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

Proceeding	91180212
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SCHERING CORPORATION,

Opposer,

v.

IDEA AG,

Applicant.

Opposition No.: 91/180,212

App'n Serial No. 77/070,074

Mark: DIRACTIN

The Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S SECOND MOTION
TO COMPEL DISCOVERY RESPONSES AND TO TEST SUFFICIENCY OF
RESPONSES**

AND

**APPLICANT'S SECOND MOTION FOR MODIFICATION OF THE BOARD'S
STANDARD PROTECTIVE ORDER (TBMP § 412.02(a))**

I. INTRODUCTION

Applicant IDEA AG ("Applicant") hereby respectfully opposes the second motion of Opposer Schering Corporation ("Opposer") to compel Applicant to provide additional responses to certain interrogatories and requests for production, and to test the sufficiency of Applicant's responses to certain requests for admission (the "Second Motion").

Opposition No. 91180212
Application Serial. No. 77/070,074
Atty. Docket No. 108-007TUS

Opposer's first motion to compel and to test the sufficiency of discovery responses (the "First Motion") was denied by the Board, on February 4, 2009, on grounds that Opposer had failed to adequately confer with Applicant prior to filing the motion. (Board Order, page 5, attached as Exhibit 18 to Opposer's Second Motion.) Opposer's Second Motion has the exact same defect: apparently viewing the pre-motion conferral requirement as a bare technical requirement rather than a substantive one, Opposer went through the slightest motions of appearing to invite conferral, but did this on a pro-forma basis only, while refusing to actually engage in any the kind of good faith substantive communications that the Board specifically called for. (Id.)

Despite numerous requests by Applicant, and thorough communication by Applicant of the factual and legal bases for its objections to the discovery requests in question, Opposer in turn failed and refused to offer any explanation for its positions, instead limiting its "conferral" to (1) purely conclusory and unsupported statements on what is discoverable, and (2) repeated demands that Applicant further explain itself to Opposer, even though Applicant had already done so extensively, and even though Opposer refused to offer any substantive explanations or arguments on its side that would allow Applicant to intelligently assess Opposer's reasons for disagreeing with the legal positions that Applicant had already fully articulated. Despite it being Opposer's burden to show good cause why its own motion should be granted, Opposer's "conferral" consisted of a series of bare demands only, with no effort to communicate the substantive basis for any good cause it purports to have. For this reason, Applicant's Second Motion is as lacking as its First Motion, and should likewise be denied.

Moreover, to the extent the Board may reach the substance of the Second Motion, Applicant has already provided adequate responses to the discovery in question, in compliance with the requirements of the Trademark Rules and the Federal Rules of Civil Procedure. Much of Opposer's requested discovery is, however, plainly overreaching

and even harassing in nature, and designed to garner information that is plainly irrelevant, privileged, and/or otherwise not susceptible to discovery in this action. Applicant considers that the scope of the present opposition should be properly restricted to examining whether the mark “DIRACTIN” (“Mark”) should be refused registration, and should not extend to matters that have no bearing on that question. Much of Opposer’s discovery has improperly focused on the latter category, and to that extent, Applicant has rightfully interposed objections and declined to respond further.

Unfortunately, the scope of Opposer’s requests far exceeds the scope of the issues presented in these proceedings; Applicant firmly believes that Opposer’s overbroad—and at times completely irrelevant—discovery inquiries improperly aim to obtain confidential and/or privileged information about Applicant’s business activities, with the specific aim of hindering Applicant’s ability to lawfully market its products in the United States.¹ Whatever Opposer’s motivations may be, Applicant’s discovery responses set forth valid objections that clearly demarcate the limits of permissible discovery in this action. Opposer’s Second Motion must therefore be denied.

¹ Applicant finds Opposer’s improper discovery particularly troubling in light of the meritless nature of these opposition proceedings. Significantly, the PTO’s examining attorney in charge of the underlying 1(b) application never made any mention of Opposer’s marks as a possible barrier to registration for Applicant. This likely due in part to the total lack of similarity between Applicant’s and Opposer’s respective goods. Opposer’s TINACTIN mark is used in connection with over-the-counter anti-fungal skin creams used to treat athlete’s foot, jock-itch, ringworm and the like. In contrast, Applicant intends to use its DIRACTIN mark in connection with a prescription-only topical anti-inflammatory/analgesic gel used primarily to treat pain from osteoarthritis and other joint conditions. Notably, none of Opposer’s discovery relates to the critical inquiry into how there could ever be a likelihood of confusion between such vastly different products.

In addition, there is no actionable similarity between the parties’ respective marks, since the “ACTIN” portion of each mark also appears in a large number of registered and pending U.S. trademarks that Opposer has never challenged, while the remaining “TIN” and “DIR” portions of the respective marks are not substantially similar. It is thus apparent that this opposition proceeding—including the discovery at issue in the instant motion—is not bona fide, but is rather an improper attempt to obtain confidential/proprietary information about Applicant and/or to impair Applicant’s ability to lawfully market its products in the United States.

II. LEGAL ARGUMENT

A. Opposer Has Again Failed to Confer With Applicant Prior to Filing Its Second Motion

Opposer's Second Motion correctly sets forth the timeline of its purported "conferral" efforts (*see* Second Motion at 4-5), but not the substance of those efforts. Opposer's merely pro-forma approach to pre-motion conferral is amply evidenced by the documents already filed by Opposer in support of its Second Motion. After Opposer's First Motion was denied on February 4, 2009 (see Board Order, Exhibit 18 to Opposer's Second Motion), counsel indeed exchanged a series of emails and a telephone call, as explained in Opposer's Second Motion (at 4-5). The actual content of those discussions is plainly displayed in Exhibits 19-24 of Opposer's Second Motion.

During an initial telephone conference on February 24, 2009, Opposer's counsel requested that Applicant review each disputed discovery item and indicate whether Applicant intended to supplement its previous discovery responses. (*See* Second Motion, Exh. 20.) Applicant did so, and replied through counsel on March 6, 2009, with a detailed email indicating that Applicant had reviewed the disputed items; that such review revealed several outstanding issues for which Opposer had not yet explained its position; and that, in order to confer meaningfully, Applicant would at least need some indication from Opposer of what legal theories and arguments support its motion. (*Id.*, Exh. 21.) Specifically, Applicant pointed out that Opposer had not yet provided any authority, or otherwise articulated any basis for its views, on the applicability of German attorney-client privilege to certain categories of documents sought by Opposer; on the applicability of the controlling authorities cited by Applicant regarding trademark use and priority issues in this 1(b) (intent-to-use) opposition proceeding; or on the Board's power to enter a modified protective order upon motion of a party, pursuant to Trademark Rule

2.116(g).² In addition, Applicant requested that Opposer clarify exactly which discovery requests would be at issue in the Second Motion, since Opposer had not yet told Applicant whether the Second Motion would cover the exact same requests as the First Motion. Applicant concluded that it could not yet agree to modify its discovery responses based on the merely conclusory positions that Opposer had taken up to that point, but that, in order to facilitate meaningful discussion, Opposer was invited to finally explain the basis of its positions on these issues, to which Applicant would then gladly give consideration.

At this point, Opposer shut down completely in terms of any effort to actually communicate substantively, apparently finding it too bothersome to actually engage with Applicant prior to filing its motion. Opposer's counsel's email of March 9, 2009, merely repeats its short and conclusory statements on what it thinks is and isn't discoverable, with no accompanying authority or argument that would permit Applicant to meaningfully assess Opposer's positions, and then declares an "impasse." (*See* Second Motion, Exh. 22). Applicant's counsel replied on March 12, 2009, explaining again that "[Applicant] would like to hear and consider [Opposer's] arguments ... [but that Opposer] had not yet seen fit to communicate [them], either in the briefing on the previously-denied motion, during the recently-initiated conferral process, or at any time.... [Opposer] has refused to provide any basis or support for its ... views, and has instead made only conclusory assertions about what is and isn't discoverable. Such pro forma, non-substantive engagement is insufficient to create an 'impasse.'" (*See* Second Motion, Exh. 23.)

Finally, on March 20 and 23, 2009, counsel exchanged a final set of emails, in which Applicant's counsel again reiterated that "despite several requests, [Opposer] has

² Incorporated herein is Applicant's second motion to modify the Board's Standard Protective Order in this case. (*See* section II.C., below.)

not yet given us even an inkling of the rationale for its position on these few key issues.... If [Opposer] will finally do so ... then we can likely narrow the discussion for purposes of an informed and productive phone call.” (Second Motion, Exh. 24.)

Opposer again ignored Applicant’s entreaties, and thereafter filed its Second Motion without attempting any further communication with Applicant.

For the second time, Opposer has improperly ignored the scope and spirit of Trademark Rule 2.120(e)(1) and Fed. R. Civ. P. 37(a)(1), this time by attempting to create the appearance of conferring with Applicant’s counsel, but actually repeatedly refusing to engage substantively or make any good faith attempt to resolve any of the outstanding issues. This is ample justification for the Board to deny Opposer’s Second Motion.

B. Opposer’s Second Motion Has No Substantive Merit

The instant discovery motion sharply criticizes Applicant’s valid objections as to relevance and privilege, which are intertwined with an overarching issue involving the proper scope of a protective order in this case.

Briefly summarized (with additional detail below), Applicant’s positions on the primary issues are as follows:

- Discovery relating to “first use” is completely irrelevant to an opposition proceeding such as the instant one, in which *priority is not at issue*. Similarly, discovery regarding later “use” is necessarily irrelevant in an opposition to an **intent-to-use** application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), in which **no actual use has been alleged** in the application. In this area, Opposer appears to have an ulterior motive of fishing for business intelligence that has no probative value in this case.
- Regarding documents and communications subject to attorney-client privilege and/or the work product doctrine, choice of law principles require the

application of the relevant German law to questions involving documents that, if in existence, were created by Applicant's German attorneys working in Germany. Under German law, attorneys are strictly forbidden from disclosing either the content *or the existence* of any communications between the attorney and the client, extending to trademark search documents and/or opinion letters relating thereto. Accordingly, should any such documents exist, they cannot be produced or even identified in a privilege log, as such identification would reveal the existence of the documents, and would further subject the German attorneys involved to criminal sanctions under German law for making this disclosure.

- As Opposer's Second Motion faithfully indicates, the one, and only, subject of the Second Motion that the parties have actually discussed in detail is the appropriate scope and language of a protective order covering the substantial amount of highly sensitive and proprietary business information that Opposer seeks from Applicant. Because Opposer is now demanding unreasonable concessions from Applicant in exchange for agreeing to a stipulation to modify the Board's Standard Protective Order, Applicant is compelled to seek the Board's intervention, which is required to vigorously protect the confidential business activities of Applicant from being unnecessarily exposed. To ensure protection, Applicant hereby makes its own motion to modify the Standard Protective Order.

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C. A Modified Version of the Standard Protective Order is Completely Warranted (TBMP § 412.02(a))³

In response to the numerous requests propounded by Opposer relating to sensitive commercial information of Applicant (which would not be available to Opposer through any other means), Applicant's counsel reviewed the Board's Standard Protective Order ("SPO"), and is concerned that there are virtually no protections in the form of post-proceeding confidentiality obligations. (*See* further discussion in Exhs. 8-11 of Opposer's Second Motion.) Specifically, there is nothing in the SPO that imposes a duty of confidentiality on Opposer for any of the information it has requested of Applicant after conclusion of this proceeding. This problem is exacerbated by the fact that Opposer has already gamed the system in such a way as to frustrate any attempt by Applicant to obtain discovery from Opposer. Thus, the risks associated with the SPO are, in this situation, completely one-sided.

In what may be viewed as irony, Opposer's law firm has gone on record as being opposed to the Board's SPO, especially where the parties are competitors. Opposer's law firm, in a letter it has posted on its own website, states that "the automatic entry of the Board's standard protective order will not provide adequate protection to confidential information in a significant percentage of cases." (*See Exhibit A* hereto.) This case clearly involves competitors, and, as mentioned in other areas of this opposition, Opposer has probed quite deeply into sensitive confidential information of Opposer, including a

³ Applicant's previous motion for modification of the Board's Standard Protective Order was denied without prejudice. Having now made further efforts to reach a meeting of the minds on this issue (*see* communications evidenced in Second Motion, Exhs. 21, 22), Applicant hereby renews its motion.

significant number of requests that probe areas completely unrelated to any of the issues in the present proceeding.

Counsel for Applicant contacted counsel for Opposer to address these issues, in an attempt to reach an amicable resolution. Opposer requested specific reasons for changes being implemented, as well as red-line copies of all the changes made by Applicant to the SPO. (*See* Opposer’s Second Motion, Exhs. 8-10.) Opposer largely conceded to the changes made by Applicant, and even made a few additional corrections to help improve the clarity of the standard protective order. (*Id.*) However, Opposer also added a section entitled “Court Jurisdiction, Venue,” in which Applicant was to agree to both jurisdiction in the district court of New Jersey for certain disputes between the parties, and venue in New Jersey for virtually any dispute between the parties. Since Applicant has no relationship with the forum unilaterally selected by Opposer, and more importantly because that change was completely unrelated to the basic deficiencies in the Board’s SPO, Applicant, understandably, rejected the counter-offer. Opposer, however, then indicated that it would not agree to any modification of the SPO *unless* Applicant agreed to Opposer’s onerous “Court Jurisdiction, Venue” provision.⁴ (*Id.*) Because that provision would be patently unfair, and because Opposer expressly stated that it was

⁴ Applicant further takes note of the Board’s comment, in its order on Opposer’s First Motion, that “the Board’s jurisdiction over the parties and their attorneys terminates when the proceeding is terminated, thereby limiting the Board’s authority to determine or oversee what choice of laws or forum would be proper in the event of any post-termination disputes between the parties.” (Board Order, attached as Exh. 18 to the Second Motion.) Since the Board would thus be unable to enforce the venue provision that Opposer is demanding, Applicant does not understand why Opposer continues to insist on it, unless such insistence is merely a pretextual reason for refusing to agree to an otherwise fair and agreeable modification to the SPO.

unwilling to budge, Applicant has been unable to resolve this issue, which has necessarily delayed Applicant's ability to produce materials to Opposer.⁵

To resolve this issue, Applicant respectfully requests, pursuant to TBMP § 412.02(a), that the Board enter as an order the revised stipulated protective order attached as Exhibit 8 to Opposer's Second Motion.

D. Applicable German Law on Attorney-Client Privilege Absolutely Precludes Discovery of the Content or Existence of Any Attorney-Client Communications

Applicant's objections of attorney-client privilege and/or work product protection require particular attention in this case, as the objections concern documents, advice and information that, if in existence, are/were embodied in communications in Germany between German attorneys and Applicant. These documents, advice and information are subject to the strict German laws governing attorney-client privilege, under which the privilege extends to both the content *and the existence* of the entirety of attorney-client communications, including but not limited to trademark search documents (if any) and search-related communications and opinions. Furthermore, as discussed below, a German Patent and Trademark Attorney ("Patentanwalt") is also subject to a strict obligation to zealously maintain all client communications as secret, and risks criminal sanctions by doing otherwise. Accordingly, Applicant cannot be compelled to disclose the content or existence of any documents and/or communications that occurred or may have passed between the Patentanwalt and their client.

⁵ Prior to making the instant Second Motion for Modification of the Board's SPO, Applicant discussed these issues yet again with Opposer, by telephone on February 24, 2009, and again by email on March 6, 2009. (*See* Second Motion, Exh. 21.) Again, no resolution was reached.

Rule 501 of the Federal Rules of Evidence provides that questions of privilege are decided under the common law. *Astra Aktiebolag v. Andrx Pharms., Inc.*, 208 F.R.D. 92, 97 (S.D.N.Y. 2002) (applying German law to sustain claims of attorney-client privilege in U.S. court). The “common law” applied under Rule 501 includes “choice of law” principles. *Id.* Where, as here, alleged privileged communications take place in a foreign country or involve foreign attorneys, the Federal Circuit defers to the law of the jurisdiction “where the allegedly privileged relationship was entered into” (in this case, Germany) or “the place in which that relationship was centered at the time the communication was sent” (again, Germany). *Id.* at 98. Thus, letters between a party’s in-house counsel and outside counsel, all German, containing legal opinions and advice, are subject to German laws of privilege and confidentiality. *See id.*

Another powerful holding in support of deference to German law on privilege in the present case is *McCook Metals L.L.C. v. Alcoa, Inc.*, 192 F.R.D. 242, 257 (N.D. Ill. 2000), where the court stated that “[u]nder German law, attorney-client privilege protects “**all** communications between a German patent attorney and his client which occur in the rendition of legal services for the client, the client and the attorney may refuse to disclose such communications in a court proceeding”” (citation omitted; emphasis added). *See also Santrade, Ltd. v. General Electric Co.*, 150 F.R.D. 539, 547 (E.D.N.C. 1993); John E. McCabe, Jr., “Attorney-Client Privilege And Work Product Immunity In Patent Litigation” in *2001 Intellectual Property Law Update*, edited by Anthony B. Askew and Elizabeth C. Jacobs, Aspen Law & Business, §3.01[C][2][b][3].

For definitional purposes, a Patentanwalt is entitled to represent clients in litigation matters before various German Federal Courts in matters arising from the

German Patent Act, German trademark law, and in other proceedings where the case involves a question involving an industrial property right.⁶ For the avoidance of any doubt, the recognized protections of German law extending to attorney-client communications involving a Patentanwalt are not restricted to matters involving only a German patent (or application therefor). Section 3, paragraph 2 of the Patentanwaltsordnung (“Regulations Governing the Conduct of German Patent Attorneys” or PatAnwO) concerns “Legal Advice and Representation” and explicitly recognizes that a Patentanwalt is empowered to “advise others or to represent them against third parties” (“zu beraten und Dritten gegenüber zu vertreten”) in matters concerning the acquisition, maintenance, defense, and challenging of “a trademark or another symbol protectable under the German trademark laws....” (“...einer Marke oder eines anderen nach dem Markengesetz geschützten Kennzeichens...”). The above-quoted German text can be found in the relevant section of the PatAnwO (Exhibit B.1 hereto) and in the accompanying English translation included therein. Accordingly, any privilege or other legal provisions pertaining to the governance of Patentanwalt conduct covers the *entirety* of a Patentanwalt’s scope of recognized professional practice, including activities relating to trademark protection and related advice given to the client in the context of the attorney-client relationship. (See Declaration of Dr. Martin Grund [“Grund Decl.”], ¶ 4, attached hereto as Exhibit B).

The rules of professional ethics, privilege, and discipline governing the conduct of a Patentanwalt are administered by the German Patent Attorney Chamber

⁶ See: PatAnwO §4(1), Exhibit B.1 hereto. A Patentanwalt may act in litigation (“Rechtsstreitigkeiten”), where the claim arises out of the German Patent laws (“Patentgesetz”) or trademark laws (“Markengesetz”) before the German Patent Courts.

(“Patentanwaltskammer”) and are enforceable by the German courts. Such rules are similar to those governing the conduct of a German attorney at law (“Rechtsanwalt”), and dictate that a Patentanwalt: (i) is bound to strict secrecy regarding client information, extending to *everything* that has come to his knowledge while performing in his professional capacity⁷ (*see* Exhibit B, Grund Decl., ¶ 4); and (ii) has the right to exercise a testimonial privilege by refusing testimony for “personal reasons” during civil proceedings (§383 ZPO)⁸ and in criminal proceedings (§53 StPO)⁹ (*see* Grund Decl., ¶ 7). Breach of this strict rule of secrecy by a Patentanwalt, in particular where the secret concerns business or operations information which is disclosed in confidence to the Patentanwalt, or otherwise became known during the course of the attorney-client relationship, is treated harshly under German law, and is considered to be a criminal offense punishable by a fine or a prison sentence not exceeding one year (§203 StGB).¹⁰ (*See* Exhibit B, Grund Decl., ¶ 8.) Similar to public policies underlying parallel U.S. practices, it is self-evident that these provisions are in place to encourage a free and forthright exchange of information between the German Patentanwalt and the client.

⁷ *See* PatAnwO, §39a (Exhibit B.1). The English translation provided with the exhibit was generously provided by the Patentanwaltskammer (German Patent Attorney Bar Association, Munich, Germany) to Dr. Martin Grund on October 6, 2008.

⁸ *See* ZPO (German Code of Civil Procedure) §383, governing a person that has been entrusted with information where secrecy is mandatory in view of their “appointment, status, or trade,” which governs confidential client information received by a person having a status as a Patentanwalt. (Exhibit B.1)

⁹ *See* StPO (German Code of Criminal Procedure) §53, which specifies that patent attorneys may refuse to give evidence during criminal proceedings for “professional reasons.” (Exhibit B.1)

¹⁰ *See* StGB (German Criminal Code) §203. (Exhibit B.1)

To summarize, under the German law that is applicable to this proceeding by way of the Federal Circuit's choice of law principles, the production *or disclosure* of Patentanwalt communications, whether written or oral, cannot be compelled. *Astra Aktiebolag*, supra, at 98. Under German law¹¹, attorney-client privilege protects "all communications between a German patent attorney and his client which occur in the rendition of legal services for the client, [and] the client and the attorney may refuse to disclose such communications in a court proceeding." *McCook Metals L.L.C. v. Alcoa, Inc.*, 192 F.R.D. 242, 257 (N.D. Ill. 2000) (emphasis added); *see also Santrade, Ltd. v. General Electric Co.*, 150 F.R.D. 539, 547 (E.D.N.C. 1993). Applicant's objections to discovery requests in this area, and its declination to produce a privilege log that would reveal the existence of such protected communications, are therefore valid and justified.

E. Applicant has Properly Responded to all Discovery Requests Propounded by Opposer

At the level of each individual discovery request, Opposer's Second Motion is very difficult to understand, to the point of near-unintelligibility, because it presents arguments only in general fashion, without bothering to state which arguments apply to each discovery request. While Applicant and the Board are therefore left guessing on this point, Applicant will attempt to address the issues that Opposer may have in mind for

¹¹ "Under Fed. R. Civ. P. 44.1, although the parties may present evidence as to the substance of foreign law, the court may conduct its own research on foreign law, and its ruling on what foreign law requires is deemed a ruling of law. *See* 5 James Wm. Moore, et al., *Moore's Federal Practice*, P 44.1.01[2] at 44.1-3 to -4 (2d ed. 1992). Thus, it is not necessarily the case that the plaintiffs here bear a burden of proof on this issue...." *Golden Trade v. Lee Apparel Co.*, 143 F.R.D. 514, 524 n. 5 (S.D.N.Y. 1992).

each individual discovery request¹² in issue. To that end, Applicant further opposes Opposer's Second Motion on the following specific grounds:

1. INTERROGATORIES

Interrogatory No. 4

Applicant's substantive response to this interrogatory is already complete, indicating simply that there are no non-privileged documents in IDEA's custody, possession and control that are responsive to this interrogatory. To the extent that Opposer demands a privilege log, Fed. R. Civ. P. 26(b)(5) includes an important carve-out: a responding party need not, in making a privilege log, reveal information that is itself privileged. German law, which is controlling in this instance under applicable comity and choice of law principles, dictates that both the content and the existence of any such document is strictly privileged and subject to stringent secrecy obligations. (*See* Section II.D., above.)

In addition, this Interrogatory clearly requests sensitive and proprietary business information of Applicant. Even if the Board were to disregard the significant privilege issue, identification of these kinds of documents would have to occur under the protection of a suitable protective order. There is no such suitable protective order in place, as the SPO (as discussed above) is completely insufficient in adequately safeguarding Applicant's interests, especially since Applicant is located outside the United States. Accordingly, Applicant respectfully moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Interrogatory No. 10

Applicant's substantive response speaks for itself: if no "sales, marketing, advertising [or] promotion" under Applicant's Mark have occurred in the United States, as stated, then logically there can be no "person most knowledgeable" about those activities.

In addition, Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (*intent to use*) application, where any alleged "use" of the Mark has no probative value and would only be speculative. The topics of "sales, marketing, advertising and promotion" fall under the heading of "use" of the Mark. While such information may be generally discoverable in regard to 1(a) (actual use) applications, the requested information has no pertinence to the prosecution of a 1(b) application in which no "use" has been, or need yet be alleged.

Finally, Applicant stands by its other stated objections, which are not disputed in Opposer's Motion, such that Opposer has now waived the opportunity to do so.

¹² Since Opposer has attached the individual requests and responses to its Second Motion, for the sake of brevity Applicant will not repeat that information here.

Interrogatory No. 12

To the extent Applicant is aware of any publications, this Interrogatory is duplicative of Interrogatory No. 11, which has already been answered (*see* Opposer's Second Motion, Exh. 4) – apparently to Opposer's satisfaction, since Interrogatory No. 11 is not at issue in the present Motion.

To the extent information regarding third party publications (if any) is sought, Applicant maintains its objections of overbroad, unduly burdensome, etc. Such information could come from an infinite number of sources, and is equally available to Opposer.

To the extent this Interrogatory seeks information regarding Applicant's own "use" of the Mark, the objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "use" of the Mark has no probative value, since no allegation of use has been filed. (*See* Interrogatory No. 10, above.).

Interrogatory No. 13

Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "use" of the Mark has no probative value since no allegation of use has been filed. The topics of "licenses, permissions [and] consents" fall under the heading of "use" of the Mark. Accordingly, relevance has not been established. (*See* Interrogatory No. 10, above.)

In addition, this Interrogatory requests sensitive and proprietary business information from Applicant. Even if the Board were to ignore the significant relevance issues, identification of such documents would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Interrogatory No. 14

Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "use" of the Mark has no probative value. The topic of "promotion" falls under the heading of "use" of the Mark. (*See* Interrogatory No. 10, above.)

In addition, this interrogatory requests sensitive and proprietary business information. Even if the Board were to ignore the significant relevance issues, identification of such documents would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Interrogatory Nos. 19 and 20

On its face, this interrogatory seeks information regarding a business relationship to the extent that relationship “relates or pertains” to the Mark. Applicant has adequately responded that there is no such relationship. Now, Opposer’s Second Motion attempts to broaden the facial language of the interrogatory by demanding information regarding “Applicant’s business relationship” with the third-party entity *irrespective* of whether the Mark is involved. This strays far beyond relevance, does not reflect the actual language of the interrogatory, and is a particularly egregious attempt to discover potentially valuable (and confidential) business information that has no relevance to these proceedings.

In addition, this interrogatory requests sensitive and proprietary business information. Even if the Board were to ignore the significant relevance issues, identification of such documents would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant’s proposed modification of the Standard Protective Order (“SPO”), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, which are not disputed in Opposer’s Second Motion, such that Opposer has now waived the opportunity to do so.

Interrogatory No. 22

The substantive response is complete, and speaks for itself.

2. DOCUMENT REQUESTS

Request Nos. 1 and 2

Opposer’s only argument is that a privilege log is required. However, Applicant has not made any privilege-based objections. Since Opposer provides no other basis on which a response should be compelled, the Second Motion must be denied as to this Request.

At any rate, Applicant’s objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged “use” of the Mark has no probative value. The topic of “advertisements ... for goods sold” falls under the heading of “use” of the Mark. (*See* Interrogatory No. 10, above.)

Applicant stands by all of its stated objections, none of which are disputed in Opposer’s Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 3

Applicant’s objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged “use” of the Mark has no probative value. The request expressly concerns “use” in the United States. (*See* Interrogatory No. 10, above.)

Despite valid objections, Applicant’s response offers to produce documents under a suitably modified protective order. That offer remains open. Applicant therefore

moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

In the absence of the requested modification to the SPO, Applicant stands by all its stated objections, most of which are not disputed in the Second Motion, such that Opposer has now waived the opportunity to do so.

Request Nos. 4 and 5

The substantive response is complete, and speaks for itself.

In addition, Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "use" of the Mark has no probative value. The topic of "promoting sale and use" falls under the heading of "use" of the Mark. (*See* Interrogatory No. 10, above.)

Applicant stands by all its stated objections, most of which are not disputed in the Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 6

The substantive response is complete, and speaks for itself.

At any rate, Applicant stands by all its stated objections, most of which are not disputed in the Second Motion.

Since the Second Motion does not take issue with Applicant's objections pursuant to attorney-client privilege, Opposer has waived its opportunity to do so. However, in the event that privileged documents may exist and the Board would wish to require a privilege log, Fed. R. Civ. P. 26(b)(5) includes an important carve-out: a responding party need not, in making a privilege log, reveal information that is itself privileged. German law, which is controlling in this instance under applicable choice of law principles, provides that both the content and the existence of such documents are strictly privileged. (*See* section II.D., above.)

Request No. 7

Applicant stands by all its stated objections, most of which are not disputed in the Second Motion, such that Opposer has now waived the opportunity to do so.

In the event that privileged documents may exist and the Board would wish to require a privilege log, Fed. R. Civ. P. 26(b)(5) includes an important carve-out: a responding party need not, in making a privilege log, reveal information that is itself privileged. German law, which is controlling in this instance under applicable choice of law principles, provides that both the content and the existence of such documents are strictly privileged. (*See* section II.D., above.)

In the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant's other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Request No. 8

Applicant's objection as to relevance is valid because discovery concerning the "date of first use" (if any) is necessarily irrelevant to an opposition proceeding in which priority is not at issue. Opposer's mark TINACTIN was registered on November 24, 1964. Applicant's 1(b) application was filed on December 22, 2006. Given the elapsed time of over forty years, Applicant has no intention of defending its application on grounds of priority. While "first use" information may be generally discoverable, per TBMP § 414(5), the cases cited in that section illustrate that the general rule applies only to cases in which priority is at issue. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 U.S.P.Q. 193, 195-96 (TTAB 1976) (first use is "relevant to issue of priority"); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 U.S.P.Q. 495, 496 (TTAB 1975) (first use information "goes to the veracity of [a] claim of first use"). In the instant case, Applicant's 1(b) application makes no claim of first use, and priority is not at issue. Where priority is not at issue, plain logic dictates that "first use" cannot be relevant.

In the event that privileged documents may exist and the Board would wish to require a privilege log, Fed. R. Civ. P. 26(b)(5) includes an important carve-out: a responding party need not, in making a privilege log, reveal information that is itself privileged. German law, which is controlling in this instance under applicable choice of law principles, provides that both the content and the existence of such documents are strictly privileged. (*See* section II.D., above.)

In the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant's other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Request No. 9

Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "continuous use" of the Mark has no probative value. (*See* Interrogatory No. 10, above.)

In the event that privileged documents may exist and the Board would wish to require a privilege log, Fed. R. Civ. P. 26(b)(5) includes an important carve-out: a responding party need not, in making a privilege log, reveal information that is itself privileged. German law, which is controlling in this instance under applicable choice of law principles, provides that both the content and the existence of such documents are strictly privileged. (*See* section II.D., above.)

In the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant's other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 10

The substantive response is complete, and speaks for itself.

In addition, this request is egregiously burdensome, overbroad, vague, and lacking in specificity to the point of incomprehensibility. Documents "evidencing, relating or referring to" a product has a virtually limitless scope.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request Nos. 11, 12, 13, 14, 16, 17, 18, 19, 20 and 21

The substantive responses are complete, and speak for themselves.

Further, Applicant stands by all its stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 15

While trademark search documents (if any) may be generally discoverable as explained in TBMP § 414(6), they are not discoverable here. German law, which is controlling in this instance under applicable choice of law principles, provides that both the content and the existence (or non-existence) of search documents are strictly privileged. To the extent that a privilege log may otherwise be required, Fed. R. Civ. P. 26(b)(5) includes an important carve-out which therefore applies here: a responding party need not, in making a privilege log, reveal information that is itself privileged. Providing a privilege log in this instance would be counter to the combined effect of applicable (German) law and Fed. R. Civ. P. 26(b)(5). (*See* section II.D., above.)

Further, Applicant stands by all its stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 22

This request is egregiously burdensome, overbroad, vague, and lacking in specificity to the point of incomprehensibility. A request for documents "evidencing, relating or referring to" an entire company (or companies) has a virtually limitless scope.

In addition, Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "use" of the Mark has no probative value. The topics of importation and distribution fall under the heading of "use" of the Mark. (*See* Interrogatory No. 10, above.)

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 23

Despite valid objections, Applicant's response offers to produce documents under a suitably modified protective order. That offer remains open. Applicant therefore moves the Board to approve Applicant's proposed modification of the SPO, as requested in Section II.C., above, and for the reasons set forth therein.

Request No. 24

Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any alleged "use" of the Mark has no probative value. Licensing, if any has occurred, would be pertinent only to potential "use" of the Mark. (*See* Interrogatory No. 10, above.)

In the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant's other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request Nos. 25 and 26

This interrogatory seeks information regarding a business transaction (if any) involving purchase of *pharmaceutical compounds*. Such a transaction, if it occurred, strays far beyond relevance to anything related to trademark rights, and is a particularly egregious attempt to discover potentially valuable (and confidential) business information that has no relevance to these proceedings.

In the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant's other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed modification of the Standard Protective Order ("SPO"), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 27

This request is egregiously burdensome, overbroad, vague, and lacking in specificity to the point of incomprehensibility. A request for documents "evidencing, relating, or referring to" Applicant's intent to use the Mark has a virtually limitless scope.

In the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant's other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant's proposed

modification of the Standard Protective Order (“SPO”), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer’s Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 28

Applicant’s response offers to produce the only document in Applicant’s possession, custody or control that is responsive to the request. However, production will need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant’s proposed modification of the Standard Protective Order (“SPO”), as requested in Section II.C., above, and for the reasons set forth therein.

Request No. 29

This request is egregiously burdensome, overbroad, vague, and lacking in specificity to the point of incomprehensibility. A request for documents “evidencing, relating or referring to” an entire “business relationship” with a third-party entity has a virtually limitless scope that goes far beyond anything related to trademark rights. Yet again, this nothing more than an attempt to discover potentially valuable (and confidential) business information that has no relevance to these proceedings.

Moreover, in the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant’s other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant’s proposed modification of the Standard Protective Order (“SPO”), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer’s Second Motion, such that Opposer has now waived the opportunity to do so.

Request Nos. 30, 31, 32, 33 and 34

The named third-party entity is not an applicant in these proceedings, or a party to these proceedings in any respect. Any purported “ownership” of the Mark by that entity is irrelevant to Opposer’s opposition to the instant application, which is prosecuted by Applicant alone.

In addition, this request is plainly burdensome, overbroad, vague, and lacking in specificity. A request for documents that “evidence, refer, or relate to” such documents (if any) has an excessively broad scope. If Opposer has specific documents in mind, or even a reasonably narrow category of documents in mind, it should have written its request accordingly.

Moreover, in the event that the requested documents may exist, they would be sensitive and proprietary. Even if the Board were to ignore the validity of Applicant’s other objections, production (if any) would need to occur under the protection of a suitable protective order. Applicant therefore moves the Board to approve Applicant’s

proposed modification of the Standard Protective Order (“SPO”), as requested in Section II.C., above, and for the reasons set forth therein.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer’s Second Motion, such that Opposer has now waived the opportunity to do so.

Request No. 35

The substantive response is complete, and speaks for itself.

Further, Applicant stands by all its stated objections, most of which are not disputed in Opposer’s Second Motion, such that Opposer has now waived the opportunity to do so.

In addition, Applicant hereby incorporates its discussions, above, regarding each Interrogatory that requests identification of documents (namely, Interrogatory Nos. 4, 12, 13) as well as its objections to other interrogatories that request identification of documents but are not themselves subject to the instant Second Motion (namely, Interrogatory No. 11; *see* Second Motion, Exh. 4)

Request No. 36

This request is plainly burdensome, overbroad, vague, and lacking in specificity, and fundamentally designed to harass Applicant. Applicant set forth a number of valid objections to this request directly, and further incorporates its valid objections to the various Requests for Admission at issue (*see* Second Motion, Exh. 6), which are too numerous to repeat here.

Request No. 37

Applicant stands by its objections to this request. Moreover, Opposer’s attempt to compel a further response to this request is nonsensical and moot: Applicant did not refer to any documents in its responses to interrogatories or requests for admission, with the lone exception of the 1(b) application that is the subject of this case, and is easily available to Opposer through the Trademark Office’s Document Retrieval System. Opposer apparently did not see fit to determine that there was any reason to file a motion on this response before burdening the Board and Applicant by doing so. This is not surprising, as it is in keeping with Opposer’s overall failure to attempt to confer with Applicant prior to filing the Second Motion.

3. REQUESTS FOR ADMISSIONS

Request Nos. 1, 2, 4 and 5

Applicant’s objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any admission regarding “use” (or non-use) of the Mark has no probative value. (*See* Interrogatory No. 10, above.)

Request No. 3

This request concerns priority, which is necessarily irrelevant to an opposition proceeding in which priority is not at issue. (See Document Request No. 8, above.)

Request Nos. 6, 7, 8 and 9

While admissions concerning the occurrence (or non-occurrence) of a trademark search may be generally subject to discovery as explained in TBMP § 414(6), they are not subject to discovery here. German law, which is controlling in this instance under applicable comity and choice of law principles, provides that both the content and the existence (or non-existence) of search documents are strictly privileged and subject to a stringent requirement of secrecy. (See section II.D., above.)

Request Nos. 10 and 11

The request is vague, ambiguous and uncertain in its meaning.

While vague, the request appears to concern priority, which is necessarily irrelevant to an opposition proceeding in which priority is not at issue. (See Document Request No. 8, above.)

Further, Applicant's objection as to relevance is valid because this is an Opposition proceeding concerning a 1(b) (intent to use) application, where any admission regarding "use" (or non-use) of the Mark has no probative value. (See Interrogatory No. 10, above.)

Request Nos. 16, 17 and 18

This request has no legitimate discovery purpose, and appears intended merely to continue Opposer's pattern of harassment toward Dr. Stacey Farmer. The document in question speaks for itself.

Moreover, the request cannot be meaningfully admitted or denied, as it is a compound request that would require at least two separate admissions or denials.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request Nos. 20 and 22

This request has no legitimate discovery purpose, and appears intended merely to continue Opposer's pattern of harassment of Applicant. The document, while unauthenticated, speaks for itself.

Moreover, the request cannot be meaningfully admitted or denied, as it is a compound request that would require at least two separate admissions or denials.

Finally, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

Request Nos. 21 and 23

The request cannot be meaningfully admitted or denied, as it is a compound request that would require at least two separate admissions or denials.

Further, Applicant stands by its other stated objections, most of which are not disputed in Opposer's Second Motion, such that Opposer has now waived the opportunity to do so.

III. CONCLUSION

Opposer has propounded a set of discovery that is remarkably overbroad, straying far into irrelevant and/or privileged areas, to which Applicant has dutifully responded in substance where warranted, and with valid objections where appropriate. Moreover, Opposer has, for the second time in these proceedings, refused to confer with Applicant in any meaningful way prior to filing a discovery motion. Applicant therefore requests that the Board deny Opposer's Second Motion. Applicant further requests that the Board grant Applicant's own motion to modify the Standard Protective Order, by adopting instead the modified order contained in Exhibit 8 to Opposer's Second Motion.

IDEA AG

DATED: April 17, 2009



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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S SECOND MOTION TO COMPEL DISCOVERY RESPONSES AND TO TEST SUFFICIENCY OF RESPONSES and APPLICANT'S SECOND MOTION FOR MODIFICATION OF THE BOARD'S STANDARD PROTECTIVE ORDER (TBMP § 412.02(a)) was served on counsel for Opposer, this 17th day of April, 2009, by sending same via First Class U.S. Mail, prepaid, to:

David J. Kera, Esq.
Beth A. Chapman, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

DATED: April 17, 2009



Sarah Jarvis

EXHIBIT A



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[« AIPLA Submits Comments to TTAB, Raising Many Concerns with Proposed Rules | Main | INTA Comments on TTAB Rules »](#)

March 20, 2006

Oblon, Spivak Submits Comments to PTO

Oblon, Spivak has submitted comments to the PTO's TTAB Rules Package

Archives

- [March 2006](#)

March 20, 2006

[Via E-Mail](#)

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The Honorable Jon Dudas
Undersecretary of Commerce for Intellectual Property and Director of the United States
Patent and Trademark Office
Box Comments
P.O. Box 1450
Alexandria, VA 22313-1450

The Honorable Gerard F. Rogers
Administrative Trademark Judge
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Comments on Proposed Rules: "Miscellaneous Changes to Trademark Trial and
Appeal Board Rules"

[71 Federal Register 2498 \(January 17, 2006\)](#)

Dear Undersecretary Dudas and Judge Rogers:

Our firm appreciates the opportunity to comment on the U.S. Patent and Trademark Office's ("PTO") proposal to Amend the Rules of Practice before the Trademark Trial and Appeal Board, which were published in the *Federal Register* on January 17, 2006 [71 F.R. No. 10, at 2498]. The following comments are provided based on our review and understanding of the proposed rules. The proposed rules raise numerous significant issues, which would benefit from additional discussion between the PTO and the attorneys and parties that will be affected.

Onerous Effects of Proposed Amendments

The changes which are proposed are in fact far reaching and substantive in nature and effect. Requirements imposed on parties in the early stages of proceeding are greatly increased and the procedure in general will entail greater costs, particularly in the early stages when it is unknown whether an applicant will seriously contest an opposition. The great majority of applications are filed under 15 U.S.C. § 1051(b) on the basis of a *bona fide* intention to use the mark of an application. Many of those applications are filed as trial balloons to see whether they will survive examination by the trademark examining attorneys and, thereafter, whether any other party will raise a serious objection. By imposing on opposers an obligation to make initial disclosures within one hundred days after the filing of an opposition (the institution of a proceeding, if filed electronically, usually occurs within twenty-four hours after the opposition is transmitted electronically to the Trademark Trial and Appeal Board) would mean that preparations for making the initial disclosures would have to begin weeks before the opposition is filed when it would not even be known whether an applicant would contest an opposition. The marshalling of evidence, identification of witnesses, and searching of old records and files can be a time consuming and expensive exercise, all of which may be wasted if an applicant defaults by not answering an opposition or quickly enters into negotiations for an agreement that would avoid further proceedings.

The PTO characterizes the proposed amendments as “non-substantive changes to the rules” and states that the goals of the proposed amendments are to increase efficiency of the Board proceedings, enhance settlement prospects, lead to earlier settlement, and, for cases that do not settle, promote greater exchange of information leading to increased procedural fairness and greater likelihood that cases determined on their merits will be determined on a fairly created record.

The undersigned, who have been practicing before the Trademark Trial and Appeal Board (“TTAB”) for decades, and include a former Administrative Trademark Judge, are not aware of substantial criticism that the cases decided by the TTAB lack procedural fairness or are based on unfairly created records. Furthermore, the TTAB is already an effective alternative dispute resolution forum: approximately 95% of all cases are being resolved prior to final hearing. It is unlikely that the proposed amendments will have the intended effect on the remaining 5% -- however, they may undermine the current settlement-oriented nature of practice before the TTAB. In particular, the proposal that a suspension for settlement negotiation must precede the filing of an answer or await the discovery conference ignores the fact that settlement negotiations frequently start after an answer is filed but before discovery begins. If settlement negotiations are discouraged at that stage, an opportunity for an agreement may be deferred for a long time or lost.

A discovery conference, when both parties are jockeying for a favorable position to obtain as much information as possible while disclosing the least possible information, is not a hospitable atmosphere for even a preliminary settlement discussion.

Initial Disclosures

One of the reasons offered by the PTO for the institution of initial disclosures, which is one of the key elements of the proposed rule changes, is an article that was published in May 1998 entitled "An Empirical Study of Discovery and Disclosure Practice Under the 1993 Federal Rule Amendments," cited at 71 F.R., No. 10 at Page 2500. This study does not offer support for the wide ranging changes that the PTO seeks to implement for Board practice, particularly the proposals for initial disclosures.

The analogy fails for two reasons. First, the initial disclosure rule in the Federal Rules of Civil Procedure, Rule 26(a)(1), F.R.Civ.P., provides for disclosure of four types of information: (1) the names, addresses, and telephone numbers of individuals likely to have discoverable information that the disclosing party may use to support its claims or defenses, unless solely for impeachment, with an identification of the subjects of the information; (2) a copy or description by category and location of all documents, date of compilations, and tangible things that are in the possession, custody, or control of the party and that the disclosing party may use to support its claims or defenses, unless solely for impeachment; (3) a computation of any category of damages claimed by the disclosing party; (4) a copy of any insurance agreement under which an insurer may be liable to satisfy part or all of a judgment or to indemnify or reimburse payments made to satisfy a judgment.

Of the four categories of disclosure in Rule 26(a)(1), categories 3 and 4 are irrelevant to Board practice because damages are outside the scope of the Board's jurisdiction.

The first two categories, which are essentially the identification of witnesses and identification of documents, must be disclosed only if they support the disclosing party's claims or defenses.

The PTO's proposal is unsupported by the experience of the Federal Courts under Rule 26(a)(1), F.R.Civ.P. The Federal Rule contemplates the disclosure of sources of information which a party may use to support a claim or defense on its own behalf. The PTO's proposed rules contemplate the disclosure of many categories of substantive information, going well beyond disclosure of source or location, including categories of information which would be detrimental to the disclosing party and not intended for use in supporting the disclosing party's claim or defense. The proposed initial disclosure rule is inconsistent with the explanation at 71 F.R. 2051: "For a variety of reasons related to the unique nature of Board proceedings, the intent of initial disclosure can be more limited than in the courts while still promoting the goals of increased fairness and efficiency." On the contrary, the rule, as explained at Page 2501, would require initial disclosures far exceeding initial disclosures in district court actions based on the Trademark Act.

The effect of the PTO's proposed rule, which appears to require the disclosure of admissions against interest, would evidently be to make parties very careful to limit and restrict their disclosure of any information which under any interpretation could be used to the detriment of the disclosing party. This would not only defeat the purpose of the initial disclosure rule but would lead to a sharp increase in the number of motions filed at the Board to compel more complete disclosure, to preclude the introduction of testimony and evidence, or to strike testimony and evidence from the record. These motions would increase the cost of proceedings, the time of pendency of proceedings, and most importantly the demands on the Board's personnel to decide a multitude of motions which do not exist under the present practice.

It also appears from the Board's explanation at Page 2501 that the initial disclosures are described, at least in part, by general descriptions of categories of information rather than by the persons or places wherein the information may be known or recorded. For example, one of the items for initial disclosure is "evidence of actual confusion possessed by a party in regard to the involved marks." This does not define the evidence as being admissible or not or by the type of evidence which exists, (e.g., letters, memoranda, notes, recorded telephone conversations, records of telephone conversations, emails, information compiled as electronic data, or any other means of record keeping).

Similarly, the information described as "the party's awareness of third-party use or registration of marks that are the same or very similar for goods or services the same as or closely related to the involved marks and goods or services" would require a disclosing party to search all of its records of the type described in the preceding paragraph plus others (for example, search reports, which would not necessarily be limited to search reports on the mark in issue) and to interpret key words such as "awareness", and "very similar" for marks and "closely related" for goods or services. Some of these interpretations would require the exercise of keen legal judgment and could be the subject of second guessing at some later undetermined point in the proceedings if it became tactically advantageous for a party to challenge the adequacy of the disclosure.

Some of the information described as the subject of initial disclosure is so confidential and important that it is difficult to conceive that a party would voluntarily disgorge the information absent an order from the Board, which, of course, would entail additional motion practice. This information includes "plans for future use of any marks on which claims or defenses rely". Does this apply only to applicants relying on 15 U.S.C. § 1051(b), whose future plans bear on the *bona fides* of the intent to use the mark or also to opposers, whose future plans are irrelevant unless natural expansion of use is an issue? Plans for future use are often closely guarded trade secrets and whether or not they should be disclosed would be a rich source of controversy and motions to compel.

Another category of information which a party might be very reluctant to disclose would be "market research conducted by the party in regard to any involved mark on which it will rely." Major manufacturers of consumer goods frequently do market research to assess, among other things, the success or failure of a proposed or ongoing advertising or promotional campaign, to assess its relative position compared

to competitors, to test- market a new product, or to test the aided or unaided recall of a mark by its present and potential customers. The vast majority of this ongoing market research would never find its way into the record of a proceeding before the Board, and disclosure to others, particularly to direct or even indirect competitors, could be very damaging. This, again, is an area which could produce a large increase in motions before the Board to test the adequacy of the disclosures made by a party.

Some of the information described in the initial disclosure explanation could simply be irrelevant. These might include the "origin of any mark on which the party relies, including adoption or creation of the mark and original plans for use of the mark" when an opposer is relying on a mark that has been in use and registered for many years. In addition, information about the origin and first use may have long since disappeared. This again could produce motions by applicants who contest the assertion that information about origin and first use is no longer available or is irrelevant.

Another category of information which could produce many motions is "information regarding...controversies in which the party has been involved, which were related to the involved marks or, if applicable, assertedly non-distinctive matter." What is a "controversy" could be a very subjective judgment capable of wide or narrow interpretation, depending on the point of view of a party.

It is suggested that, to facilitate the orderly and expeditious progress of Board proceedings and to avoid the expansion of motion practice which can be anticipated if the proposal as published is adopted, the types of information to be required in initial disclosures should be the following (which would follow the requirements of rule 26(a)(1), F.R.Civ.P

- 1) The names of individuals of a party, and the contact information therefor, who are known to have the most extensive knowledge in support of a party's claims or defenses, and the nature and extent of that knowledge.
- 2) General descriptions of, and the probable locations of, documents and things in the possession, custody or control of the party, in support of a party's claims or defenses.

Pro Se Adversaries Will Benefit Disproportionately From the Proposed Amendments

Our experience has been that we are, more and more, dealing with *pro se* adverse parties in opposition proceedings. *Pro se* parties, in general, do not understand trademark terminology or trademark law, and, of course, they do not understand TTAE procedures and rules. We may anticipate that, if the proposed rules are adopted in the form published in 71 F.R., there will be many cases pending at the Board where *pro se* parties do not comply with the initial disclosure requirements, may not even comply with the discovery conference requirement, and yet will receive lenient treatment because the Board historically has given *pro se* parties additional time and additional guidance

The result will be an imbalance in performance between parties represented by counsel and parties representing themselves, which will impose a greater burden on parties represented by counsel and, ultimately, a greater burden on the TTAB.

In its comments on page 2501, “the Board recognizes the existence of other issues relatively unique to the Board proceedings, for example, that a high percentage of applications involved in oppositions are not based on use of the applied-for mark in commerce, but rather, on intent to use, on a foreign registration or on an international registration.” Clearly, the disclosures being required of these parties will be relatively nominal compared to individuals and companies that have extensive use of one or more marks that may serve as the bases for an opposition.

Shifting the Burden for the Service of the Notice of Opposition/Cancellation

The Board currently sends out scheduling orders on the same day or within 2 days of the filing of an opposition or petition for cancellation through ESTTA. Therefore, the proposed change will not end up in greater efficiencies, but may actually slow the institution of a proceeding while the Board awaits receipt of the pleading, fee, and proof of service.

The requirement for service of process by the plaintiff could create additional burdens on the party filing the action, especially in the event that the documents are returned as undeliverable. For example, although “undeliverable” mail does not usually include a delivery date, under the proposed rules the plaintiff must take further affirmative action, the timing of which is dependent on when the undelivered copy is received. It is unclear if the plaintiff has an affirmative duty to make a further investigation or if it is sufficient to advise the Board of the returned document. What happens if the returned letter includes a new address? Must the plaintiff re-serve the document, and then what happens with the dates that previously were set by the Board? Is it the plaintiff's duty to inform the Board that it re-served the document at a new address? It appears that the Board will still be required to issue new discovery and trial schedules, so even the Board would not always benefit from this proposed new procedure.

In addition to requiring plaintiff to serve the owner of record, the plaintiff is required to serve any “party the plaintiff believed had an ownership interest” even if that ownership interest is not recorded, although the requirement applies only when it was “known to plaintiff”. Under these circumstances, if the proper party is not served and a default judgment is issued, any party with an ownership interest, which could include a licensee, an unrecorded assignee, or as receiver or trustee in bankruptcy, learning of the default judgment may bring an action against the plaintiff for not complying with the rules and serving the proper parties. Accordingly, the proposed rule exposes the plaintiff (and counsel) to liability or, alternatively, invites them to make sure to keep the blinders on.

In support of the proposed amendment, the PTO asserts that “plaintiffs and defendants often are in contact prior to a plaintiff’s filing of its complaint or claim”. However, unless the filing of an extension of time constitutes such “contact”, more often than not, the parties are not in contact.

In light of the increasing use of ESTTA and electronic service of process by the PTO without human intervention, the proposed changes in the service of process are unnecessary.

Discovery Conference

In requiring the parties to conduct discovery conferences, the PTO is not recognizing the fact that an increasing proportion of the parties are *pro se* and/or foreign and are not familiar with the TTAB rules or proceedings. By requiring the parties to confer, those with counsel are being given the task of educating the *pro se* and/or foreign individuals and entities.

This potentially penalizes those who are represented by counsel because they have to take the time and effort to explain the rules, issues, and procedures — possibly to individuals for whom English is not a first language. In a recent case, even though an applicant filed an application in English, along with the declaration, when she was contacted about a possible consent judgment, she simply responded that she did not speak English, requiring us to hire foreign counsel in order to communicate with the applicant. The proposed amendments fail to take into account such situations and are likely to lead to increased motion practice instead of increased efficiencies and settlements.

Attorneys admitted in the U.S but who are unfamiliar with Board practice may be unable to contribute helpfully to a discovery conference. Litigants in district court actions generally retain experienced trial counsel. Trademark applicants, on the other hand, frequently retain business lawyers to file applications. When those lawyers suddenly find themselves in contested Board proceedings, they may be wholly unaware of discovery practice or how to litigate the issues. A discovery conference 30 days after the answer was due may be a futile exercise. If the discovery conference fails to produce an agreement, more motion practice will result. The proposal that the Board’s judges and interlocutory attorneys will participate, when requested, in discovery conferences may result in an unsustainable burden on the Board’s personnel.

Motions to Suspend Proceedings

Although settlement discussions sometimes begin prior to the answer's being filed, in many cases settlement is not discussed until after issue is joined by the filing of the defendant's answer. The answer is in the nature of a disclosure insofar as it lets the plaintiff know (i) whether the defendant is going to defend the case; (ii) whether the defendant is represented by counsel; (iii) what allegations the defendant denies; (iv) whether the defendant is asserting any affirmative defenses; and (v) whether the defendant is asserting any counterclaims. Thus, instead of encouraging settlement through the exchange of information, the requirement that the parties discuss settlement prior to answer in order to suspend the action ignores the utility of the exchange of information provided by an answer to an opposition or cancellation petition and will result in fewer settlements in the early stages.

Interrogatories

If a party is forced to take depositions to obtain information that may otherwise be available through additional interrogatories, the proposed amendments will increase the costs to both parties. Limiting the number of interrogatories to twenty-five (25) also ignores the fact that many parties are foreign individuals or entities, which are increasingly becoming parties in proceedings before the Board. Interrogatories are a convenient, efficient, and cost-effective means of obtaining information from foreign parties.

Taking depositions is not always an option. Because of limited funds, many individuals and entities choose not to take depositions of the other side. Also, in contrast to Federal Court litigation, the TTAB may not compel a party outside of the U.S. to appear for a deposition. While depositions on written questions or letters rogatory are possible alternatives, they are complicated, time-consuming, and expensive procedures.

With the seventy-five (75) interrogatories limit, the parties can more easily remain within the limit without engaging in motion practice. In contrast, with the lower number, more conflicts are likely, especially when there are multiple issues, multiple marks, etc.

Twenty-five (25) interrogatories are too few. The limit of seventy-five (75) interrogatories appears to be working well, and rather than attempting to specify different numerical limits for interrogatories depending on the issues in a proceeding, it is suggested that the limit for the number of interrogatories be kept at seventy-five (75). This would be particularly important if the initial disclosures are limited to the subjects suggested in this comment.

Protective Order

With approximately 40% of all filings being made by *pro se* applicants, the requirement that the parties enter into a standard protective order could gravely prejudice parties that are adverse to direct competitors. Referring to a decision on this very issue in the case of *Geoffrey, Inc. v. Floors 'R' Us, Incorporated*, Opposition No. 90,662, (Slip opinion, TTAB, May 1, 1995), the Board stated:

As pointed out by opposer, since applicant is not represented by counsel, a protective order would be totally ineffective in preventing disclosure of confidential information to anyone other than attorneys. In a situation such as the present one, opposer cannot be required to disclose highly confidential material directly to applicant. Furthermore, most material of this nature would not appear to be sufficiently relevant to this proceeding to warrant the potential harm which might result from disclosure. Accordingly, the Board's order is amended so as to require only that the parties get together to work out suitable supplementation and/or clarification by opposer, without requiring opposer to produce any confidential information or documents.

See Attachment A.

Consequently, the automatic entry of the Board's standard protective order will not provide adequate protection to confidential information in a significant percentage of the case. The parties' option to negotiate their own protective orders will not solve the problem when there is an impasse over who would be entitled to see the information. Hence, the Board will still have to decide motions to enter protective orders, and this will delay initial disclosures and everything that follows.

Inclusion in Rule of Proposed Schedule and Disclosure Subjects

The rules of the Board, as codified in Title 37 C.F.R., have the force of law. Interpretative comments published in the preamble to proposed new rules do not have the force of law. While the Court of Appeals for the Federal Circuit and federal courts, generally, give appropriate weight to the Code of Federal Regulations, they are not obligated to, and very often do not, give weight to interpretative comments. Consequently, the discovery and trial schedule and the subjects of initial disclosure should be in the Rules. Secondly, for the convenience of the Board, attorneys, and parties (particularly *pro se* parties), the scheduling outline and disclosure should be codified in the Rules. The rules are collected and published in C.F.R. (the interpretative

comments are not) and would be readily accessible to be consulted. *Pro se* applicants, in general, have no knowledge of the existence or contents or means of accessing the Federal Register.

The rules should contain a specific provision for suspending the schedule if a party files any potentially dispositive motion, a motion to strike, or a motion to join a party. Any of these motions may affect the continued viability of the proceeding, or the issues in the proceeding, or the parties to the proceeding. These matters should be determined before there is any further activity, including the initial disclosures.

Notice Requirements for Later Changes

The Proposed Amendment announces in part “and further explained in documents posted on the Web site of the Office”. This implies that new procedures and practices may be posted to the PTO website without notice in the *Federal Register* and *Official Gazette*.

In addition to creating uncertainty and the need for busy practitioners to consult the PTO website daily, the open-ended possibility of making additional changes by announcement raises a serious question of procedural due process. Later changes in practice should be the subjects of proposed amendments and should be published in the Federal Register and Official Gazette for public comment.

Miscellaneous

Rule 2.101(b) – The reference to § 2.192(c)(1)(iii) should be corrected to: § 2.193(c)(1)(iii).

Rule 2.120(e)(2) – The rule should specify whether a suspension of proceedings precludes the serving of additional discovery requests.

Rule 2.120(g) – No explanation is offered why a motion for sanctions to be imposed against a party for its failure to participate in the required discovery conference must be filed prior to the deadline for any party to make initial disclosures. The reasoning should be explained. If the Patent and Trademark Office retains the requirement that a motion

for sanctions must be filed prior to the deadline for making initial disclosures, the filing of a motion for sanctions (a potentially dispositive motion) should automatically suspend all further proceedings and result in a resetting of all dates when the motion is decided.

Rule 2.120(h)(2) – The rule should specify whether, if a proceeding is suspended pending a ruling on a discovery motion, the parties are precluded from serving additional discovery.

Rule 2.121(a) – The trial order should state the entire schedule, starting with the due date for an answer and the deadline for a discovery conference and continuing through all of the stages described at 71 F.R. Page 2500.

Rule 2.122(d) – The rule should provide that a party may prove the existence and ownership of a registration by filing copies of data from the TARR database and from the assignment database when the TARR report shows that a registration or application has been assigned. Certification should not be required since these documents come from the Patent and Trademark Office.

Rule 2.127(e)(1) - The rule should state that a summary judgment motion based on claim preclusion, issue preclusion, or lack of jurisdiction may be filed before the party makes its initial disclosures.

Conclusion

The likely effects of the proposed amendments are far broader and more significant than anticipated by the PTO. While it is our understanding that the PTO has considered the proposed amendments for more than a year, practitioners, professional organizations, and businesses have been provided with only two months to consider and comment upon the proposed amendments. Although numerous organizations will be commenting on the proposed amendments in a timely manner, there are many who have not had the time or resources to consider and comment. While we have reviewed the proposed amendments, more time to reflect upon and examine their likely consequences will be very well spent.

Finally, we request that the period for comment be extended by 60 days and that a public hearing be held before any of the proposed rules is adopted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

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Jonathan Hudis	Kathleen Cooney-Porter
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Carol L.B. Matthews	Colette Durst-Barkey
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EXHIBIT B

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

SCHERING CORPORATION,

Opposer,

v.

IDEA AG,

Applicant.

Opposition No.: 91/180,212

App'n Serial No. 77/070,074

Mark: DIRACTIN

The Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**DECLARATION OF DR. MARTIN GRUND IN SUPPORT OF APPLICANT'S
OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY
RESPONSES AND MOTION TO TEST SUFFICIENCY OF RESPONSES**

I, Dr. Martin Grund, declare:

1. I am a German Patent and Trademark Attorney ("Patentanwalt") and founder of the German law firm of Grund Intellectual Property Group located at Nikolaistrasse 15, D80802 in Munich, Germany. I have been a licensed German Patentanwalt and registered with the German Patent Attorney Chamber ("Patentanwaltsskammer") since 1997.

2. I have personal knowledge of the facts contained in this Declaration.

Opposition No. 91180212
Application Serial. No. 77/070,074
Atty. Docket No. 108-007TUS

3. As a licensed and actively practicing Patentanwalt, I understand that the rules of professional ethics, discipline, and privilege are applicable to the entirety of my professional conduct, in all aspects of my recognized professional practice, and are administered by the Patentanwaltskammer.

4. I understand that I am bound to strict secrecy regarding client information, which includes everything, meaning all information, coming into my knowledge while I am performing in my professional capacity. This secrecy obligation constitutes one of the fundamental duties of a Patentanwalt and is embodied in the Patentanwaltsordnung (Patent Attorney Act, or PatAnwO) at §39, with the obligation of secrecy continuing to be enforceable subsequent to the termination of the attorney-client relationship pursuant to the German Patent Attorney's Code of Conduct at §2.

5. The rules of professional ethics, in particular PatAnwO §39, provides for complete secrecy of communications exchanged between a Patentanwalt and a client. German courts are not competent to compel a Patentanwalt to disclose or produce those communications, whether written or oral or in any other form. Accordingly, under German law, a privilege log of the kind that is sometimes required in litigation under U.S. law can never be required of a German lawyer representing a German client before a German Court.

6. The secrecy obligation defined above in paragraph No. 4 would extend, under German law, to a trademark search conducted directly by, or at the supervision of a Patentanwalt, in particular where such trademark search would be requested by a client. Both the content of a trademark search, and its existence in the first instance, are subject to the above-mentioned obligation of secrecy, and are further protected by privilege (see paragraph No. 7, below), and therefore cannot be disclosed to anyone.

7. I further understand that I have a right to exercise a testimonial privilege by refusing to give evidence in the form of testimony for "personal reasons" during civil

proceedings under §383 of the German Code of Civil Procedure (ZPO or Zivilprozessordnung), since I am regularly entrusted with facts and other information whose secrecy is mandatory (see paragraph No. 4, above). This testimonial privilege likewise extends to criminal proceedings under §53 of the German Code of Criminal Procedure (StPO or Strafprozessordnung), in particular, to information arising from matters which were confided to me or which I have come to know in my professional capacity as a Patentanwalt.

8. If I am adjudged to breach the secrecy obligation by disclosing private facts and other information confided to me during my capacity as a Patentanwalt, in particular, such secret information concerning the business or operations of my clients, §203 of the German Criminal Code (StGB or Strafgesetzbuch) provides that I shall be punished with imprisonment not exceeding one year or with a fine.

9. Attached hereto as Exhibit A, in German with an accompanying English translation, is a true and correct copy of the current German statutes setting forth the laws I have summarized herein.

Executed on this 14th day of October, 2008, in Munich, Germany. I declare under penalty of perjury that all statements made herein of my own knowledge, and that all statements made on information and belief, are true and correct.

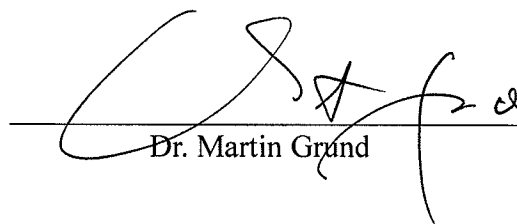

Dr. Martin Grund

EXHIBIT B.1

Attorney Client Privilege

A consequence resulting from a patent attorney's obligation to secrecy is a right to secrecy which is protected by law as the right to refuse to give evidence and the prohibition of seizure.

The Patent Attorneys' Act

§ 39a Fundamental Duties of a patent attorney

(2) A patent attorney shall be bound to secrecy. This obligation includes everything that has come to his knowledge in performing his profession. It shall not be applicable to facts which are obvious or need not be kept secret, considering their meaning.

Patent Attorneys' Code of Conduct

§ 2 Secrecy

(1) The obligation of secrecy continues to be effective after an order has been completed.

Criminal Code

§ 203 Breach of private secrets

(1) A person who reveals someone else's secret without being authorized to do so, specifically a secret concerning the personal area of life or a business or operations secret of such other person, which was confided to him or which he came to know otherwise in his capacity as

3. a lawyer, patent attorney, notary, counsel for defense in legally ordered proceedings, auditor, certified accountant, tax consultant, tax representative, or an organ or member of an organ of a company or partnership of lawyers, patent attorneys, auditors, accountants, or tax consultants shall be punished with imprisonment not exceeding one year or with a fine.

Code of Civil Procedure

§ 383 Refusal to give evidence for personal reasons

- (1) The following persons may refuse to give evidence
6. Persons entrusted, by virtue of their appointment, status, or trade, with facts whose secrecy is mandatory because of the nature thereof or by provisions of the law in respect of the facts to which the obligation of secrecy relates.
 - (3) Even if testimony is not refused, the interrogation of persons designated sub nos. 4 to 6 shall not be directed to facts in consideration of which it is manifest that a deposition cannot be made without violating the obligation of secrecy.

Code of Criminal Procedure

§ 53 Right to refuse to give evidence for professional reasons

- (1) The following persons may also refuse to give evidence
3. Lawyers, patent attorneys, notaries, auditors, certified accountants, tax consultants, and tax representatives, physicians, dentists, psychological psychotherapists, psychotherapists for children and adolescents, pharmacists, and midwives concerning matters which were confided to them or which they came to know in that capacity; other members of a bar association shall be equal to lawyers in this respect.

§ 53a Professional assistants' right to refuse to give evidence

- (1) Assistants and persons taking part in professional activity in preparation for the profession shall be equal to the persons designated in § 53(1), first sentence, nos. 1 to 4. The exercise of the helping persons' right to refuse to give evidence shall be decided by the persons designated in § 53(1), first sentence, nos. 1 to 4, unless such decision cannot be taken within a foreseeable time.
- (2) Release from the obligation of secrecy (§ 53(2), first sentence) shall apply to the helping persons as well.

§ 97 Objects not subject to seizure

- (1) The following objects shall not be subject to seizure
1. Written communications between the accused and a person entitled to refuse to give evidence according to § 52 or § 53(1), nos. 1 to 3b;
 2. recordings made by a person designated in § 53(1), first sentence, nos. 1 to 3b about the information confided to him by the accused or about other circumstances embraced by the right to refuse to give evidence;

3. other objects, including the medical examination reports which are embraced by the right to refuse to give evidence of the persons designated in § 53(1), first sentence, nos. 1 to 3b;

(2) These limitations shall be applicable only if the objects are in the custody of a person entitled to the right to refuse to give evidence. The limitations of seizure shall not be applicable if the persons entitled to refuse to give evidence are suspected of cooperating or abetting, obstructing punishment, or receiving stolen goods, or if the objects concerned have been brought about by a criminal act, or used or destined for committing a criminal act, or result from a criminal act.

Tax Code

§ 102 Withholding information for the protection of certain professional secrets

(1) The following persons also are allowed to withhold information
 3b. Lawyers, patent attorneys, notaries, auditors, tax representatives, certified accountants regarding matters which were confided to them or which they came to know in their capacity.

Tax Court Code

§ 84 Right to refuse to give evidence

(1) §§ 101 to 103 of the Tax Code shall apply *mutatis mutandis* to the right to refuse to give evidence and the obligation to instruct a person about the right to refuse to give evidence.

Dritter Teil
Die Rechte und Pflichten des Patentanwalts und die
berufliche Zusammenarbeit der Patentanwälte

Erster Abschnitt
Allgemeines

§ 39
Allgemeine Berufspflicht

Der Patentanwalt hat seinen Beruf gewissenhaft auszuüben. Er hat sich innerhalb und außerhalb des Berufs der Achtung und des Vertrauens, welche die Stellung des Patentanwalts erfordert, würdig zu erweisen.

§ 39 a
Grundpflichten des Patentanwalts

(1) Der Patentanwalt darf keine Bindungen eingehen, die seine berufliche Unabhängigkeit gefährden.

(2) Der Patentanwalt ist zur Verschwiegenheit verpflichtet. Diese Pflicht bezieht sich auf alles, was ihm in Ausübung seines Berufes bekanntgeworden ist. Dies gilt nicht für Tatsachen, die offenkundig sind oder ihrer Bedeutung nach keiner Geheimhaltung bedürfen.

(3) Der Patentanwalt darf sich bei seiner Berufsausübung nicht unsachlich verhalten. Unsachlich ist insbesondere ein Verhalten, bei dem es sich um die bewußte Verbreitung von Unwahrheiten oder solche herabsetzenden Äußerungen handelt, zu denen andere Beteiligte oder der Verfahrensablauf keinen Anlaß gegeben haben.

(4) Der Patentanwalt darf keine widerstreitenden Interessen vertreten.

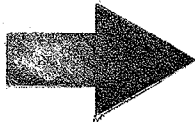
(5) Der Patentanwalt ist bei der Behandlung der ihm anvertrauten Vermögenswerte zu der erforderlichen Sorgfalt verpflichtet. Fremde Gelder sind unverzüglich an den Empfangsberechtigten weiterzuleiten oder auf ein Anderkonto einzuzahlen.

(6) Der Patentanwalt ist verpflichtet, sich fortzubilden.

§ 39 b
Werbung

Werbung ist dem Patentanwalt nur erlaubt, soweit sie über die berufliche Tätigkeit in Form und Inhalt sachlich unterrichtet und nicht auf die Erteilung eines Auftrags im Einzelfall gerichtet ist.

(2) Der Patentanwalt darf Weisungen des Auftraggebers, die mit seinen anwaltlichen Pflichten nicht vereinbar sind, nicht folgen.

**§ 2****Verschwiegenheit**

(1) Die Pflicht zur Verschwiegenheit besteht nach Beendigung des Auftrags fort.

(2) Die Pflicht zur Verschwiegenheit entfällt, wenn das berechtigte Interesse des Patentanwalts bei der Durchsetzung oder Abwehr von Ansprüchen aus dem Auftrag oder bei der Verteidigung des Patentanwalts in eigener Sache das Interesse des Auftraggebers deutlich überwiegt.

§ 3**Sachlichkeit**

Nicht unsachlich ist ein Verhalten des Patentanwalts, das in der konkreten Situation bei gewissenhafter Berufsausübung objektiv geeignet ist, die Interessen des Auftraggebers zu wahren und zu fördern.

§ 4**Verbot der Vertretung widerstreitender Interessen**

(1) Der Patentanwalt darf nicht tätig werden, wenn er, gleich in welcher Funktion, einen anderen Auftraggeber in derselben Rechtssache im widerstreitenden Interesse bereits beraten oder vertreten hat oder mit dieser Rechtssache in sonstiger Weise beruflich befaßt war.

(2) Das Verbot der Vertretung widerstreitender Interessen gilt auch im Verhältnis zu Aufträgen, die mit dem Patentanwalt zur gemeinschaftlichen Berufsausübung verbundenen Personen erteilt worden sind.

(3) Ein Einverständnis der Betroffenen beseitigt ein widerstreitendes Interesse nicht, es sei denn, das Einverständnis hebt die Gegensätzlichkeit der beiderseitigen Interessen im Umfang des in derselben Rechtssache erteilten Auftrags völlig auf.

(4) Der Patentanwalt muß das Auftragsverhältnis gegenüber jedem betroffenen Auftraggeber beenden, wenn es zu einem Interessenkonflikt gekommen ist.

§ 5**Umgang mit überlassenen Unterlagen und fremden Vermögenswerten**

(1) Überlassene Unterlagen wie Urkunden, Akten, Muster und Modelle darf der Patentanwalt ohne Einwilligung des Verfügungsberechtigten Dritten nicht aushändigen.

§ 201 a.¹⁾ Verletzung des höchstpersönlichen Lebensbereichs durch Bildaufnahmen. (1) Wer von einer anderen Person, die sich in einer Wohnung oder einem gegen Einblick besonders geschützten Raum befindet, unbefugt Bildaufnahmen herstellt oder überträgt und dadurch deren höchstpersönlichen Lebensbereich verletzt, wird mit Freiheitsstrafe bis zu einem Jahr oder mit Geldstrafe bestraft.

(2) Ebenso wird bestraft, wer eine durch eine Tat nach Absatz 1 hergestellte Bildaufnahme gebraucht oder einem Dritten zugänglich macht.

(3) Wer eine befugt hergestellte Bildaufnahme von einer anderen Person, die sich in einer Wohnung oder einem gegen Einblick besonders geschützten Raum befindet, wissentlich unbefugt einem Dritten zugänglich macht und dadurch deren höchstpersönlichen Lebensbereich verletzt, wird mit Freiheitsstrafe bis zu einem Jahr oder mit Geldstrafe bestraft.

(4) ¹Die Bildträger sowie Bildaufnahmegeräte oder andere technische Mittel, die der Täter oder Teilnehmer verwendet hat, können eingezogen werden. ²§ 74 a ist anzuwenden.

§ 202. Verletzung des Briefgeheimnisses. (1) Wer unbefugt

1. einen verschlossenen Brief oder ein anderes verschlossenes Schriftstück, die nicht zu seiner Kenntnis bestimmt sind, öffnet oder
2. sich vom Inhalt eines solchen Schriftstücks ohne Öffnung des Verschlusses unter Anwendung technischer Mittel Kenntnis verschafft,

wird mit Freiheitsstrafe bis zu einem Jahr oder mit Geldstrafe bestraft, wenn die Tat nicht in § 206 mit Strafe bedroht ist.

(2) Ebenso wird bestraft, wer sich unbefugt vom Inhalt eines Schriftstücks, das nicht zu seiner Kenntnis bestimmt und durch ein verschlossenes Behältnis gegen Kenntnisnahme besonders gesichert ist, Kenntnis verschafft, nachdem er dazu das Behältnis geöffnet hat.

(3) Einem Schriftstück im Sinne der Absätze 1 und 2 steht eine Abbildung gleich.

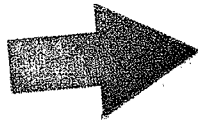
§ 202 a. Ausspähen von Daten. (1) Wer unbefugt Daten, die nicht für ihn bestimmt und die gegen unberechtigten Zugang besonders gesichert sind, sich oder einem anderen verschafft, wird mit Freiheitsstrafe bis zu drei Jahren oder mit Geldstrafe bestraft.

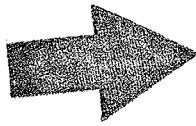
(2) Daten im Sinne des Absatzes 1 sind nur solche, die elektronisch, magnetisch oder sonst nicht unmittelbar wahrnehmbar gespeichert sind oder übermittelt werden.

§ 203.²⁾ Verletzung von Privatgeheimnissen. (1) Wer unbefugt ein fremdes Geheimnis, namentlich ein zum persönlichen Lebensbereich gehörendes Geheimnis oder ein Betriebs- oder Geschäftsgeheimnis, offenbart, das ihm als

¹⁾ § 201 a eingef. durch 36. StrÄndG v. 30. 7. 2004 (BGBl. I S. 1212).

²⁾ § 203 Abs. 2 Satz 1 Nrn. 4 und 5 geänd., Nr. 6 angef. durch Art. 3 G v. 2. 8. 2000 (BGBl. I S. 1253), Abs. 2 a eingef. durch Art. 2 G v. 22. 8. 2006 (BGBl. I S. 1970).





1. Arzt, Zahnarzt, Tierarzt, Apotheker oder Angehörigen eines anderen Heilberufs, der für die Berufsausübung oder die Führung der Berufsbezeichnung eine staatlich geregelte Ausbildung erfordert,
 2. Berufspsychologen mit staatlich anerkannter wissenschaftlicher Abschlußprüfung,
 3. Rechtsanwalt, Patentanwalt, Notar, Verteidiger in einem gesetzlich geordneten Verfahren, Wirtschaftsprüfer, vereidigtem Buchprüfer, Steuerberater, Steuerbevollmächtigten oder Organ oder Mitglied eines Organs einer Rechtsanwalts-, Patentanwalts-, Wirtschaftsprüfungs-, Buchprüfungs- oder Steuerberatungsgesellschaft,
 4. Ehe-, Familien-, Erziehungs- oder Jugendberater sowie Berater für Suchtfragen in einer Beratungsstelle, die von einer Behörde oder Körperschaft, Anstalt oder Stiftung des öffentlichen Rechts anerkannt ist,
 - 4a. Mitglied oder Beauftragten einer anerkannten Beratungsstelle nach den §§ 3 und 8 des Schwangerschaftskonfliktgesetzes,¹⁾
 5. staatlich anerkanntem Sozialarbeiter oder staatlich anerkanntem Sozialpädagogen oder
 6. Angehörigen eines Unternehmens der privaten Kranken-, Unfall- oder Lebensversicherung oder einer privatärztlichen Verrechnungsstelle
- anvertraut worden oder sonst bekanntgeworden ist, wird mit Freiheitsstrafe bis zu einem Jahr oder mit Geldstrafe bestraft.

(2) ¹Ebenso wird bestraft, wer unbefugt ein fremdes Geheimnis, namentlich ein zum persönlichen Lebensbereich gehörendes Geheimnis oder ein Betriebs- oder Geschäftsgeheimnis, offenbart, das ihm als

1. Amtsträger,
2. für den öffentlichen Dienst besonders Verpflichteten,
3. Person, die Aufgaben oder Befugnisse nach dem Personalvertretungsrecht wahrnimmt,
4. Mitglied eines für ein Gesetzgebungsorgan des Bundes oder eines Landes tätigen Untersuchungsausschusses, sonstigen Ausschusses oder Rates, das nicht selbst Mitglied des Gesetzgebungsorgans ist, oder als Hilfskraft eines solchen Ausschusses oder Rates,
5. öffentlich bestellten Sachverständigen, der auf die gewissenhafte Erfüllung seiner Obliegenheiten auf Grund eines Gesetzes förmlich verpflichtet worden ist, oder
6. Person, die auf die gewissenhafte Erfüllung ihrer Geheimhaltungspflicht bei der Durchführung wissenschaftlicher Forschungsvorhaben auf Grund eines Gesetzes förmlich verpflichtet worden ist,

anvertraut worden oder sonst bekanntgeworden ist. ²Einem Geheimnis im Sinne des Satzes 1 stehen Einzelangaben über persönliche oder sachliche Verhältnisse eines anderen gleich, die für Aufgaben der öffentlichen Verwaltung erfaßt worden sind; Satz 1 ist jedoch nicht anzuwenden, soweit solche Einzelangaben anderen Behörden oder sonstigen Stellen für Aufgaben der öffentlichen Verwaltung bekanntgegeben werden und das Gesetz dies nicht untersagt.

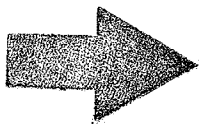
¹⁾ G zur Vermeidung und Bewältigung von Schwangerschaftskonflikten (SchwangerschaftskonfliktG – SchKG) v. 27. 7. 1992 (BGBl. I S. 1398), geänd. durch G v. 21. 8. 1995 (BGBl. I S. 1050).

(2) Die Anzeigen und Gesuche des Zeugen können schriftlich oder zum Protokoll der Geschäftsstelle oder mündlich in dem zur Vernehmung bestimmten neuen Termin angebracht werden.

§ 382. Vernehmung an bestimmten Orten. (1) Die Mitglieder der Bundesregierung oder einer Landesregierung sind an ihrem Amtssitz oder, wenn sie sich außerhalb ihres Amtssitzes aufhalten, an ihrem Aufenthaltsort zu vernehmen.

(2) Die Mitglieder des Bundestages, des Bundesrates, eines Landtages oder einer zweiten Kammer sind während ihres Aufenthaltes am Sitz der Versammlung dort zu vernehmen.

(3) Zu einer Abweichung von den vorstehenden Vorschriften bedarf es:
für die Mitglieder der Bundesregierung der Genehmigung der Bundesregierung,
für die Mitglieder einer Landesregierung der Genehmigung der Landesregierung,
für die Mitglieder einer der im Absatz 2 genannten Versammlungen der Genehmigung dieser Versammlung.



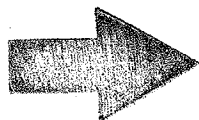
§ 383. Zeugnisverweigerung aus persönlichen Gründen. (1) Zur Verweigerung des Zeugnisses sind berechtigt:

1. der Verlobte einer Partei oder derjenige, mit dem die Partei ein Versprechen eingegangen ist, eine Lebenspartnerschaft zu begründen;
2. der Ehegatte einer Partei, auch wenn die Ehe nicht mehr besteht;
- 2a. der Lebenspartner einer Partei, auch wenn die Lebenspartnerschaft nicht mehr besteht;
3. diejenigen, die mit einer Partei in gerader Linie verwandt oder verschwägert, in der Seitenlinie bis zum dritten Grad verwandt oder bis zum zweiten Grad verschwägert sind oder waren;
4. Geistliche in Ansehung desjenigen, was ihnen bei der Ausübung der Seelsorge anvertraut ist;
5. Personen, die bei der Vorbereitung, Herstellung oder Verbreitung von periodischen Druckwerken oder Rundfunksendungen berufsmäßig mitwirken oder mitgewirkt haben, über die Person des Verfassers, Einsenders oder Gewährsmanns von Beiträgen und Unterlagen sowie über die ihnen im Hinblick auf ihre Tätigkeit gemachten Mitteilungen, soweit es sich um Beiträge, Unterlagen und Mitteilungen für den redaktionellen Teil handelt;
6. Personen, denen kraft ihres Amtes, Standes oder Gewerbes Tatsachen anvertraut sind, deren Geheimhaltung durch ihre Natur oder durch gesetzliche Vorschrift geboten ist, in Betreff der Tatsachen, auf welche die Verpflichtung zur Verschwiegenheit sich bezieht¹⁾.

(2) Die unter Nummern 1 bis 3 bezeichneten Personen sind vor der Vernehmung über ihr Recht zur Verweigerung des Zeugnisses zu belehren.

(3) Die Vernehmung der unter Nummern 4 bis 6 bezeichneten Personen ist, auch wenn das Zeugnis nicht verweigert wird, auf Tatsachen nicht zu

¹⁾ Ferner die Mitglieder des Deutschen Bundestages sowie der Landtage nach Art. 47 Grundgesetz und den entsprechenden Bestimmungen der Landesverfassungen.



richten, in Ansehung welcher erhellt, dass ohne Verletzung der Verpflichtung zur Verschwiegenheit ein Zeugnis nicht abgelegt werden kann.

§ 384. Zeugnisverweigerung aus sachlichen Gründen. Das Zeugnis kann verweigert werden:

1. über Fragen, deren Beantwortung dem Zeugen oder einer Person, zu der er in einem der im § 383 Nr. 1 bis 3 bezeichneten Verhältnisse steht, einen unmittelbaren vermögensrechtlichen Schaden verursachen würde;
2. über Fragen, deren Beantwortung dem Zeugen oder einem seiner im § 383 Nr. 1 bis 3 bezeichneten Angehörigen zur Unehre gereichen oder die Gefahr zuziehen würde, wegen einer Straftat oder einer Ordnungswidrigkeit verfolgt zu werden;
3. über Fragen, die der Zeuge nicht würde beantworten können, ohne ein Kunst- oder Gewerbegeheimnis zu offenbaren.

§ 385. Ausnahmen vom Zeugnisverweigerungsrecht. (1) In den Fällen des § 383 Nr. 1 bis 3 und des § 384 Nr. 1 darf der Zeuge das Zeugnis nicht verweigern:

1. über die Errichtung und den Inhalt eines Rechtsgeschäfts, bei dessen Errichtung er als Zeuge zugezogen war;
2. über Geburten, Verheiratungen oder Sterbefälle von Familienmitgliedern;
3. über Tatsachen, welche die durch das Familienverhältnis bedingten Vermögensangelegenheiten betreffen;
4. über die auf das streitige Rechtsverhältnis sich beziehenden Handlungen, die von ihm selbst als Rechtsvorgänger oder Vertreter einer Partei vorgenommen sein sollen.

(2) Die im § 383 Nr. 4, 6 bezeichneten Personen dürfen das Zeugnis nicht verweigern, wenn sie von der Verpflichtung zur Verschwiegenheit entbunden sind.

§ 386. Erklärung der Zeugnisverweigerung. (1) Der Zeuge, der das Zeugnis verweigert, hat vor dem zu seiner Vernehmung bestimmten Termin schriftlich oder zum Protokoll der Geschäftsstelle oder in diesem Termin die Tatsachen, auf die er die Weigerung gründet, anzugeben und glaubhaft zu machen.

(2) Zur Glaubhaftmachung genügt in den Fällen des § 383 Nr. 4, 6 die mit Berufung auf einen geleisteten Diensteid abgegebene Versicherung.

(3) Hat der Zeuge seine Weigerung schriftlich oder zum Protokoll der Geschäftsstelle erklärt, so ist er nicht verpflichtet, in dem zu seiner Vernehmung bestimmten Termin zu erscheinen.

(4) Von dem Eingang einer Erklärung des Zeugen oder von der Aufnahme einer solchen zum Protokoll hat die Geschäftsstelle die Parteien zu benachrichtigen.

§ 387. Zwischenstreit über Zeugnisverweigerung. (1) Über die Rechtmäßigkeit der Weigerung wird von dem Prozessgericht nach Anhörung der Parteien entschieden.

(2) ¹Haben Minderjährige wegen mangelnder Verstandesreife oder haben Minderjährige oder Betreute wegen einer psychischen Krankheit oder einer geistigen oder seelischen Behinderung von der Bedeutung des Zeugnisverweigerungsrechts keine genügende Vorstellung, so dürfen sie nur vernommen werden, wenn sie zur Aussage bereit sind und auch ihr gesetzlicher Vertreter der Vernehmung zustimmt. ²Ist der gesetzliche Vertreter selbst Beschuldigter, so kann er über die Ausübung des Zeugnisverweigerungsrechts nicht entscheiden; das gleiche gilt für den nicht beschuldigten Elternteil, wenn die gesetzliche Vertretung beiden Eltern zusteht.

(3) ¹Die zur Verweigerung des Zeugnisses berechtigten Personen, in den Fällen des Absatzes 2 auch deren zur Entscheidung über die Ausübung des Zeugnisverweigerungsrechts befugte Vertreter, sind vor jeder Vernehmung über ihr Recht zu belehren. ²Sie können den Verzicht auf dieses Recht auch während der Vernehmung widerrufen.

§ 53.¹⁾ [Zeugnisverweigerungsrecht aus beruflichen Gründen]

(1) ¹Zur Verweigerung des Zeugnisses sind ferner berechtigt

1. Geistliche über das, was ihnen in ihrer Eigenschaft als Seelsorger anvertraut worden oder bekanntgeworden ist;
2. Verteidiger des Beschuldigten über das, was ihnen in dieser Eigenschaft anvertraut worden oder bekanntgeworden ist;
3. Rechtsanwälte, Patentanwälte, Notare, Wirtschaftsprüfer, vereidigte Buchprüfer, Steuerberater und Steuerbevollmächtigte, Ärzte, Zahnärzte, Psychologische Psychotherapeuten, Kinder- und Jugendlichenpsychotherapeuten, Apotheker und Hebammen über das, was ihnen in dieser Eigenschaft anvertraut worden oder bekanntgeworden ist; Rechtsanwälte stehen dabei sonstige Mitglieder einer Rechtsanwaltskammer gleich;
- 3a. Mitglieder oder Beauftragte einer anerkannten Beratungsstelle nach den §§ 3 und 8 des Schwangerschaftskonfliktgesetzes²⁾ über das, was ihnen in dieser Eigenschaft anvertraut worden oder bekanntgeworden ist;
- 3b. Berater für Fragen der Betäubungsmittelabhängigkeit in einer Beratungsstelle, die eine Behörde oder eine Körperschaft, Anstalt oder Stiftung des öffentlichen Rechts anerkannt oder bei sich eingerichtet hat, über das, was ihnen in dieser Eigenschaft anvertraut worden oder bekanntgeworden ist;
4. Mitglieder des Bundestages, eines Landtages oder einer zweiten Kammer über Personen, die ihnen in ihrer Eigenschaft als Mitglieder dieser Organe oder denen sie in dieser Eigenschaft Tatsachen anvertraut haben sowie über diese Tatsachen selbst;

¹⁾ § 53 Abs. 1 Nr. 3a geänd. durch Art. 14 G v. 27. 7. 1992 (BGBl. I S. 1398), Abs. 1 Nr. 3b eingef., Abs. 2 geänd. durch G v. 23. 7. 1992 (BGBl. I S. 1366), Abs. 1 Nr. 3a geänd. durch Art. 9 Abs. 2 G v. 21. 8. 1995 (BGBl. I S. 1050), Abs. 1 Nr. 3 geänd. durch Art. 5 G v. 16. 6. 1998 (BGBl. I S. 1311) und Art. 10 G v. 31. 8. 1998 (BGBl. I S. 2585), Abs. 1 Nr. 5 neugef., Sätze 2 und 3 angef., Abs. 2 Satz 1 geänd., Sätze 2 und 3 angef. durch Art. 1 G v. 15. 2. 2002 (BGBl. I S. 682).

²⁾ G zur Vermeidung und Bewältigung von Schwangerschaftskonflikten (SchwangerschaftskonfliktG – SchKG) v. 27. 7. 1992 (BGBl. I S. 1398), geänd. durch G v. 21. 8. 1995 (BGBl. I S. 1050).

5. Personen, die bei der Vorbereitung, Herstellung oder Verbreitung von Druckwerken, Rundfunksendungen, Filmberichten oder der Unterrichtung oder Meinungsbildung dienenden Informations- und Kommunikationsdiensten berufsmäßig mitwirken oder mitgewirkt haben.

²Die in Satz 1 Nr. 5 genannten Personen dürfen das Zeugnis verweigern über die Person des Verfassers oder Einsenders von Beiträgen und Unterlagen oder des sonstigen Informanten sowie über die ihnen im Hinblick auf ihre Tätigkeit gemachten Mitteilungen, über deren Inhalt sowie über den Inhalt selbst erarbeiteter Materialien und den Gegenstand berufsbezogener Wahrnehmungen. ³Dies gilt nur, soweit es sich um Beiträge, Unterlagen, Mitteilungen und Materialien für den redaktionellen Teil oder redaktionell aufbereitete Informations- und Kommunikationsdienste handelt.

(2) ¹Die in Absatz 1 Satz 1 Nr. 2 bis 3b Genannten dürfen das Zeugnis nicht verweigern, wenn sie von der Verpflichtung zur Verschwiegenheit entbunden sind. ²Die Berechtigung zur Zeugnisverweigerung der in Absatz 1 Satz 1 Nr. 5 Genannten über den Inhalt selbst erarbeiteter Materialien und den Gegenstand entsprechender Wahrnehmungen entfällt, wenn die Aussage zur Aufklärung eines Verbrechens beitragen soll oder wenn Gegenstand der Untersuchung

1. eine Straftat des Friedensverrats und der Gefährdung des demokratischen Rechtsstaats oder des Landesverrats und der Gefährdung der äußeren Sicherheit (§§ 80 a, 85, 87, 88, 95, auch in Verbindung mit § 97 b, §§ 97 a, 98 bis 100 a des Strafgesetzbuches),

2. eine Straftat gegen die sexuelle Selbstbestimmung nach den §§ 174 bis 176, 179 des Strafgesetzbuches oder

3. eine Geldwäsche, eine Verschleierung unrechtmäßig erlangter Vermögenswerte nach § 261 Abs. 1 bis 4 des Strafgesetzbuches

ist und die Erforschung des Sachverhalts oder die Ermittlung des Aufenthaltsortes des Beschuldigten auf andere Weise aussichtslos oder wesentlich erschwert wäre. ³Der Zeuge kann jedoch auch in diesen Fällen die Aussage verweigern, soweit sie zur Offenbarung der Person des Verfassers oder Einsenders von Beiträgen und Unterlagen oder des sonstigen Informanten oder der ihm im Hinblick auf seine Tätigkeit nach Absatz 1 Satz 1 Nr. 5 gemachten Mitteilungen oder deren Inhalts führen würde.

§ 53 a.¹⁾ [Zeugnisverweigerungsrecht der Berufshelfer] (1) ¹Den in § 53 Abs. 1 Satz 1 Nr. 1 bis 4 Genannten stehen ihre Gehilfen und die Personen gleich, die zur Vorbereitung auf den Beruf an der berufsmäßigen Tätigkeit teilnehmen. ²Über die Ausübung des Rechtes dieser Hilfspersonen, das Zeugnis zu verweigern, entscheiden die in § 53 Abs. 1 Satz 1 Nr. 1 bis 4 Genannten, es sei denn, daß diese Entscheidung in absehbarer Zeit nicht herbeigeführt werden kann.

(2) Die Entbindung von der Verpflichtung zur Verschwiegenheit (§ 53 Abs. 2 Satz 1) gilt auch für die Hilfspersonen.

§ 54.²⁾ [Aussagegenehmigung für Richter und Beamte] (1) Für die Vernehmung von Richtern, Beamten und anderen Personen des öffentlichen

¹⁾ § 53 a Abs. 1 Satz 2 und Abs. 2 geändert durch Art. 1 G v. 15. 2. 2002 (BGBl. I S. 682).

²⁾ § 54 Abs. 2 und 4 neu gef. durch Art. 4 G v. 4. 11. 1994 (BGBl. I S. 3346).

Achter Abschnitt.¹⁾ Beschlagnahme, Überwachung des Fernmeldeverkehrs, Rasterfahndung, Einsatz technischer Mittel, Einsatz Verdeckter Ermittler und Durchsuchung

§ 94. [Gegenstand der Beschlagnahme] (1) Gegenstände, die als Beweismittel für die Untersuchung von Bedeutung sein können, sind in Verwahrung zu nehmen oder in anderer Weise sicherzustellen.

(2) Befinden sich die Gegenstände in dem Gewahrsam einer Person und werden sie nicht freiwillig herausgegeben, so bedarf es der Beschlagnahme.

(3) Die Absätze 1 und 2 gelten auch für Führerscheine, die der Einziehung unterliegen.

§ 95. [Herausgabepflicht] (1) Wer einen Gegenstand der vorbezeichneten Art in seinem Gewahrsam hat, ist verpflichtet, ihn auf Erfordern vorzulegen und auszuliefern.

(2) ¹Im Falle der Weigerung können gegen ihn die in § 70 bestimmten Ordnungs- und Zwangsmittel festgesetzt werden. ²Das gilt nicht bei Personen, die zur Verweigerung des Zeugnisses berechtigt sind.

§ 96.²⁾ [Amtliche Schriftstücke] ¹Die Vorlegung oder Auslieferung von Akten oder anderen in amtlicher Verwahrung befindlichen Schriftstücken durch Behörden und öffentliche Beamte darf nicht gefordert werden, wenn deren oberste Dienstbehörde erklärt, daß das Bekanntwerden des Inhalts dieser Akten oder Schriftstücke dem Wohl des Bundes oder eines deutschen Landes Nachteile bereiten würde. ²Satz 1 gilt entsprechend für Akten und sonstige Schriftstücke, die sich im Gewahrsam eines Mitglieds des Bundestages oder eines Landtages beziehungsweise eines Angestellten einer Fraktion des Bundestages oder eines Landtages befinden, wenn die für die Erteilung einer Aussagegenehmigung zuständige Stelle eine solche Erklärung abgegeben hat.

§ 97.³⁾ [Der Beschlagnahme nicht unterliegende Gegenstände]

(1) Der Beschlagnahme unterliegen nicht

1. schriftliche Mitteilungen zwischen dem Beschuldigten und den Personen, die nach § 52 oder § 53 Abs. 1 Satz 1 Nr. 1 bis 3b das Zeugnis verweigern dürfen;
2. Aufzeichnungen, welche die in § 53 Abs. 1 Satz 1 Nr. 1 bis 3b Genannten über die ihnen vom Beschuldigten anvertrauten Mitteilungen oder über andere Umstände gemacht haben, auf die sich das Zeugnisverweigerungsrecht erstreckt;
3. andere Gegenstände einschließlich der ärztlichen Untersuchungsbefunde, auf die sich das Zeugnisverweigerungsrecht der in § 53 Abs. 1 Satz 1 Nr. 1 bis 3b Genannten erstreckt.

¹⁾ Überschr. des Achten Abschn. geänd. durch Art. 3 G v. 15. 7. 1992 (BGBl. I S. 1302).

²⁾ § 96 Satz 2 angef. durch Art. 4 G v. 4. 11. 1994 (BGBl. I S. 3346).

³⁾ § 97 Abs. 1 Nrn. 1 bis 3 geänd., Abs. 2 Satz 2 neu gef. durch G v. 23. 7. 1992 (BGBl. I S. 1366), Abs. 2 Satz 2 geänd. durch Art. 5 G v. 16. 6. 1998 (BGBl. I S. 1311), Abs. 1 Nrn. 1 bis 3, Abs. 2 Satz 2, Abs. 3 und Abs. 5 Satz 1 geänd., Abs. 5 Satz 2 neu gef. durch Art. 1 G v. 15. 2. 2002 (BGBl. I S. 682), Abs. 2 Sätze 1 und 2 geänd. mWv 1. 1. 2004 durch Art. 30 GMG v. 14. 11. 2003 (BGBl. I S. 2190).

(2) ¹Diese Beschränkungen gelten nur, wenn die Gegenstände im Gewahrsam der zur Verweigerung des Zeugnisses Berechtigten sind, es sei denn, es handelt sich um eine Gesundheitskarte im Sinne des § 291a des Fünften Buches Sozialgesetzbuch. ²Der Beschlagnahme unterliegen auch nicht Gegenstände, auf die sich das Zeugnisverweigerungsrecht der Ärzte, Zahnärzte, Psychologischen Psychotherapeuten, Kinder- und Jugendlichenpsychotherapeuten, Apotheker und Hebammen erstreckt, wenn sie im Gewahrsam einer Krankenanstalt oder eines Dienstleisters, der für die Genannten personenbezogene Daten erhebt, verarbeitet oder nutzt, sind, sowie Gegenstände, auf die sich das Zeugnisverweigerungsrecht der in § 53 Abs. 1 Satz 1 Nr. 3a und 3b genannten Personen erstreckt, wenn sie im Gewahrsam der in dieser Vorschrift bezeichneten Beratungsstelle sind. ³Die Beschränkungen der Beschlagnahme gelten nicht, wenn die zur Verweigerung des Zeugnisses Berechtigten einer Teilnahme oder einer Begünstigung, Strafvereitelung oder Hehlerei verdächtig sind oder wenn es sich um Gegenstände handelt, die durch eine Straftat hervorgebracht oder zur Begehung einer Straftat gebraucht oder bestimmt sind oder die aus einer Straftat herrühren.

(3) Soweit das Zeugnisverweigerungsrecht der Mitglieder des Bundestages, eines Landtages oder einer zweiten Kammer reicht (§ 53 Abs. 1 Satz 1 Nr. 4), ist die Beschlagnahme von Schriftstücken unzulässig.

(4) Die Absätze 1 bis 3 sind entsprechend anzuwenden, soweit die in § 53a Genannten das Zeugnis verweigern dürfen.

(5) ¹Soweit das Zeugnisverweigerungsrecht der in § 53 Abs. 1 Satz 1 Nr. 5 genannten Personen reicht, ist die Beschlagnahme von Schriftstücken, Ton-, Bild- und Datenträgern, Abbildungen und anderen Darstellungen, die sich im Gewahrsam dieser Personen oder der Redaktion, des Verlages, der Druckerei oder der Rundfunkanstalt befinden, unzulässig. ²Absatz 2 Satz 3 gilt entsprechend; die Beschlagnahme ist jedoch auch in diesen Fällen nur zulässig, wenn sie unter Berücksichtigung der Grundrechte aus Artikel 5 Abs. 1 Satz 2 des Grundgesetzes nicht außer Verhältnis zur Bedeutung der Sache steht und die Erforschung des Sachverhaltes oder die Ermittlung des Aufenthaltsortes des Täters auf andere Weise aussichtslos oder wesentlich erschwert wäre.

§ 98. ¹[Anordnung der Beschlagnahme] (1) ¹Beschlagnahmen dürfen nur durch den Richter, bei Gefahr im Verzug auch durch die Staatsanwaltschaft und ihre Ermittlungspersonen (§ 152 des Gerichtsverfassungsgesetzes) angeordnet werden. ²Die Beschlagnahme nach § 97 Abs. 5 Satz 2 in den Räumen einer Redaktion, eines Verlages, einer Druckerei oder einer Rundfunkanstalt darf nur durch den Richter angeordnet werden.

(2) ¹Der Beamte, der einen Gegenstand ohne richterliche Anordnung beschlagnahmt hat, soll binnen drei Tagen die richterliche Bestätigung beantragen, wenn bei der Beschlagnahme weder der davon Betroffene noch ein erwachsener Angehöriger anwesend war oder wenn der Betroffene und im Falle seiner Abwesenheit ein erwachsener Angehöriger des Betroffenen gegen die Beschlagnahme ausdrücklichen Widerspruch erhoben hat. ²Der Betroffene kann jederzeit die richterliche Entscheidung beantragen. ³Solange die öffentliche Klage noch nicht erhoben ist, entscheidet das Amtsgericht, in dessen Be-

¹ § 98 Abs. 1 Satz 1 und Abs. 3 geänd. mWv 1. 9. 2004 durch Art. 3 1. JuMoG v. 24. 8. 2004 (BGBl. I S. 2198).

Patentanwaltsordnung

Vom 7. September 1966
(BGBl. I S. 557; BIPMZ 1966, 313)

zuletzt geändert durch Artikel 6 des Gesetzes
vom 26. März 2006
(BGBl. I S. 358; BIPMZ 2007, 217)

**Erster Teil
Der Patentanwalt**

§ 1

Stellung des Patentanwalts in der Rechtspflege

Der Patentanwalt ist in dem ihm durch dieses Gesetz zugewiesenen Aufgabenbereich ein unabhängiges Organ der Rechtspflege.

§ 2

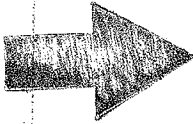
Beruf des Patentanwalts

- (1) Der Patentanwalt übt einen freien Beruf aus.
- (2) Seine Tätigkeit ist kein Gewerbe.

§ 3

Recht zur Beratung und Vertretung

- (1) Der Patentanwalt ist nach Maßgabe dieses Gesetzes unabhängiger Berater und Vertreter.
- (2) Der Patentanwalt hat die berufliche Aufgabe,
 1. in Angelegenheiten der Erlangung, Aufrechterhaltung, Verteidigung und Anfechtung eines Patents, eines ergänzenden Schutzzertifikats, eines Gebrauchsmusters, eines Geschmacksmusters, des Schutzes einer Topographie, einer Marke oder eines anderen nach dem Markengesetz geschützten Kennzeichens (gewerbliche Schutzrechte) oder eines Sortenschutzrechts andere zu beraten und Dritten gegenüber zu vertreten;
 2. in Angelegenheiten, die zum Geschäftskreis des Patentamts und des Patentgerichts gehören, andere vor dem Patentamt und dem Patentgericht zu vertreten;



3. in Verfahren wegen Erklärung der Nichtigkeit oder Zurücknahme des Patents oder ergänzenden Schutzzertifikats oder wegen Erteilung einer Zwangslizenz andere vor dem Bundesgerichtshof zu vertreten;
4. in Angelegenheiten des Sortenschutzes andere vor dem Bundessortenamt zu vertreten.

(3) Der Patentanwalt ist ferner befugt,

1. in Angelegenheiten, für die eine Frage von Bedeutung ist, die ein gewerbliches Schutzrecht, ein Datenverarbeitungsprogramm, eine nicht geschützte Erfindung oder eine sonstige die Technik bereichernde Leistung, ein Sortenschutzrecht oder eine nicht geschützte, den Pflanzenbau bereichernde Leistung auf dem Gebiet der Pflanzenzüchtung betrifft oder für die eine mit einer solchen Frage unmittelbar zusammenhängende Rechtsfrage von Bedeutung ist, andere zu beraten und Dritten gegenüber zu vertreten, auch wenn die Voraussetzungen des Absatzes 2 Nr. 1 nicht vorliegen;
2. bei der Verlängerung der Schutzfrist eines Geschmacksmusters andere vor den Amtsgerichten zu vertreten;
3. in den in Nummer 1 bezeichneten Angelegenheiten andere vor Schiedsgerichten und vor anderen als den in Absatz 2 bezeichneten Verwaltungsbehörden zu vertreten.

(4) Jedermann hat das Recht, sich von einem Patentanwalt seiner Wahl nach Maßgabe der gesetzlichen Vorschriften beraten und vertreten zu lassen.

(5) Das Recht der Rechtsanwälte zur Beratung und Vertretung in allen Rechtsangelegenheiten (§ 3 der Bundesrechtsanwaltsordnung) bleibt unberührt.

§ 4

Auftreten vor den Gerichten

(1) In Rechtsstreitigkeiten, in denen ein Anspruch aus einem der im Patentgesetz¹, im Gebrauchsmustergesetz², im Halbleiterschutzgesetz³, im Markengesetz⁴, im Gesetz über Arbeitnehmererfindungen⁵, im Geschmacksmustergesetz⁶ oder im Sortenschutzgesetz⁷ geregelten Rechtsverhältnisse geltend gemacht wird, sowie in Rechtsbeschwerdeverfahren gegen Beschlüsse der Beschwerdestate des Patentgerichts ist auf Antrag einer Partei ihrem Patentanwalt das Wort zu gestatten.

1 abgedruckt unter Nr. 100.

2 abgedruckt unter Nr. 150 a.

3 abgedruckt unter Nr. 160.

4 abgedruckt unter Nr. 200.

5 abgedruckt unter Nr. 450.

6 abgedruckt unter Nr. 180 a.

7 abgedruckt unter Nr. 405.

(2) Das gleiche gilt in sonstigen Rechtsstreitigkeiten, soweit für die Entscheidung eine Frage von Bedeutung ist, die ein gewerbliches Schutzrecht, ein Geschmacksmuster, ein Datenverarbeitungsprogramm, eine nicht geschützte Erfindung oder eine sonstige die Technik bereichernde Leistung, ein Sortenschutzrecht oder eine nicht geschützte, den Pflanzenbau bereichernde Leistung auf dem Gebiet der Pflanzenzüchtung betrifft, oder soweit für die Entscheidung eine mit einer solchen Frage unmittelbar zusammenhängende Rechtsfrage von Bedeutung ist.

(3) § 157 Abs. 1 und 2 der Zivilprozeßordnung⁸ gilt insoweit für Patentanwälte nicht.