

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

June 27, 2022

Opposition No. 91266633

Align Technologies Corp.

v.

Atlassian, Inc. and Atlassian Pty. Ltd.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Applicants' motion (filed March 18, 2022, 21-22 TTABVUE) to compel discovery and to test the sufficiency of responses to requests for admission. The motion has been fully briefed.

The Board finds as an initial matter that Applicants made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. *See* Trademark Rules 2.120(f)(1) and 2.120(i)(1). However, several issues presented in Applicants' motion could have been resolved without the need for Board intervention through a more thorough review of TBMP §§ 414 and 524 (2021). To the extent that the parties rely on case law other than Board precedent in briefing Applicants' motion, the parties are reminded that discovery in Board proceedings is generally narrower than in court proceedings. *See Intercontinental Exchange Holdings, Inc. v. New York Mercantile Exchange, Inc.*, 2021 USPQ2d 988, at *9-10 (TTAB 2021). The

parties are further reminded that the Board is empowered only to determine the right to register marks. *See* TBMP § 102.01.

Motion to test sufficiency of responses to requests for admission denied

The Board turns first to the motion to test the sufficiency of responses to requests for admission.²¹ TTABVUE 12-14. A request for admission is not a means of eliciting information and is instead a way for the parties to stipulate to certain facts to reduce the number of issues for trial. *See Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663, at *5-6 (TTAB 2019). In response to each request for admission, a party must admit or deny the request or explain in detail why it cannot admit or deny the request. *See* Fed. R. Civ. P. 36(a)(4); TBMP § 407.03(b). An admission conclusively establishes the matter set forth in the request, while a denial is merely a refusal to stipulate to that matter, thus leaving the matter to be resolved on the merits. *See* Fed. R. Civ. P. 36(b); *Phillies v. Phila. Consol. Holding Corp.*, 107 USPQ2d 2149, 2152 (TTAB 2013); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 n.8 (TTAB 2007). If a response to a request for admission includes an admission or denial, the Board generally will find the response to be sufficient. *See* TBMP § 524.01.

By its motion, Applicants seek to compel further responses to request for admission nos. 7-12 and 14. Opposer's response to each of the requests at issue ends with a denial. ²¹ TTABVUE 44-46. Accordingly, the Board, in keeping with its general practice, finds that these responses are sufficient. The motion to test the sufficiency of responses to requests for admission is therefore denied.

Motion to compel granted in part

In the motion to compel, Applicants seeks to compel: (1) further responses to interrogatory no. 43, (2) production of documents responsive to Applicants' document request nos. 35, 37, 39 and 46, and (3) a determination of the confidentiality status of Opposer's responses to Applicants' interrogatory nos. 23 and 47. In interrogatory no. 43 and document request no. 39, 21 TTABVUE 30-31 and 38, Applicants seek information and documents regarding any licensing agreements Opposer relies on to use the intellectual property of any third parties. Information concerning Opposer's licensing agreements with third parties based on Opposer's pleaded mark is discoverable. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). On the other hand, Applicant's request for information and documents regarding Opposer's licensing agreements in connection with its use of third-party intellectual property is irrelevant, overly broad and otherwise disproportionate to the needs of this proceeding.¹ 1 TTABVUE 5. *See Fed.*

¹ In this proceeding, Opposer opposes registration of Applicants' mark JIRA ALIGN in standard characters for goods and services in International Classes 9 and 42 on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its previously used mark ALIGN for "company goal tracking, project management, and communication software." 1 TTABVUE. In their answer, 4 TTABVUE, Applicants deny the salient allegations of the notice of opposition and provide amplifications of those denials which provide a fuller basis of their intended defense in this proceeding. Contrary to Applicants' assertion in their motion, 21 TTABVUE 11, Applicants did not assert defenses of unclean hands, unlawful use and bad faith in their answer. Further, failure to state a claim is not a defense because it relates to an assertion of the insufficiency of the complaint rather than a statement of a defense to a properly pleaded claim. *See John W. Carson Found. v. Toilets.com, Inc.*, 97 USPQ2d 1942, 1949 (TTAB 2010).

To the extent that Opposer relies upon prior use of its pleaded mark on services, Opposer has not clearly identified the services for which it is claiming prior use of the pleaded mark in the notice of opposition. If Opposer wants to rely upon prior use of its pleaded mark on services, it must amend its notice of opposition to provide fair notice of the specific services for which it is claiming prior use of the pleaded mark. *See Phillies*, 107 USPQ2d at 2153.

R. Civ. P. 26(b); *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 122 (TTAB 1974) (interrogatory too broad, requiring identity of products having no relevance to opposition); *Volkswagenwerk AG v. Thermo-Chem Corp.*, 176 USPQ 493, 493 (TTAB 1973) (applicant need not provide information as to its other marks or its other products, or as to whether involved mark is used on other products). Applicant need not respond further to this interrogatory and document request.

In document request no. 35, Applicants seek all documents relating to any settlement agreements relating to Opposer's pleaded mark. 21 TTABVUE 35. Information concerning settlement agreements between Opposer and third parties based on Opposer's pleaded mark is discoverable. *See Am. Soc. of Oral Surgeons v. Am. Col. of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979) (relevant to show admissions against interest, limitations on rights in mark, course of conduct leading to abandonment, that the mark has been carefully policed, etc.); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 USPQ 193, 197 (TTAB 1976) (settlement agreements that have avoided litigation may show limitations on party's rights in mark or reveal inconsistent statements); TBMP § 414(10). Opposer is directed to produce copies of settlement agreements responsive to this request.

In document request no. 37, Opposer seeks documents relating to its dispute with O.C. Tanner Company ("Tanner"), Opposer's predecessor-in-interest with regard to Opposer's unpleaded Registration No. 6234390. To the extent that there is any settlement agreement between Opposer and Tanner in any dispute based on Opposer's pleaded mark, Opposer has effectively been directed to produce a copy of

that agreement *supra* in response to document request no. 35. To the extent that there has been any litigation between Opposer and Tanner based on Opposer's pleaded mark, Opposer need only provide documents sufficient to identify the names of the parties to that litigation, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). *See Interbank Card Ass'n v. U.S. Nat'l Bank of Oregon*, 197 USPQ 127, 128 (TTAB 1975) (need not reveal reasons for dismissal of prior opposition against third party); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975) (need not identify all documents pertaining to such litigation); TBMP § 414(10).

To the extent that Applicants seek documents in addition to those already produced regarding unpleaded Registration No. 6234390 that may have been assigned to Opposer in connection with a dispute with Tanner, Opposer need not provide such documents unless and until it amends its notice of opposition to rely upon that registration herein or Applicant amends its answer to add a counterclaim for cancellation of that registration.² *See* Fed. R. Civ. P. 26(e)(1) (duty to supplement discovery responses). *Cf. Volkswagenwerk AG*, 176 USPQ at 493 (applicant need not provide information as to its other marks or its other products, or as to whether involved mark is used on other products); TBMP § 314 (a party cannot obtain judgment on an unpleaded issue). Opposer is directed to produce documents responsive to this request in accordance with the foregoing.

² Applicants can obtain a copy of the document reflecting the assignment of that registration from Tanner to Opposer by reviewing the online records of the USPTO's Assignment Branch for that registration at <http://ahd.uspto.gov/ahdpub/index.jsp>.

In document request no. 46, Applicants seek documents relating to Opposer's relationship with Verne Harnish³ or Scaling Up, which Applicants contend is "Opposer's primary customer." 21 TTABVUE 9. Even if the Board assumes that "Scaling Up has reached out directly to [one of the Applicants] about this dispute and claims to be Opposer's 'sister firm,'" as Applicants allege, 21 TTABVUE 9, Scaling Up is a separate legal entity and a nonparty to this proceeding. Further, Opposer generally need not provide information about its relationships with its customers other than licensing agreements. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988) (need not reveal names of customers including dealers). Opposer is directed to produce any licensing agreements in which it has entered with Mr. Harnish or Scaling Up with regard to the pleaded mark ALIGN.

In sum, the motion to compel is granted to the extent that Opposer is allowed until thirty days from the date of this order to produce documents responsive to document request nos. 35, 37 and 46 in accordance with the foregoing. The motion to compel is otherwise denied.

Motion to change confidentiality designations granted

Applicants have challenged Opposer's designation of its responses to interrogatory nos. 23 and 47 as confidential - attorney's eyes only (AEO). In Opposer's response to interrogatory no. 23, Opposer has provided the number of companies that purchased its goods and services for each year since 2012. In Opposer's response to interrogatory

³ Mr. Harnish appears to be a principal of Scaling Up.

no. 47, Opposer describes its relationship with Mr. Harnish or Scaling Up to promote or sell its goods.

The Board's Standard Protective Order provides for two levels of protected information: (1) Confidential and (2) Confidential — For Attorneys' Eyes Only (trade secret/commercially sensitive) (“AEO”).⁴ *See* TBMP § 412.01. The designations Confidential and AEO “should be limited to information that the producing party or their counsel has determined, in good faith, contains, reflects, or reveals non-public, confidential, proprietary or commercial information that is not readily ascertainable through proper means by the public or the receiving party, to the extent that information either is the type of information that the party normally attempts to protect from disclosure or is subject to privacy protection under federal, state or local law.” *Id.* Types of information that “may” qualify for AEO protection include sensitive business information, including highly sensitive financial or marketing information, and competitive business information, including non-public financial and marketing analyses and strategic product/service expansion plans. *Id.* The AEO designation should be limited to information that “can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others.” *U.S. Polo Ass’n v. David McLane Enters.*,

⁴ Protected information disclosed pursuant to the Standard Protective Order may be used only to facilitate the prosecution or defense of this Board proceeding. In addition, the recipient of any protected information disclosed in accordance with the terms of the Standard Protective Order (e.g., outside counsel, in-house counsel, employees of the parties, etc.) is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using, disseminating, retaining, returning, and destroying the information. *See* Standard Protective Order, paragraph 11.

Inc., 2019 USPQ2d 108442, at *2 (TTAB 2019) (citation omitted). Parties may access information designated as Confidential, subject to any agreed exceptions. *See* TBMP § 412.01. Parties, including in-house counsel, do not have access to information designated as AEO. *Id.*

A motion to challenge a confidentiality designation should be substantially contemporaneous with the designation, or made as soon as practicable after the basis for the challenge is known. *See Duke Univ. v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000); TBMP § 412.01(b). Bearing in mind that Applicants filed their motion roughly one month after the breakdown of discussions regarding the confidentiality designations, the Board finds that Applicants' challenge of the attorney's eyes only designation is sufficiently contemporaneous with the designations at issue.

When a designation has been challenged, the party seeking protection bears the burden of demonstrating that its confidentiality designations are appropriate and must demonstrate a particular need for protection and that a clearly defined and serious injury will result otherwise. *See U.S. Polo Ass'n v. David McLane Enters., Inc.*, 2019 USPQ2d 108442, at *2–3 (TTAB 2019). In this regard, the party must provide particular and specific demonstrations of fact, as distinguished from stereotyped and conclusory statements. *Id.*

With regard to Opposer's response to interrogatory no. 23, 22 TTABVUE 15-16, a party's number of annual customers is analogous to its annual sales figures, the disclosure of which are routinely treated merely as Confidential in Board proceedings.

See id., at *5. Opposer has failed to persuade the Board that designating its annual customer numbers as AEO is warranted. Accordingly, the Board finds that Opposer's response to interrogatory no. 23 is properly designated as Confidential and not as AEO.

With regard to Opposer's response to interrogatory no. 47, 22 TTABVUE 16, Opposer describes Mr. Harnisch's promotion of Opposer's goods in connection with Scaling Up in general terms without setting forth specific strategic information. Bearing in mind that, by definition, promotion to actual or potential customers is inherently public in nature, Opposer has failed persuade the Board that its response is properly designated as AEO. Further, publicly available information should not be designated as confidential. *Id.*, at *8. To the extent that Opposer's response names a licensing agreement, the identity of documents, as opposed to their substance, is not confidential. *See* TBMP § 414(1). Accordingly, the Board finds that Opposer's response to interrogatory no. 47 should not be designated as Confidential or AEO.

Proceedings resumed

Proceedings are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	8/6/2022
Discovery Closes	9/5/2022
Plaintiff's Pretrial Disclosures Due	10/20/2022
Plaintiff's 30-day Trial Period Ends	12/4/2022
Defendant's Pretrial Disclosures Due	12/19/2022
Defendant's 30-day Trial Period Ends	2/2/2023
Plaintiff's Rebuttal Disclosures Due	2/17/2023
Plaintiff's 15-day Rebuttal Period Ends	3/19/2023
Plaintiff's Opening Brief Due	5/18/2023

Defendant's Brief Due	6/17/2023
Plaintiff's Reply Brief Due	7/2/2023
Request for Oral Hearing (optional) Due	7/12/2023

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable.

Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing.

Note: Parties are strongly encouraged to check the entire document before filing.⁵ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

⁵ To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.