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37 C.F.R 1.8

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06/17/04  
Date

Gaimel Davis  
Signature

**TRADEMARK**

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

GEORGIA-PACIFIC CORPORATION )  
and FORT JAMES OPERATING )  
COMPANY, )

Opposers, )

v. )

SOLO CUP COMPANY, )

Applicant. )

Opposition No. 91157923

**OPPOSERS' MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION FOR  
ENTRY OF COMPREHENSIVE PROTECTIVE ORDER**

**INTRODUCTION**

Applicant's instant motion for protective order ("Applicant's Protective Order Motion") should be denied as a matter of law because it is not germane to Opposers' summary judgment motion filed on April 27, 2004 ("Opposers' Summary Judgment Motion").

Alternatively, if the Board considers Applicant's Protective Order Motion, the Board should modify two of the provisions in Applicant's proposed protective order because: (1) it does not provide Opposers' in-house counsel equal and adequate access to documents; and (2) it improperly requires the receiving party to disclose the identity of a consulting expert before such expert can review confidential documents of the producing party. Accordingly, Applicant's

proposed protective order should be amended to permit Opposers' in-house counsel full access to all documents and not require disclosure of consulting experts.

### ARGUMENT

#### **I. APPLICANT'S PROTECTIVE ORDER MOTION SHOULD BE DENIED BECAUSE IT IS NOT GERMANE TO OPPOSERS' SUMMARY JUDGMENT MOTION.**

Opposers agree that if the Board does not grant Opposers' Summary Judgment Motion, the parties will need a protective order. However, Opposers disagree that a protective order is necessary at this time. Currently, the proceedings are suspended because Opposers filed Opposers' Summary Judgment Motion. When a party in an opposition proceeding files a dispositive motion, the TTAB suspends the proceeding "with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion. . . ." 37 CFR § 2.127(d); TBMP § 528.03. Applicant's Protective Order Motion is not germane to Opposers' Summary Judgment Motion because a protective order is not necessary for Applicant to respond to Opposers' Summary Judgment Motion.

On May 24, 2004, Applicant responded to Opposers' Summary Judgment Motion by filing a combined Rule 56(f) motion/motion to compel ("Applicant's Rule 56(f) Motion"), requesting additional discovery before it had to file its response to Opposers' Summary Judgment Motion. Opposers responded to Applicant's Rule 56(f) Motion by arguing: (1) Applicant failed to demonstrate that the additional discovery it was seeking was germane to Opposers' Summary Judgment Motion, and (2) Applicant failed to demonstrate that it had been constrained from obtaining such discovery. *See* Opposers' June 10, 2004 Memorandum in Opposition to Applicant's Motion to Compel and to Take Additional Discovery Under Rule

56(f). To summarize Opposers' response to Applicant's Rule 56(f) Motion, the only information Applicant needs to respond to Opposers' Summary Judgment Motion is (or should be) within Applicant's possession, namely: (1) Applicant's Utility Patent; (2) Applicant's related discovery admissions; and (3) the evidence Applicant possessed when it asserted in its trademark application and Response to Office Action that Applicant's Claimed Mark was functional (after asserting the superior design of those features in Applicant's Utility Patent). Applicant does not require anything from Opposers (or any third parties) to respond to Opposers' Summary Judgment Motion.

Therefore, because Applicant does not need additional discovery, no protective order is necessary for the parties to proceed with Opposers' Summary Judgment Motion. Accordingly, Applicant's Protective Order Motion is not germane to Opposers' Summary Judgment Motion and should be denied as a matter of law.

**II. IF THE BOARD CONSIDERS APPLICANT'S PROTECTIVE ORDER MOTION, IT SHOULD DENY ENTRY OF APPLICANT'S PROPOSED PARAGRAPHS 10.B AND 12 AND SUBSTITUTE OPPOSERS' PROVISIONS PROPOSED BELOW.**

Opposers generally agree with most of the provisions contained in Applicant's proposed protective order. Opposers informed Applicant of that general agreement over two months ago, but also clearly objected to Applicant's proposed provisions that: (1) limited Opposers' in-house counsel from having full access to all relevant documents and information in the case; and (2) required identification of the receiving party's consulting experts before such experts could review the producing party's confidential documents. (See Opposers' counsel's April 8, 2004 letter to Applicant's counsel attached hereto as Exhibit A). Opposers proposed alternative procedures that would address Applicant's stated concerns, but also meet Opposers' needs. *Id.*

However, Applicant rejected any compromise, insisting on the provisions it proposed. Opposers have serious concerns about the limitations that Applicant's proposed paragraphs 10.B and 12 place on Opposers. Therefore, Opposers respectfully request that the TTAB deny entry of Applicant's paragraphs 10.B and 12 and enter the substitute provisions proposed by Opposers below.

**A. Any comprehensive protective order should provide in-house counsel with access to the same documents as outside counsel.**

There are at least five reasons why the Board should deny entering paragraph 10.B of Applicant's proposed protective order.

First, Opposers' in-house counsel are licensed attorneys who are bound by the same professional responsibility standards – and are subject to the same sanctions for violating those standards – as outside counsel. Opposers' in-house counsel understand their obligations to maintain the confidentiality of information covered by a protective order. In this regard, there really is no difference between Applicant's outside counsel, Opposers' outside counsel, and Opposers' in-house counsel. The Federal Circuit stated: “[I]ike 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.” *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1467-69 (Fed. Cir. 1984). The Federal Circuit then held that “status as in-house counsel cannot alone create the probability of serious risk to confidentiality and cannot therefore serve as the sole basis for denial of access.” *Id.* Other than asserting the mere fact that Opposers' in-house counsel are “in-house,” Applicant has not articulated, much less demonstrated, any reason for not disclosing information to Opposers' in-house counsel. As the Federal Circuit stated, Opposers' in-house counsel's status as in-house counsel cannot serve as the sole basis for denial of access.

Applicant has made no showing as to why Opposers' in-house counsel, in particular, should be barred from viewing any of Applicant's documents.

Applicant erroneously cites *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1469-72 (9th Cir. 1992) as support for its argument that in-house counsel should be barred from viewing a competitor's confidential information. The ruling in *Brown Bag* was based on a specific fact finding that in-house counsel, in that case, were actively involved in "competitive decision-making" within the corporation. *Id.* In that case, the in-house attorney was the only member of the legal department in a 15 employee company, in sharp contrast with the instant case, where the Opposers' in-house lawyers and paralegal working on this case are 3 members of a 100+ member legal department of Opposers, which together employ over 55,000 people. The holding in *Brown Bag* does not constitute a bright line rule that all in-house counsel should be banned from sensitive information because they might be involved in competitive decision making. Rather, the holding in *Brown Bag* applied to the specific facts of the case at issue, which are not present in this case.

In contrast, Applicant has not pointed to any evidence that Opposers' in-house counsel are involved in competitive decision-making. In fact, Applicant has not even inquired as to counsel's role at Opposers' corporations. Rather, Applicant would like the Board to apply a bright line rule – that does not exist – without any evidence that Opposers' in-house counsel are involved in the type of competitive decision-making discussed in *Brown Bag* and *U.S. Steel*. Applicant's argument presumes as a general proposition that in-house counsel are incapable of maintaining confidentiality and will violate their professional responsibility obligations by revealing confidential information to business people. Such a bright line rule does not exist and, in fact, was rejected by the Federal Circuit in *U.S. Steel*. *U.S. Steel*, 730 F.2d at 1468-69.

Second, Applicant's proposed protective order denies Opposers' in-house counsel the ability to participate fully in this opposition proceeding. It prevents Opposers' in-house counsel from considering Applicants' proprietary trade secrets information and "sensitive business information." It is critical for in-house counsel to have access to all available documents in order to make fully-informed decisions regarding strategy and settlement issues in this proceeding. If Opposers' in-house counsel do not have access to all relevant information, they will be at a disadvantage in managing Opposers' case.

Third, like all litigants, Opposers want to maintain efficiencies and economics in conjunction with litigation matters. Opposers' are integrally involved with all aspects of this litigation, (for example, Opposers' in-house counsel, not external, conducted discovery and forwarded all responsive documents to external counsel). To exclude in-house counsel from reviewing responsive documents would increase costs and create inefficiencies.

Fourth, the TTAB's template Protective Order ("Board's Protective Order") (a copy of which is attached as Exhibit B), allows in-house counsel full access to protected information. Pursuant to paragraph 3 of the Board's Protective Order, "Access to Protected Information," the definition of "attorneys" specifically includes in-house counsel and support staff operating under counsel's direction, such as paralegals. Further, this paragraph specifically provides attorneys with access to all confidential and highly confidential information (subject to any agreed upon exceptions). The only limitation placed on in-house counsel access to protected information in the Board's Protective Order is with regard to information designated as "trade secret/commercially sensitive," which Opposers believe will not apply to this matter.

Fifth, there is an important policy reason why the Board should deny paragraph 10.B of Applicant's proposed order and substitute Opposers' proposed paragraph set forth below.

Denying in-house counsel access to documents, solely because they are in-house counsel, would establish a chilling precedent for opposition/cancellation proceedings that would lead to an unfair advantage in certain circumstances. Oppositions and cancellation proceedings can be, and are, filed by in-house counsel at companies that choose not to utilize outside counsel. If the Board adopts the bright line rule proposed by Applicant and denies in-house counsel access to relevant information solely because they are in-house, that will preclude or severely limit in-house counsel from being able to litigate opposition or cancellation proceedings. Therefore, the same rule regarding access should apply to both in-house and outside counsel to promote fairness and consistency.

Based on the foregoing, Opposers request that if the Board enters a protective order, that it provide complete access to Applicant's documents and information to Opposers' in-house counsel by substituting the following provision for Applicant's paragraph 10.B:

“ATTORNEYS’ EYES ONLY” shall be made available only to, and inspected by: outside and-in-house counsel for the parties, and supporting personnel employed by such counsel, such as paralegal, legal secretary, data entry clerk, legal clerk, and/or private photocopying and exhibit preparation services – provided that such individuals are informed of the terms of this Order.

In the alternative, Opposers request that the Board enter the Board's Protective Order, with the modification that in-house counsel have access to all documents/information designated as “confidential” or “highly confidential.” Opposers are amenable to this alternative approach, based on the understanding that the TTAB views overdesignation, and improper designation, of documents and information as “trade secret/commercially sensitive” with disfavor.

**B. Any comprehensive protective order should not require disclosure of the identity of non-testifying expert witnesses before release of confidential information.**

Federal Rule of Civil Procedure 26(a)(2) articulates the requirements for disclosure of expert witnesses. That Rule specifies that “a party shall disclose to other parties the identity of any person *who may be used at trial* to present evidence under Rules 702, 703, or 705 of the Federal Rules of Evidence.” Fed. R. Civ. P. 26(a)(2) (emphasis added). Rule 26(a)(2) is silent regarding the disclosure of the identity of *consulting* experts who will not be used to testify at trial. In fact, Rule 26(b)(4)(B) states that a party may not discover the facts known or opinions held by a consulting expert without exceptional circumstances.<sup>1</sup> Rule 26(a)(2)’s silence and Rule 26(b)(4)(B)’s prohibition indicates that the drafters of the Federal Rules intended that the identity of consulting experts not be revealed.

The Board previously addressed a similar question, stating that “only under the ‘exceptional circumstances’ exception to FRCP 26(b)(4)(B) should the identity of a receiving party’s expert, who will not testify, be disclosed to the producing party.” *Anheuser-Busch, Inc. v. Bynum*, 1996 TTAB LEXIS 518, \*2-\*3 (TTAB Sept. 25, 1996) (finding no evidence of extraordinary circumstances and accepting opposer’s objection to the disclosure of the identity of a non-testifying expert) (a copy of this case is attached as Exhibit C); *see also* Fed. R. Civ. P. 26(b)(4)(B). There are no extraordinary circumstances in this case that warrant the disclosure of consulting experts. Applicant has not even asserted that such extraordinary circumstances exist.

To the extent Applicant is concerned with ensuring that an objectionable consulting expert – i.e., someone who worked for the receiving party or another competitor – does not view Applicant’s confidential information, there is another way to address that concern without

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<sup>1</sup> Or pursuant to Rule 35(b) which is not applicable to the current question.



revealing the identify of any consulting experts. Over two months ago, Opposers presented Applicant with a proposed provision that would address Applicant's concerns. That provision states:

Prior to disclosure of CONFIDENTIAL information of another party to an outside independent expert or consultant employed by counsel for assistance in the preparation, prosecution or trial of this action, counsel for the party that has received such CONFIDENTIAL information shall provide such expert or consultant with a copy of this Order, and shall require such expert or consultant to execute the declaration shown in Exhibit A. Through that declaration the expert or consultant acknowledges that he or she is familiar with the provisions of the Protective Order, will abide by them, and will agree to this Court's jurisdiction to enforce them. Each outside expert or consultant who will receive another party's CONFIDENTIAL information shall make a representation, as part of the declaration shown in Exhibit A, that he or she is not, and has not been previously, an employee, agent, or consultant for any of the other parties in this case (i.e., other than the party seeking to retain the expert or consultant), or any of such parties' competitors, to the best of his or her knowledge. Such declaration shall be kept by the employing counsel for reference should such be necessary. For a business organization retained as a consultant, the declaration shall be signed by a person authorized to bind the business organization who shall advise any other personnel of such consultant to whom CONFIDENTIAL information is disclosed of the obligations imposed by this Order. If a party wishes to retain an expert or consultant who cannot make all the representations required by Exhibit A, such expert or consultant shall be identified to the other parties prior to making any disclosure of such other parties' CONFIDENTIAL information in sufficient time (not less than two (2) weeks) for any party to object and seek further protection should it deem that necessary. If any party objects, no disclosure of such party's CONFIDENTIAL information shall be made to such expert or consultant until the matter is resolved.

(See Exhibit 1).

Opposers respectfully submit that this provision is adequate to address Applicant's concerns. Executing the protective order would bind the consulting expert to the same confidentiality requirements as any other person allowed to view such information. There is no reason for Applicant to require disclosure of the identity of such experts in contravention of the policy behind requiring disclosure of only testifying expert witnesses. *See* Fed. R. Civ. P. 26(b)(4)(B).

Therefore, Opposers' request that if the Board enters a protective order, it substitute Opposers' paragraph proposed above for Applicant's paragraph 12.

**CONCLUSION**

Based on the foregoing, Opposers respectfully request that the Board deny Applicant's Protective Order Motion on the ground that it is not germane to Opposers' Summary Judgment Motion. Alternatively, if the Board decides to enter a protective order at this time, Opposers further request that the Board deny entering paragraphs 10.B and 12 of Applicant's proposed protective order and substitute Opposers' proposed provisions that provide Opposers' in-house counsel full access to all documents and not require identification of a non-testifying expert before disclosure of confidential information.

Respectfully submitted,



William G. Barber  
Timothy M. Kenny  
Carrie L. Johnson  
FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201

ATTORNEYS FOR OPPOSERS  
GEORGIA-PACIFIC CORPORATION  
AND FORT JAMES OPERATING  
COMPANY

Dated: 6/17/2004

# FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP  
2100 IDS CENTER  
80 SOUTH EIGHTH STREET  
MINNEAPOLIS, MINNESOTA 55402-2112  
WWW.FULBRIGHT.COM

TIMOTHY M. KENNY  
PARTNER  
TKENNY@FULBRIGHT.COM

DIRECT DIAL: (612) 321-2805  
TELEPHONE: (612) 321-2800  
FACSIMILE: (612) 321-9600

April 8, 2004

## VIA DIGITAL SENDER AND U.S. MAIL

Brad Rademaker, Esq.  
Wallenstein & Wagner, Ltd.  
311 South Wacker Drive  
53rd Floor  
Chicago, Illinois 60606-6630

Re: Georgia-Pacific Corporation and Fort James Operating Company v.  
Solo Cup Company  
Our Matter No.: GEPA:007 (10308254)

Dear Brad:

We have reviewed your proposed Protective Order. We have concerns about a few provisions in your proposed draft that need to be resolved before Georgia-Pacific/Fort James can agree to stipulate to entry of the Order.

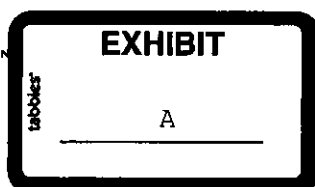
First, we are unable to agree to any protective order which prevents in-house counsel from having the same access to confidential information that is available to outside counsel. It is critical for in-house counsel to have access to all available documents in order for them to make decisions regarding strategy and settlement issues in this proceeding. The Federal Circuit stated that: "[I]ike retained counsel... in-house counsel are offices of the court, are bound by the same Code of Professional Responsibility, are subject to the same sanctions" before holding that "status as in-house counsel cannot alone create the probability of serious risk to confidentiality and cannot therefore serve as the sole basis for denial of access." *U.S. Steel Corp. v. United States*, 730 F.2d 1465, 1467-1469 (Fed. Cir. 1984) (reversing decision to deny in-house counsel access to confidential information and documents).

Second, we believe your proposed paragraph 11.B – that appears to require disclosure of consulting experts – contravenes the policy behind not requiring disclosure of consulting experts. Based upon your proposed provision, we believe we understand Solo's concerns regarding this issue. To address those concerns – while at the same time insuring non-disclosure of any consulting experts – we propose the following provision instead:

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Brad Rademaker, Esq.  
Wallenstein & Wagner, Ltd.  
April 8, 2004  
Page 2

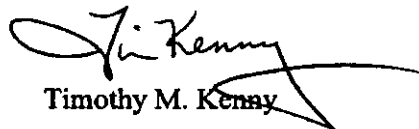
Prior to disclosure of CONFIDENTIAL information of another party to an outside independent expert or consultant employed by counsel for assistance in the preparation, prosecution or trial of this action, counsel for the party that has received such CONFIDENTIAL information shall provide such expert or consultant with a copy of this Order, and shall require such expert or consultant to execute the declaration shown in Exhibit A. Through that declaration the expert or consultant acknowledges that he or she is familiar with the provisions of the Protective Order, will abide by them, and will agree to this Court's jurisdiction to enforce them. Each outside expert or consultant who will receive another party's CONFIDENTIAL information shall make a representation, as part of the declaration shown in Exhibit A, that he or she is not, and has not been previously, an employee, agent, or consultant for any of the other parties in this case (i.e., other than the party seeking to retain the expert or consultant), or any of such parties' competitors, to the best of his or her knowledge. Such declaration shall be kept by the employing counsel for reference should such be necessary. For a business organization retained as a consultant, the declaration shall be signed by a person authorized to bind the business organization who shall advise any other personnel of such consultant to whom CONFIDENTIAL information is disclosed of the obligations imposed by this Order. If a party wishes to retain an expert or consultant who cannot make all the representations required by Exhibit A, such expert or consultant shall be identified to the other parties prior to making any disclosure of such other parties' CONFIDENTIAL information in sufficient time (not less than two (2) weeks) for any party to object and seek further protection should it deem that necessary. If any party objects, no disclosure of such party's CONFIDENTIAL information shall be made to such expert or consultant until the matter is resolved.

A copy of our proposed Exhibit A is attached to this letter.

Third, regarding the timing proposed in your protective order for certain events to take place, we believe that all such time periods should be the same and should be measured in **business** days. We think 10 or 14 business days should provide an adequate period for all of the events, but are open to discussing an alternative.

Please let us know when you are available to discuss these issues so we can try to reach agreement on a draft that satisfies the needs of both parties.

Very truly yours,



Timothy M. Kenny

TMK/jcd

cc: Linda Kuczma, Esq. (via email)

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

GEORGIA-PACIFIC CORPORATION )  
and FORT JAMES OPERATING )  
COMPANY, )

Opposers, )

v. )

SOLO CUP COMPANY, )

Applicant. )

Opposition No. 91157923

**Declaration Concerning Receipt of CONFIDENTIAL Information**

I, \_\_\_\_\_ (printed name), declare as follows:

1. I have been requested by counsel for \_\_\_\_\_ to assist counsel with the preparation, prosecution, or trial of this action and am informed by counsel that my role will require me to receive materials designated as CONFIDENTIAL under a Protective Order.

2. I have read and understand the terms of the Protective Order entered in this case (dated \_\_\_\_\_). I agree to abide by the terms of the Protective Order and will not disclose any information designated as CONFIDENTIAL information and will not use such information other than in my role in assisting counsel in this case.

3. I am not an employee of any of the parties in this case. I am not, and have not been previously, an agent or consultant for any of the other parties in this case, or any of such parties' competitors, to the best of my knowledge.

4. I agree to submit to the jurisdiction of the T.T.A.B. for enforcement of the undertakings I have made here and I appoint \_\_\_\_\_ (counsel for the party requesting assistance) as my agent to receive the service of process in that connection.



I declare under penalty of perjury that the foregoing is true and correct. Executed on

\_\_\_\_\_ (date).

\_\_\_\_\_  
(signature)

**Terms of Suggested Protective Agreement upon Stipulation**

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

Plaintiff

Proceeding No.

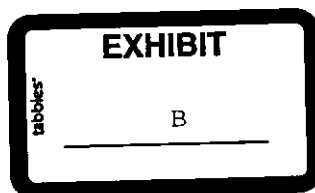
v.

Defendant

**PROVISIONS FOR PROTECTING  
CONFIDENTIALITY OF INFORMATION  
REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, either the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any

Appendix of Forms - 5



## APPENDIX OF FORMS

additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Parties may use this standard form order as the entirety of their agreement or may use it as a template from which they may fashion a modified agreement. If the Board orders that the parties abide by the terms of this order, they may subsequently agree to modifications or additions, subject to Board approval.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

### TERMS OF ORDER

#### *1) Classes of Protected Information.*

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential—Material to be shielded by the Board from public access.

Highly Confidential—Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive—Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

#### *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 document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no



## APPENDIX OF FORMS

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.***

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.

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.

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

Attorneys for parties are defined as including in-house counsel and outside counsel, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.

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.

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.

Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive.

Independent experts or consultants, non-party witnesses, and any other individual not

## APPENDIX OF FORMS

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 4 and 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.***

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.

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

## APPENDIX OF FORMS

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.***

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.

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

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.

## APPENDIX OF FORMS

### ***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.***

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.

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 affected 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. Occasions when a whole document or brief must be submitted under seal should be very rare.

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:

## APPENDIX OF FORMS

### 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.***

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.

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.

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.***

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.

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

## APPENDIX OF FORMS

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.

By Agreement of the Following,  
Effective:

\_\_\_\_\_  
[insert signature date]

\_\_\_\_\_  
[print or type name and title of  
individual signing for plaintiff]

\_\_\_\_\_  
[print or type name and title of  
individual signing for defendant]

\_\_\_\_\_  
[print or type name and law firm of  
attorney for plaintiff]

\_\_\_\_\_  
[print or type name and law firm of  
attorney for defendant]

By Order of the Board, effective \_\_\_\_\_.

\_\_\_\_\_  
[print or type name and title of Board attorney  
or judge imposing order]

LEXSEE 1996 TTAB LEXIS 518

Anheuser-Busch, Incorporated v. Charles D. Bynum

Opposition No. 94,460

Trademark Trial and Appeal Board

1996 TTAB LEXIS 518

September 25, 1996, Decided

**OPINION:**

[\*1]

This case now comes up for consideration of applicant's motion for a protective order; opposer's cross-motion for a protective order; and opposer's motions to extend the close of discovery and reset trial dates. The motion and cross-motions for a protective order have been fully briefed. Applicant filed briefs in response to opposer's first two motions to extend the close of discovery and reset trial dates, but not opposer's subsequently filed--and nearly identical--motions to extend.

**MOTIONS FOR PROTECTIVE ORDERS**

While both parties wish to exchange discovery pursuant to a protective order, they disagree as to its terms. Each party attached a copy of a proposed protective order to its motion, and moved for its entry over the other's objection. Their primary concerns may be reduced to three: (1) whether applicant, as opposed to his counsel, should be denied access to the confidential or trade secret information produced during discovery, (2) opposer's contention that applicant's proposed protective order would allow disclosure of confidential information to the former employees of a producing party and to third-party witnesses, and (3) opposer's contention that the prior disclosure [\*2] of the identity of all experts with which a party plans to consult, as required in applicant's proposed protective order, undermines FRCP 26(B)(4)(b). n1

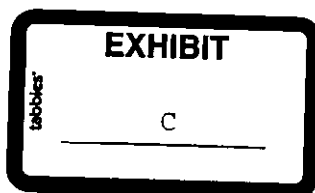
n1 Apart from the text of its proposed protective order, applicant makes no argument regarding issues (2) and (3) set forth supra.

The Board turns first to the issue of the prior disclosure of the identity of all experts consulted by a party.

Amidst the subordinate clauses of Paragraph 1(a) of applicant's proposed protective order is the requirement that any expert, to whom a producing party's discovery is to be shown by the receiving party, shall sign a copy of the proposed protective order, which in turn must be forwarded to the producing party for its approval at least ten days prior to the expert's examination of that discovery. Opposer correctly points out, however, that only under the "exceptional circumstances" exception to FRCP 26(b)(4)(B) should the identity of a receiving party's expert, who will not testify, be disclosed to the producing party. n2

n2 FRCP 26(B)(4)(b), of course, also provides for a FRCP 35(b) exception.

Accordingly, in the absence of a showing of exceptional circumstances, the Board finds as [\*3] well-taken opposer's objection to both the disclosure of the identity of a non-testifying expert, and the need for consent prior to that expert's review of the fruits of discovery. n3



n3 It is generally sufficient in proceedings before the Board that a protective order provide that any expert not be, nor never have been, an officer, director, or employee of any of the parties, and that such expert agrees in writing to be bound by the protective order regarding confidential information.

The Board turns next to the issue of the disclosure of confidential information to former employees of a producing party or third-party witnesses.

Absent an actual, proposed disclosure to an identified former employee or third-party witness, and an explanation of the circumstances of such disclosure, the Board declines to rule on the propriety of Paragraphs 1(b) and (c) of applicant's protective order. As set forth in more detail infra, the parties are to resolve this issue in drafting a new stipulated protective order.

The Board turns next to the issue of access to confidential information produced during discovery.

Opposer would allow access to confidential or trade secret information produced [\*4] during discovery only to the Board and its staff, outside and in-house counsel and their staff, and certain independent experts and consultants. Applicant would also allow access by the parties themselves to all confidential information, with the limited exception of "competition sensitive" information, i.e., information which applicant would define as including "trade secrets and other highly sensitive information relating to competitive subject matter, i.e., fishing tackle." n4

n4 Paragraph 9 of applicant's proposed protective order makes reference to information that a party believes should be designated "CONFIDENTIAL - ATTORNEYS ONLY." It is on pages 3-5 of applicant's motion for a protective order where applicant defines such special confidential information as that "competition sensitive" information which pertains to the "fishing tackle business," presumably some aspect of the business activities associated with applicant's claimed goods, namely, "fishing lures."

In support of its proposed protective order, applicant argues that (1) applicant, as a one-man operation, has limited financial resources and thus no in-house counsel or large staff of outside counsel and independent [\*5] consultants, (2) applicant is uniquely positioned, as a businessman and angler, to evaluate all of opposer's discovery responses, and (3) applicant would be denied due process if, given his limited resources and special expertise, he were unable to have direct access to all confidential information produced by opposer.

In support of its protective order, and in opposition to applicant's, opposer argues that the purpose of a protective order is to keep confidential or trade secret information out of the hands of a knowledgeable competitor, and that it is precisely because applicant, as a one-man operation, is so "uniquely positioned" within his business that direct access by applicant, as opposed to applicant's attorney, to the confidential information of opposer is inappropriate. n5

n5 As examples of confidential information, opposer cites certain of applicant's first set of interrogatories and first set of document requests regarding opposer's sales (Interrogatories 1 and 5), marketing studies (Interrogatory 10, Requests 3 and 4), and license agreements (Request 5).

Commonly, the terms of a protective order provide specification as to, inter alia, the persons to whom confidential [\*6] or trade secret information n6 may be disclosed (i.e., outside counsel; in-house counsel; counsel's necessary legal and clerical personnel; etc.). See Rany L. Simms, *TIPS FROM THE TTAB: Stipulated Protective Agreements*, 71 *Trademark Rep.* 653 (1981). Furthermore, disclosure of specific types of discovery information has been limited to "attorney's eyes only" in the absence of a showing by the receiving party of a need for access thereto. In *Neville Chemical Company v. The Lubrizol Corporation*, 184 USPQ 689 (TTAB 1975), the Board found that:

Inasmuch as the information to be revealed by opposer includes names of customers, and since the Board does not see that applicant itself, as opposed to applicant's attorneys, has any need for such information which would outweigh the possible harm to opposer from the revelation thereof to applicant, the protective order should provide that the information furnished by opposer will be confined to applicant's attorneys and will not be disclosed to the detriment of opposer.

*Id.* at 690. In *Davis v. General Motors Corporation*, 184 USPQ 288 (N.D. Ill. 1974), [\*7] the court found that:



...because the disclosure of the requested material may affect other parties in addition to the defendant, i.e., manufacturers and suppliers, this court considers it proper at this time to require that such information be disclosed only to plaintiff's trial attorney and non-party, court approved, independent experts or consultants.

n6 For example, annual sales and advertising figures generally are discoverable, and may be made under a protective order, if the disclosing party considers such information confidential. See *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985).

In the instant proceeding, applicant has not made a showing why he, as opposed to his counsel, should have access to opposer's confidential information which, pursuant to common practice, would not normally be disclosed directly to him. First, the Board agrees with opposer that it is applicant's unique position within his business which precludes his access to opposer's confidential information. Second, applicant is represented by competent counsel. There is no reason why applicant's attorney cannot discuss all relevant issues with his [\*8] applicant in the preparation of applicant's case without discussing whatever confidential information opposer might produce in the course of discovery. Third, while the Board is sympathetic to applicant's desire to lessen the litigation costs necessarily incurred in an opposition proceeding, they do not outweigh the fact opposer is entitled to keep certain of its business information confidential. The fact that the parties' have to administer a system of confidentiality, and thus incur costs, does not render that system invalid under any theory of law set forth in these motions. Fourth, applicant's argument is for general access to opposer's confidential information. Presently, there is no dispute before the Board regarding the production of specific confidential information.

Accordingly, and unless they agree otherwise, the parties are allowed until October 7, 1996 in which to work out a stipulated protective order which incorporates the ruling and guidelines set forth or referenced herein, and to submit same for entry in this proceeding. First, the protective order is to contain one level of confidentiality to which only the parties' attorneys and non-parties, including experts [\*9] and consultants, are to have access. n7 Second, the parties are to decide whether or not they wish to include a provision for the disclosure of confidential information to former employees of a producing party, to third-party witnesses, or to similar persons. If the parties cannot agree, they are to include a provision allowing the proposal of such a disclosure and the opportunity to object to that proposed disclosure. Actual disclosure is to be prohibited absent agreement between the parties. As in all discovery disputes, recourse to the Board is to be had only after the parties make a good faith effort to resolve a dispute over a proposed disclosure. Third, the protective order is not to contain any provisions which require the prior disclosure of experts and consultants or the related need to obtain consent in contravention of FRCP 26. Lastly, The remaining provisions of the protective order are to otherwise comply with the guidelines set forth in TBMP § 416 n8 (Protective Orders) in general, and § 416.06 (Contents of Protective Order) in particular. n9 The parties' respective motions for a protective orders are therefore denied to the extent they do not conform to the ruling and [\*10] guidelines set forth or referenced herein.

n7 In view thereof, the Board need not address applicant's second-tier concept of "competition sensitive" information other than to state that the business of either party which is subject to discovery in this proceeding may fall under the parties' protective order.

n8 The Trademark Trial and Appeal Board Manual of Procedure (TBMP) (Stock No. 903-022-00000-1) is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 [Telephone: (202) 512-1800]. The TBMP is also available via the USPTO home page on the internet: <http://www.uspto.gov/web/uspto/tbmp>.

n9 The parties are also referred to TBMP § 419 (Discovery Guidelines) and the relevant numbered paragraphs and the cases cited therein regarding what is discoverable and what is confidential. The parties are reminded, however, that while discovery in Board proceedings may involve the discovery and exchange of confidential information, that should be a limited amount of material in view of the limited jurisdiction of the Board over the question of the registrability of marks only. See Section 17 of the Trademark Act. Generally, most of the relevant information to be exchanged by the parties is not confidential material.

[\*11]

**MOTION TO EXTEND THE CLOSE OF DISCOVERY AND RESET TRIAL DATES**

The Board turns next to opposer's motion to extend the close of discovery and reset trial dates.

Both parties, in their filings herein, have recognized the need for a protective order to protect their confidential or trade secret information. Moreover, it appears that neither party has produced all documents requested by the other due to their impasse over a protective order. Opposer's motions to extend the close of discovery and reset trial dates, to the extent they are subsumed by the trial order below, are therefore granted for good cause shown. However, in view of applicant's objections thereto, discovery will not be extended again unless the parties stipulate thereto or upon a showing of excusable neglect. n10 See FRCP 6(b).

n10 If the parties are engaged in settlement negotiations, the Board suggests that they immediately file a motion on consent to suspend these proceedings pending settlement negotiations. Should those negotiations subsequently fail and proceedings resume, the Board, unless otherwise stipulated to by the parties, will reset the close of discovery so as to preserve the time remaining in discovery as of the filing date of the consented motion to suspend. [\*12]

In accordance with the Trademark Rules of practice, the close of discovery is extended and the trial dates reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE:	November 7, 1996
Testimony period for party in position of plaintiff to close (opening thirty days prior thereto)	January 6, 1997
Testimony period for party in position of defendant to close (opening thirty days prior thereto)	March 7, 1997
Rebuttal testimony period to close (opening fifteen days prior thereto)	April 21, 1997

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

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. Rule 2.125.

Alan M. Datri

Attorney, Trademark Trial and Appeal Board

CERTIFICATE OF MAILING  
37 C.F.R 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: BOX TTAB – NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on the date below:

4/17/04  
Date

Jaime C. Davis  
Signature

TRADEMARK

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

GEORGIA-PACIFIC CORPORATION )  
and FORT JAMES OPERATING )  
COMPANY, )  
 )  
Opposers, )  
 )  
v. )  
 )  
SOLO CUP COMPANY, )  
 )  
Applicant. )  
 )

Opposition No. 91157923

TTAB



06-21-2004

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TRANSMITTAL

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Arlington, Virginia 22202-3514

Commissioner:

Transmitted herewith please find an original of the following documents:

1. Opposers' Memorandum in Opposition to Applicant's Motion for Entry of Comprehensive Protective Order;
2. Certificate of Service; and
3. Return Postcard.

Please return the enclosed postcard to evidence receipt of these materials.

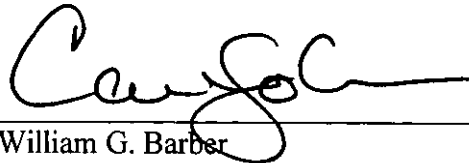
No fee is believed to be due in connection with this filing. However, should any fees under 37 C.F.R. § 2.6 be deemed necessary relating to this filing, the Commissioner for Trademarks is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Deposit Account No. 50-1212/10308254(GEPA:007/TMK).

All communications concerning the referenced opposition should be addressed to:

Timothy M. Kenny, Esq.  
c/o Trademark Docketing  
Fulbright & Jaworski L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
Facsimile No.: (512) 536-4598

Date: June 17, 2004

Respectfully submitted,



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William G. Barber  
Timothy M. Kenny  
Carrie L. Johnson  
FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
Telephone: (512) 474-5201

ATTORNEYS FOR OPPOSERS  
GEORGIA-PACIFIC CORPORATION AND FORT  
JAMES OPERATING COMPANY

## CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of Opposers' Memorandum in Opposition to Applicant's Motion for Entry of Comprehensive Protective Order was forwarded to counsel for Applicant, via first-class mail, postage prepaid, on June 17, 2004, as follows:

Linda A. Kuczma, Esq.  
Brad Rademaker, Esq.  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive  
53rd Floor  
Chicago, Illinois 60606-6630



Jaime C. Davis