strategy and as to the assessment of settlement proposals. *See* Declaration of Christine Cason, at ¶ 5, attached as **Exhibit B**. Ms. Cason does not engage in competitive decision-making for Opposer, or engage in decisions relating to the pricing, marketing, or technical design of Opposer's products and services. *Id.* Applicant has objected the in-house counsel provision of Opposer's proposed Protective Order on the grounds that the parties are competitors, and inexplicably accused Opposer of using this "Opposition Proceeding as a vehicle for [Opposer's] in-house counsel and others in its legal department to view and have access to [Applicant's] sensitive commercial information." *See* correspondence of September 24, 2010, attached as **Exhibit C**. Despite Opposer's attempt to resolve this

matter through email correspondence with counsel for Applicant, 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.

Opposer is permitted under the Board's rules to modify the standard protective order. The Board has made clear that its Standard Protective Order is not mandatory in any proceeding, as the language in the Board's 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* Standard Protective Order, entitled, "*Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding.*" The parties are free to agree to a substitute protective order or to supplement or amend the standard, subject to Board approval. *See Hershey Chocolate & Confectionery Corp. v. Cerreta Candy Co., Inc.*, 2002 TTAB LEXIS 302, *18 (TTAB May 17, 2002) ("The Board's standardized order may be used as a template upon which to base a more particularized agreement."). 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 Applicant 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., 730 F.2d at 1468 (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). See also *Helene Curtis, Inc. v. Derma-Cure, Inc.*, 1996 TTAB LEXIS 457, *5 (TTAB July 9, 1996)(“If the in-house counsel are not officers or directors of their employer, (and, of course, they should clearly understand their obligation not to disclose confidential information to their employer), then access to confidential information by in-house counsel in this cancellation proceeding is allowable.”).

Opposer has submitted the Declaration of its in-house counsel, Christine M. Cason, attesting to the fact that she is not engaged in competitive decision-making for Opposer. See **Ex. B**, ¶ 7. Ms. Cason does not engage in decisions relating to the pricing, marketing, or technical design of Opposer’s products and services as well. *Id.* at ¶ 7. In a similar, but unrelated proceeding involving Opposer’s related company, Georgia-Pacific Consumer Products LP, the Board held that Georgia-Pacific:

...by making a record of the declarations under oath of each of its in-house counsel named in the Proposed Order, [had] 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.

Georgia-Pacific Consumer Products LP v. Global Tissue Group, Inc., Opposition No. 91184529 (TTAB May 4, 2009)(not reported). A copy of the Board’s May 4, 2009 decision is attached as **Exhibit D**. The result should be no different in this case.

The case of *Matsushita Electric Industrial Co. v. United States*, 929 F.2d 1577, 1580 (Fed. Cir. 1991) is also instructive. 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. *Id.* The Cason Declaration clearly meets (and exceeds) the standard set forth in *Matsushita*, demonstrating that Opposer's in-house counsel is not engaged in competitive decision-making and should thus be permitted access to all levels of confidential information produced by Applicant in discovery.

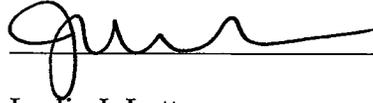
Despite the Federal Circuit's clear guidelines on this issue, Applicant's argument for modifying the Protective Order to prevent Opposer's in-house counsel from accessing its trade secret information rests improperly on its concern that the parties are competitors and that its trade secret information could be accessed by Opposer. 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. 730 F.2d 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*, 929 F.2d at 1579 (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). As Opposer's in-house counsel is not involved in "competitive decision-making" for her client, she should not be denied access on the basis of her status as in-house counsel.

Based on the foregoing, Opposer therefore requests that its Motion for Protective Order be granted and the Board approve the Proposed Order submitted with this Motion.

Date: October 1, 2010

Respectfully submitted,

LOTT & FRIEDLAND, P.A.



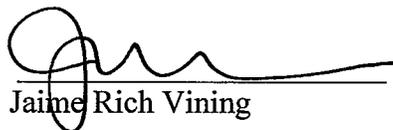
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(305)448-7089

*Attorneys for Opposer
GP Harmon Recycling LLC*

CERTIFICATE OF SERVICE

WE HEREBY CERTIFY that the foregoing **OPPOSER'S MOTION FOR PROTECTIVE ORDER** was served upon Applicant by delivering true and correct copies of same to counsel for Applicant via Federal Express October 1, 2010 as follows:

Ben D. Tobor, Esq.
Greenberg Traurig LLP
1000 Louisiana St., Suite 1700
Houston, TX 77002



Jaime Rich Vining

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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PROTECTIVE ORDER

For good cause shown, it is hereby ORDERED that the following provisions shall govern the use and dissemination of all information, documents or materials that are produced in this action and designated as Confidential or Highly Confidential by Opposer, GP Harmon Recycling LLC ("Opposer") or by Applicant, Waste Management, Inc. ("Applicant")(collectively referred to as "the Parties"):

1.

Any party asked to provide information or discovery in connection with this action may designate all or portions of any information, materials, or documents produced or furnished by such party as CONFIDENTIAL. Any information, document or material that a producing party reasonably and in good faith believes constitutes or contains trade secret information or confidential or sensitive information or information that is otherwise protectable under applicable law may be classified as CONFIDENTIAL.

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2.

Any party asked to provide information or discovery in connection with this action may designate all or portions of any information, materials, or document produced or furnished by any such party as HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY. Any information, document or material that a producing party reasonably and in good faith believes constitutes or contains trade secret information or confidential or sensitive information or information that is otherwise protectable under applicable law may be classified as HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY.

3.

Any designating Party who produces or supplies information, documents, or other materials in this action may designate as “HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY” only information, documents or other materials concerning the following: (a) development of new products; (b) marketing plans and methods having current or future applicability; (c) business planning and financial documents having past, current or future applicability; and (d) other information which constitutes trade secrets when such information is so proprietary or competitively sensitive that its disclosure is likely to cause irreparable injury to the designating Party.

4.

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The Parties agree not to designate information as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY for the purpose of harassing the receiving party or for the purpose of unnecessarily restricting the receiving party's access to information concerning this Opposition action.

5.

Any document or transcript (or portions thereof), whether an original or copy, including any exhibits and answers to interrogatories, as well as physical objects, recordings or things that any party deems to contain CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information shall be labeled on the first page and on each subsequent page of such document or on such physical object with the appropriate designation. All CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information not reduced to documentary, tangible or physical form, or which cannot be conveniently labeled, shall be so designated by a party by informing the opposing party in writing. All information disclosed during discovery whether or not labeled CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY may be used only for the purpose of this Opposition action and for no other purpose, except as described in this paragraph. In the event a party elects to produce original documents or other materials for inspection, no markings need be made by the producing party in advance of the inspection, and all such documents shall be considered as marked HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY during and in connection with such inspection and until such time as the producing party designates any such documents or materials differently. In the event that specific information designated as

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CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY and disclosed during discovery reveals unlawful conduct by a third party, the party receiving such information is not precluded from bringing a legal action against the third party for its unlawful conduct, provided that the producing party is given thirty (30) days advance written notice and the information is maintained, to the extent possible, in accordance with any CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY designation.

6.

Information or documents designated as CONFIDENTIAL may only be disclosed to:

- (a) All attorneys of record in this action, other lawyers regularly employed in their offices and their staff to whom it is necessary that materials be disclosed for purposes of this Opposition action, including secretaries, paralegals, and document clerks;
- (b) In-house counsel for the Parties and their staff to whom it is necessary that materials be disclosed for purposes of this Opposition action, including secretaries, paralegals, and document clerks;
- (c) Those employees and agents of the receiving party who are involved in or are responsible for this Opposition action and who have a need to know the CONFIDENTIAL information;
- (d) Trademark Trial and Appeal Board ("TTAB") personnel;
- (e) Outside commercial copying and other litigation support services;
- (f) Independent experts or consultants retained by counsel for the purpose of assisting in this Opposition action, including their staff to whom it is necessary that materials

be disclosed for purposes of this Opposition action, subject to the provisions in paragraph 8 below;

(g) Any witness testifying under oath who is an employee or former employee of the party that designated such information as CONFIDENTIAL;

(h) A total of no more than three (3) non lawyer party representative(s) attending any depositions, hearings or trials;

(i) Any person who is an author or addressee of any document or thing containing such information, or any person copied thereon; and

(j) Such other persons as hereafter may be designated by written agreement of all parties in this action or by Order of the TTAB, such Order obtained on noticed motion (or on shortened time as the TTAB may allow), permitting such disclosure.

7.

Information or documents designated as HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY may only be disclosed to those persons entitled to receive CONFIDENTIAL information under paragraphs 6(a), 6(b), 6(d), 6(e), 6(f), 6(g), 6(i), or 6(j).

8.

Individuals designed in 6(f) and 6(g) above shall sign a written agreement in the form of Exhibit A hereto prior to receiving any CONFIDENTIAL information. Experts receiving any information or documents designated as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY, shall sign a written agreement in the form of Exhibit B attached hereto prior to receiving any CONFIDENTIAL information or HIGHLY CONFIDENTIAL --

ATTORNEYS' EYES ONLY information. Exhibit B need not be disclosed to the opposing party, provided that a copy of executed Exhibit B is retained by counsel for the receiving party.

9.

Persons authorized under paragraphs 6 and 7 to receive information designated as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY ("Qualified Persons") shall not disclose or disseminate, directly or indirectly, any CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information to persons other than the party that designated the information as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY or to other Qualified Persons, nor shall any Qualified Person make public disclosure of any CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information or use CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information for any purpose other than in connection with this Opposition action, subject to the exception set forth in paragraph 5 above. A party alleging improper disclosure and/or use of information designated as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY may seek relief from the TTAB, including striking all or part of the pleadings, entering judgment against the disobedient party, or any other relief as set forth in 37 C.F.R. §2.120(g), TBMP §527, if the Parties are not able to resolve the issue in good faith.

10.

Information disclosed at any deposition may be designated as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY on the record at the deposition or

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by notifying all parties in writing, within fourteen days of receipt of the transcript by the attorneys for the designating party, of the specific pages and lines of the transcript which contain CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS EYES ONLY information. All information disclosed in depositions shall be treated as HIGHLY CONFIDENTIAL -- ATTORNEYS EYES ONLY until at least fourteen days after the transcript(s) of said deposition is actually received by the attorneys for each party. Only those persons authorized to receive CONFIDENTIAL information will be allowed to attend that portion of any deposition in which CONFIDENTIAL information is used or elicited from the deponent. Only those persons authorized to receive HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information will be allowed to attend that portion of any deposition in which HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information is used or elicited from the deponent.

11.

Any court reporter, transcriber or videographer who reports or transcribes testimony in this action at a deposition shall agree by a statement on the record or written statement that all testimony and information revealed at the deposition is and shall remain confidential and shall not be disclosed by such reporter or transcriber except to the attorneys for the Parties and any other person who is present while such testimony is being given, and that all copies of any transcript, reporter's notes or any other transcription records of any such testimony shall be retained in absolute confidentiality and safekeeping by such reporter, transcriber or videographer or shall be delivered to the undersigned attorneys.

12.

Nothing shall prevent disclosures beyond the terms of this Order if the party that designated the information as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY consents to such disclosure, or if the TTAB, after notice, orders such disclosure.

13.

All documents and transcripts of deposition testimony including exhibits and/or attachments associated with such transcripts, filed with the TTAB in this proceeding which have been designated, in whole or in part, as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY shall be filed and maintained under seal.

14.

All documents, deposition transcripts or other information identified by any party as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY, and all copies thereof, shall not be disclosed to any person who is not an authorized recipient, and shall be carefully maintained so as to preclude access by persons who are not authorized recipients. At the termination of this proceeding (whether by settlement or final judgment and exhaustion of all appeals), unless otherwise ordered by the TTAB, such documents either (a) shall be returned to the producing party or (b) shall be destroyed within 60 days of the termination of this proceeding, in which event counsel shall give written notice of such destruction to opposing counsel. In no event shall a party retain a copy of CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information produced to it, except that

outside litigation counsel may keep one copy of any pleadings containing such information for archival purposes. Nothing in this Order requires the return or destruction of attorney work-product or attorney-client communications of either party that is maintained and stored by counsel in the regular course of business. Furthermore, nothing in this Order requires the return or destruction of such information filed with the TTAB. Insofar as the provisions of any protective order entered in this Opposition action restrict the communication and use of the documents produced thereunder, such order shall continue to be binding after the conclusion of this proceeding except that there shall be no restriction on any document that was used as an exhibit in the proceedings unless such exhibit was maintained under seal.

15.

Nothing in this Order shall bar or otherwise restrict any attorney herein from rendering advice to his or her client with respect to this Opposition action by communication with any individual not entitled to see information or documents designated as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY and, in the course thereof, referring to or relying upon his or her examination of CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information provided that the attorney does not disclose the CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information to any person not authorized to receive the information. The Parties agree to cooperate in good faith with respect to any request for permission to disclose CONFIDENTIAL or HIGHLY CONFIDENTIAL information for purposes of counseling clients with respect to this proceeding.

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16.

This Order shall not be construed to prevent any person, including a Qualified Person, from making use of designated CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information that was lawfully in his or her possession prior to receipt from the supplying party that (a) appears in any published material available to the general public, without fault of the disclosing party, (b) was or is hereafter obtained from a source or sources not under an obligation of secrecy to the other party or parties, without fault of the disclosing party, or (c) is exempted from the operation of this Order by written consent of the party producing such CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information.

17.

If a party disagrees with any designation of any information as CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY, the party shall notify counsel for the other party and they shall attempt to resolve the dispute by agreement. If the dispute is not so resolved, the information shall continue to be kept confidential unless the TTAB rules otherwise and the party or person that made the designation shall have the burden of showing that the designation was proper. If a party opposes the proposed disclosure of CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information to a person or entity, CONFIDENTIAL information or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY information shall not be disclosed to that person or entity unless

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the TTAB rules otherwise, and the party or person wishing to make such disclosure shall have the burden of showing that the disclosure would be proper and consistent with this Order.

18.

Discovery material produced without the designation of CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY may be so designated subsequent to production or testimony when the producing party failed to make such designation at the time of production or during the testimony through inadvertence or error. If discovery material is so designated subsequent to production or testimony, the receiving party shall use its best efforts to promptly collect any copies that have been provided to individuals other than those Qualified Persons identified in paragraphs 6 and 7 of this Order. For purposes of this Paragraph, the material will be deemed to be CONFIDENTIAL or HIGHLY CONFIDENTIAL -- ATTORNEYS' EYES ONLY as of the date upon which notice of the designation is received. It shall not be a violation of this Order to disseminate discovery material that has not been designated as subject to this Order as of the time the material is disseminated.

19.

If information subject to a claim of attorney-client privilege or work-product immunity is inadvertently produced, such production shall in no way prejudice or otherwise constitute a waiver of, or estoppel as to, any such claim. If a party has inadvertently produced information subject to a claim of immunity or privilege, upon request, such information shall be returned promptly and, if a document, all copies of that document shall be destroyed. The party returning such information may move the TTAB for an Order compelling production of such information.

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20.

The terms and conditions in this Order shall survive and remain in full force and effect after the termination of this Opposition action until canceled or otherwise modified by Order of this TTAB, or by written agreement of the Parties.

21.

The TTAB shall retain jurisdiction to enforce the provisions of this Order.

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CONFIDENTIALITY ACKNOWLEDGEMENT A

I, _____, being duly sworn on oath, state the following:

1. I have read and understand the Protective Order to which this Exhibit A is annexed and I attest to my understanding that access to information designated Confidential or Highly Confidential may be provided to me and that such access is pursuant to the terms and conditions and restrictions of the Protective Order. I agree to be bound by the terms of the Protective Order. I hereby submit to the jurisdiction of the TTAB for the purpose of enforcement of this Confidentiality Acknowledgment and the Protective Order.

2. I shall not use or disclose to others, except in accordance with the Protective Order, any Confidential information or Highly Confidential information. I also shall return all Confidential information and Highly Confidential information provided to me in this proceeding to case counsel for the party that provided the information to me within sixty (60) days after the conclusion of this action, including the exhaustion of all appeals. If I fail to abide by the terms of this Confidentiality Acknowledgment or the Protective Order, I understand that I may subject the party that provided the information to me with sanctions under 37 C.F.R. §2.120(g) and TBMP §527 of which the TTAB, has, without limitation, the power to impose such relief to remedy contemptuous conduct.

Dated: _____

Signature

Printed Name

Address

Individual or Entity Represented

EXHIBIT B

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CONFIDENTIALITY ACKNOWLEDGEMENT B

I, _____, being duly sworn on oath, state the following:

1. I have been retained by _____ [party] to serve as an Expert in this action.

2. I have read and understand the Protective Order to which this Exhibit B is annexed and I attest to my understanding that access to information designated Highly Confidential may be provided to me and that such access is pursuant to the terms and conditions and restrictions of the Protective Order. I agree to be bound by the terms of the Protective Order. I hereby submit to the jurisdiction of the TTAB for the purpose of enforcement of this Confidentiality Acknowledgment and the Protective Order.

3. I am not currently, and agree that, as a means of further protecting Highly Confidential information, I shall not be an officer, director, employee, consultant or agent

(other than outside counsel) of any Competitor of the Designating Party (as defined in paragraph 11(e)(i)(b) of the Protective Order) for a period of six (6) months after I am last given access to any Highly Confidential information. I recognize that, as a practical matter, this limitation is unlikely to have an impact on my employment opportunities, but understand that if I do wish to take a position that would otherwise be barred by virtue of this provision, I shall consult with the Designating Party in an effort to reach an agreement about whether my intended activity with or for a Competitor can be structured in such a way, or the Designating Party can otherwise be reasonably satisfied, that there is not a material risk of unauthorized use or disclosure of Highly Confidential information.

4. I shall not use or disclose to others, except in accordance with the Protective Order, any Confidential information or Highly Confidential information. I also shall return all Confidential information and Highly Confidential information provided to me in this proceeding to case counsel for the party I represent within sixty (60) days after the conclusion of this proceeding, including the exhaustion of all appeals. If I fail to abide by the terms of this Confidentiality Acknowledgment or the Protective Order, I understand that I may be subject to sanctions under 37 C.F.R. §2.120(g) and TBMP §527 of which the TTAB, has, without limitation, the power to impose such relief to remedy contemptuous conduct.

Dated: _____

Signature

Printed Name

Address

Individual or Entity Represented

EXHIBIT B

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DECLARATION OF CHRISTINE CASON, ESQ.

I, Christine 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 and Copyright Counsel supporting GP Harmon Recycling LLC ("Opposer"). I am submitting this Declaration pursuant to 37 C.F.R. § 2.120, in connection with Opposer's Motion for Protective Order 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 and Copyright Counsel, my primary responsibilities 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 Opposer.

6. I do not engage in decisions relating to the pricing, marketing, or technical design of Opposer's products and services.

7. Any contact that I make with the operating personnel at Opposer's facilities and in the branding and marketing departments is always in the context of legal issues and advice.

I, Christine 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 1 day of October, 2010.



Christine Cason, Esq.

EXHIBIT C

Jaime Rich Vining

From: MathenyA@gtlaw.com
Sent: Friday, September 24, 2010 7:22 PM
To: Jaime Rich Vining; ToborB@gtlaw.com
Cc: Leslie J. Lott
Subject: RE: GP Harmon Recycling LLC v. Waste Management, Inc.

Jamie,

WM will not permit GP Harmon's in-house counsel to review or have access to WM's Attorney's Eyes Only information. In light of fact that GP Harmon is a customer of WM, in addition to being a competitor as alleged by GP Harmon in its Notice of Opposition, we believe that such a category under the Protective Order is more than appropriate. If this is unacceptable to your client, then we propose going with the TTAB's standard Protective Order and we will designate items that WM does not want disclosed to your client's in-house counsel as "Trade Secret/Commercially Sensitive."

In addition, we note that WM's position on this matter is not only reasonable, it is standard practice. If GP Harmon disagrees, we can only assume it is because GP Harmon is using this Opposition Proceeding as a vehicle for your client's in-house counsel and others in its legal department to view and have access to WM's sensitive commercial information.

Anthony

From: Jaime Rich Vining [mailto:JRVining@lfiplaw.com]
Sent: Friday, September 24, 2010 9:27 AM
To: Matheny, Anthony F. (Shld-Hou-IP-Tech); Tobor, Ben D. (Shld-Hou-IP-Tech)
Cc: Leslie J. Lott
Subject: RE: GP Harmon Recycling LLC v. Waste Management, Inc.

Dear Anthony:

We have reviewed both versions of the Protective Orders and, while there are some other differences, we believe that the key difference between the two proposed documents is the clause excluding in-house attorneys from access to confidential materials designated as attorneys' eyes only. This is unacceptable to our client. In order to best resolve this issue, please explain your position,

We look forward to hearing from you soon.

Very truly yours,

Jaime Rich Vining, Esq.
Attorney at Law

LOTT & FRIEDLAND
INTELLECTUAL PROPERTY

355 Alhambra Circle
Suite 1100
Coral Gables, FL 33134
Telephone: (305) 448-7089 x 210
Facsimile: (305) 446-6191

From: MathenyA@gtlaw.com [mailto:MathenyA@gtlaw.com]
Sent: Tuesday, September 21, 2010 11:27 AM
To: Jaime Rich Vining; ToborB@gtlaw.com

Cc: Leslie J. Lott
Subject: RE: GP Harmon Recycling LLC v. Waste Management, Inc.

Jamie,

We sent our version because your version was not acceptable. We have already spent time combining our version to your version (where acceptable), including correcting inconsistencies in your version. If your client does not wish to have you review our version, then we will rely on the Protective Order already put in place by the TTAB. Let us know what you want to do.

Anthony

From: Jaime Rich Vining [mailto:JRVining@lfiplaw.com]
Sent: Tuesday, September 21, 2010 10:18 AM
To: Matheny, Anthony F. (Shld-Hou-IP-Tech); Tobor, Ben D. (Shld-Hou-IP-Tech)
Cc: Leslie J. Lott
Subject: RE: GP Harmon Recycling LLC v. Waste Management, Inc.

Dear Anthony and Ben:

Thank you for your email. It is our client's preference to work from the draft protective order we sent you on August 27, so I am attaching that version for your comments.

We look forward to hearing from you soon.

Very truly yours,

Jaime Rich Vining, Esq.
Attorney at Law

LOTT & FRIEDLAND
INTELLECTUAL PROPERTY

355 Alhambra Circle
Suite 1100
Coral Gables, FL 33134
Telephone: (305) 448-7089 x 210
Facsimile: (305) 446-6191

From: MathenyA@gtlaw.com [mailto:MathenyA@gtlaw.com]
Sent: Thursday, September 16, 2010 10:08 AM
To: Jaime Rich Vining; ToborB@gtlaw.com
Cc: Leslie J. Lott
Subject: RE: GP Harmon Recycling LLC v. Waste Management, Inc.

Jamie,

Attached is a revised Protective Order that we propose using. We did not make direct modifications to your version, but instead combined some of your provisions with a Protective Order we have used in other cases. In general, the issues are essentially the same, however, we removed the following provisions from your Protective Order -- the last sentence of 5; 6(c); agreement to certain sanctions in 9; and the restrictions on court reporters, et al in 11 (although court reporters, et al. are still included in our version). We also removed some of the restrictions in the Declarations.

Let us know if this revised Protective Order is acceptable or if you have any questions or otherwise wish to discuss.

Anthony

Tax Advice Disclosure: To ensure compliance with requirements imposed by the IRS under Circular 230, we inform you that any U.S. federal tax advice contained in this communication (including any attachments), unless otherwise specifically stated, was not intended or written to be used, and cannot be used, for the purpose of (1) avoiding penalties under the Internal Revenue Code or (2) promoting, marketing or recommending to another party any matters addressed herein.

The information contained in this transmission may contain privileged and confidential information. It is intended only for the use of the person(s) named above. If you are not the intended recipient, you are hereby notified that any review, dissemination, distribution or duplication of this communication is strictly prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message. To reply to our email administrator directly, please send an email to postmaster@gtlaw.com.

From: Jaime Rich Vining [mailto:JRVining@lfiplaw.com]
Sent: Friday, August 27, 2010 4:43 PM
To: Tobor, Ben D. (Shld-Hou-IP-Tech); Matheny, Anthony F. (Shld-Hou-IP-Tech)
Cc: Leslie J. Lott
Subject: GP Harmon Recycling LLC v. Waste Management, Inc.

Dear Ben and Anthony:

As we are all diligently preparing responses to outstanding discovery requests, this seemed like the appropriate time to propose the entry of a Protective Order. Therefore, we have prepared the attached draft for your review. Please let us know if you have any comments or suggestions.

Have a great weekend!
Jaime

Jaime Rich Vining, Esq.
Attorney at Law

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INTELLECTUAL PROPERTY

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Coral Gables, FL 33134
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EXHIBIT D

VEV

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

Opposition No. 91184529

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

Opposition No. 91184529

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).

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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.

Opposition No. 91184529

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.

Opposition No. 91184529

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

Opposition No. 91184529

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/tbamp/stndacmnt.htm>