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

November 8, 2023

Cancellation No. 92066968

Software Freedom Law Center

v.

Software Freedom Conservancy

Jennifer L. Elgin, Administrative Trademark Judge:

This proceeding comes before the Board for consideration of the March 30, 2023 construed and fully-briefed motion by Respondent for a protective order to preclude Petitioner's executive director, Eben Moglen, from attending the depositions of Respondent's witnesses Bradley Kuhn and Karen Sandler (as supplemented on August 10, 2023 in accordance with the Board's July 21, 2023 order).[1]

The Board has considered the parties' briefs and materials, but addresses the record only to the extent necessary to set forth the Board's analysis and findings. *Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, at *1 (TTAB 2022) (citing *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015)). For purposes of this order, the Board presumes the parties' familiarity with

[1] 109 TTABVUE; 120 TTABVUE; 122 TTABVUE. Citations in this order to the briefs and other materials in the case docket refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020).

the history of the proceeding and the arguments submitted in connection with the motion.

For the reasons set forth below, the motion for protective order is granted.

I. Background

The motion concerns an ongoing dispute regarding the forthcoming depositions of Respondent's witnesses, which has been pending – in one form or another – for over two years.[2] The parties now dispute whether Mr. Moglen (who claims to be a licensed attorney, but who has not entered an appearance in this proceeding), may attend these depositions as Petitioner's client representative and/or take the depositions as Petitioner's counsel.

On July 21, 2023, the Board denied Respondent's request for reconsideration of the Board's March 6, 2023 order in part, to the extent it precluded motions practice regarding the depositions.[3] However, the Board construed the filing, which was supported by declarations by Mr. Kuhn and Ms. Sandler, as a motion for a protective order to exclude Mr. Moglen from attending the depositions under Fed. R. Civ. P. 26(c)(1)(E) and 30(c)(2), and exercised its discretion to consider the motion on its merits. The Board also permitted Respondent time in which to supplement the record

[2] *See* 75 TTABVUE (Petitioner's motion to compel witnesses for deposition); 86 TTABVUE (Petitioner's motion for sanctions); 96 TTABVUE (Petitioner's motion to challenge attorney's eyes only designation); 102 TTABVUE (Respondent's request for reconsideration); 109 TTABVUE (Respondent's request for reconsideration); 111 TTABVUE (Respondent's Petition to the Director); 122 TTABVUE (Respondent's supplement to motion for protective order).

[3] 120 TTABVUE.

with all additional arguments, legal authority, and evidence in support of the construed motion.[4]

On August 10, 2023, Respondent filed a Supplemental Memorandum including evidence of its good faith effort to resolve the dispute (Exhibit A); the Supplemental Declaration of Bradley Kuhn and exhibits (including an unsworn letter from Mr. Kuhn's therapist Heather Brooks Rensmith and a DVD video file) (Exhibit B); and the Supplemental Declaration of Karen Sandler and attached exhibits, including emails from Mr. Moglen and third parties John Sullivan and Matthias Kirschner) (Exhibit C).[5]

Respondent argues there is good cause to exclude Mr. Moglen from the depositions because his presence will cause the witnesses anxiety and fear which will in turn affect their ability to testify. Respondent proffers evidence that Mr. Moglen has, for example:[6]

- Screamed at Mr. Kuhn for "failing to do my job properly, insulted my technological skill, and made various other abusive statements" and telling him "perhaps I was in the wrong job . . . ."
- Berated Mr. Kuhn for preparing a budget and attempting "to usurp his authority and [saying] that I did not have the background knowledge, experience, or permission to prepare such a document."

[4] *Id.* at 2.

[5] The Board notes that, despite the inclusion of personal information in its filings, Respondent did not opt to file such materials under seal. Should Respondent wish to do so, it may promptly file redacted versions with the Board, and the Board will place the original filings under seal. In view thereof, the Board refers to such personal information in broad terms in this order.

[6] *See* Kuhn Decl. ¶¶ 11, 17, 22, 24-38, 47-49, 51-57 (109 TTABVUE 8-19); email from Matthias Kirschner to Karen Sandler (*id.* at 51); Sandler Decl. ¶ 7, 11 (*id.* at 33-36).

- Shared personal information about Mr. Kuhn's phobias in a denigrating way with a third party;
- Yelled at Mr. Kuhn about a blog post and intimidated him physically and aggressively;
- Made evocative comments in a public setting, which Mr. Kuhn believes was intended to refer to the murder of Mr. Kuhn's mother;
- Attempted to sit with Mr. Kuhn in a restaurant when asked to keep his distance;
- Called Mr. Kuhn a "psycho" and Mr. Kuhn and Ms. Sandler "clowns" in a phone call with a third party;
- Yelled and threatened Ms. Sandler numerous times in person and on the telephone; and
- Berated Ms. Sandler from the audience while she sat on a conference panel; and
- Been verbally abusive to others in the presence of Ms. Sandler and Mr. Kuhn.

Respondent provides evidence, in the form of declarations from the witnesses and a letter and declaration from Mr. Kuhn's therapist, as to the likely harm to Mr. Kuhn and Ms. Sandler that would result from Mr. Moglen's attendance and participation at the depositions, even virtually, and "even third parties quoting him, or using his favorite turns of phrase and mannerisms."[7] In particular, Ms. Rensmith reports that "there will likely be psychological harm for [Mr. Kuhn] if he spends any time in any manner in or near Moglen's presence, either virtually or in-person, including but not limited to Moglen's presence at or nearby [Mr. Kuhn's] deposition in this matter."[8]

[7] Supp. Kuhn Decl. ¶ 69 (122 TTABVUE 18).

[8] Rensmith Decl. ¶ 12 (125 TTABVUE 15); *see also* 122 TTABVUE 21 ("I would not recommend that he be required to be in the presence of Moglen, and subjected to the potential of further harm by this person.").

Respondent argues that Petitioner has not demonstrated that Mr. Moglen's presence is necessary to its case, and that Petitioner's true goal is to "harass and hurt" the deponents.[9] Finally, Respondent argues that "under New York ethical rules, [Mr. Moglen] cannot represent Petitioner and testify as a fact witness on its behalf,"[10] and would have to excuse himself during any "Attorney's Eyes Only" deposition testimony.[11]

Petitioner's opposition to the construed motion for a protective order is supported by the Declaration of Eben Moglen and attached exhibits.[12] Petitioner confirms that Mr. Moglen intends to take the deposition as its counsel, and argues that Respondent has not met the "good cause" standard to exclude him. Petitioner contends that the motion for a protective order is "not an appropriate vehicle to disqualify an attorney from acting for a company that he created and is currently an officer."[13] Petitioner also requests an additional half day "with each witness to inquire into statements made in declarations under oath by these witnesses in connection with the present motion."[14]

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[9] 122 TTABVUE 7.

[10] *Id.* (citing N.Y.R. of Prof'l Conduct 3.7) (attached as Exhibit D).

[11] *Id.* at 7 n.2; 125 TTABVUE 9 n.3.

[12] *See* 124 TTABVUE.

[13] *Id.* at 4.

[14] *Id.* at 14. A deposition is limited to one day of seven hours, unless stipulated by the parties or otherwise authorized by Board order. Fed. R. Civ. P. 30(d)(1); *see also* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 404.06 (2023). Rule 30(d)(1) allows for additional time consistent with Fed. R. Civ. P. 26(b)(2) if needed for fair examination of the deponent. *Id.*

Mr. Moglen, in his declaration in response to Respondent's allegations, recounts past dealings with Mr. Kuhn and Ms. Sandler, including: terminating Mr. Kuhn's employment from Petitioner; a "coup" orchestrated by Mr. Kuhn to remove Mr. Moglen from Respondent's Board of Directors; and a past dispute over a plagiarism issue after which he claims "Sandler and Kuhn [ ] committed themselves to the mature and well-considered strategy of never speaking to us again . . . ."[15] Mr. Moglen explains that he should not be disqualified from conducting the depositions:

> There has never been any doubt I would personally conduct these depositions. I have known both these witnesses for decades; they each worked under my daily personal supervision for years. In addition to being familiar with the witnesses, I have a good knowledge of the background and the record. Being on salary, I am inexpensive.
> . . . .
>
> The facts recited in the reluctant witness's declarations may look slightly different after cross-examination, as much will. But let us grant them, arguendo, their . . . difficulties. Put in simpler but not less accurate words, their testimony is they are afraid. Let them call their frailties and troubles what they like, they are no basis for interfering with our, SFLC's, right to be represented by the counsel of our choice.
>
> After decades spent law professing, I guess there are quite a few people who, imagining me cross-examining them, would feel afraid. Their subjective moods do not constitute a basis for limiting my state-granted right to practice law.[16]

In reply, Respondent confirms that its present motion seeks to bar Mr. Moglen from these two depositions and not to preemptively disqualify him as counsel for Petitioner; but, Respondent points to Mr. Moglen's declaration to show that he would

[15] Moglen Decl. ¶ 14 (124 TTABVUE 23).

[16] *Id.* at ¶¶ 21-23 (124 TTABVUE 25-26).

be disqualified if he enters an appearance as counsel of record.[17] Respondent observes that Petitioner does not deny any of the factual assertions regarding Mr. Moglen's past behavior.[18] Finally, Respondent opposes Petitioner's request for additional time in the depositions.[19]

II. Evidentiary Matters

As an initial matter, the Board first turns to certain evidentiary matters.

Petitioner argues that certain evidence submitted by Respondent in support of its motion should not be considered. First Petitioner contends emails from John Sullivan and Matthias Kirschner (Exhibits 3 and 4 to Ms. Sandler's supplemental declaration) contain inadmissible hearsay.[20] Second, as to the unsworn letter from Heather Brooks Rensmith, a clinical social worker, Petitioner contends "it would be clear error for the Board to rely upon the report [from Ms. Rensmith] without permitting Petitioner to have an independent psychological examination of Kuhn obtained by a licensed practitioner of its choice," and questions Ms. Rensmith's qualifications.[21]

In its reply brief, Respondent argues the Board may consider reliable, but otherwise inadmissible evidence, in deciding a motion for protective order. Respondent also submits a Declaration from Ms. Rensmith "setting out in greater

[17] 125 TTABVUE 6-8.

[18] *Id.* at 8-10.

[19] *Id.* at 9-10.

[20] The Federal Rules of Evidence are applicable in Board proceedings under Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). *See also* TBMP § 101.02.

[21] 124 TTABVUE 10-11.

detail the points made in her August 6, 2023 letter" and "put[ting] to rest Petitioner's underbaked concerns about her qualifications and practice."[22]

There is no question, and Respondent does not contend otherwise, that the unsworn emails from Mr. Sullivan and Mr. Kirshner would be hearsay if used to prove the matter asserted therein. Fed. R. Civ. P. 801(c).[23] To the extent Respondent's argument could be construed to maintain that the Board should apply the "residual hearsay" exception under Federal Rule of Evidence 807, it is unavailing. *See TV Azteca, SAB de CV v. Martin*, 128 USPQ2d 1786, 1791 (TTAB 2018) ("The residual hearsay exception is intended to 'be used only rarely, in truly exceptional cases.'") (citing *Pozen Inc. v. Par Pharm. Inc.*, 696 F.3d 1151, 104 USPQ2d 1969, 1976 n.6 (Fed. Cir. 2012)). Because this evidence has not been shown to be reliable and guarantees of trustworthiness have not been satisfied, it fails to satisfy the preliminary requirement of the Rule 807 exception.[24] Nonetheless, the Board may consider these emails not for the truth of the matter asserted therein, but rather as foundation for Ms. Sandler and Mr. Kuhn's *belief* that they will be intimidated by Mr. Moglen during their depositions.

The letter from Ms. Rensmith is not hearsay as it is not offered to prove any actions by Mr. Moglen. Rather, the letter indicates Ms. Rensmith's opinion as to the

[22] 125 TTABVUE 5.

[23] Mr. Moglen, however, admits that the events recounted by Mr. Sullivan were "accurately recall[ed]," but lack additional context that Mr. Moglen supplies in his declaration. Moglen Decl. ¶ 23 n.2 (124 TTABVUE 26).

[24] There also would be a question of whether Respondent gave sufficient notice to Petitioner of its intent to use these out of court statements, but the Board need not reach this issue. Fed. R. Civ. P. 807(b).

harm that Mr. Kuhn would experience should Mr. Moglen attend his deposition. Even if it is hearsay, Federal Rule of Evidence 703 permits an expert opinion to be based on non-admissible evidence, including hearsay, in certain circumstances. *See* Wright & Miller, 29 Fed. Prac. & Proc. Evid. § 6274 and cases cited in n.71 (2d ed. Sept. 8, 2023 update). The Board is capable of giving Ms. Rensmith's letter appropriate probative weight, recognizing that it is unsworn and Petitioner has not had the opportunity to test her opinion by cross-examination. *See McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1274 (TTAB 2014) (where parties moved to strike evidence Board noted objections and took them into consideration allocating the appropriate weight to the evidence).[25]

III. Motion for Protective Order

A. Good Faith Effort to Confer

Fed. R. Civ. P. 26(c)(1) requires that a party that moves for a protective order include a certificate that the movant has in good faith conferred or attempted to confer with the other affected parties in an effort to resolve the dispute without court action. *See also Phillies v. Phila. Consol. Holding Corp.*, 107 USPQ2d 2149, 2151 (TTAB 2013); *see also* TBMP § 412.06. Here, there is no dispute that the parties made a good faith attempt to resolve the dispute.

[25] As noted above, Respondent also submitted a declaration from Ms. Rensmith with its reply brief, and Respondent did not move to strike it. Moreover, because the declaration was prompted by Petitioner's objections, Petitioner has had an adequate opportunity to respond to this evidence. Accordingly, the Board also will consider the declaration.

B. Analysis

Trademark Rule 2.120(g) states:

> Upon motion by a party . . . from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (A) through (H), inclusive, of Rule 26(c)(1) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions . . . as are just, order that any party comply with disclosure obligations or provide or permit discovery.

37 C.F.R. § 2.120(g); *see also* TBMP §§ 412.06, 526.

The Board may "for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense, including . . . designating the persons who may be present while the discovery is conducted." Fed. R. Civ. P. 26(c)(1)(E). "Rule 26(c) emphasizes 'the complete control that the court has over the discovery process.'" *Pioneer K.K. v. Hitachi High Techs. Am., Inc.*, 74 USPQ2d 1672, 1674 (TTAB 2005) (internal citation omitted). "To establish good cause, a movant must provide 'a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.'" *Phillies*, 107 USPQ2d at 2152-53 (quoting *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999)). Further, "[t]he movant must demonstrate that its ability to litigate will be prejudiced, not merely that the difficulty of managing the litigation will increase." *Id.* (citation omitted).

"Good cause" for issuance of a protective order pursuant to Rule 26(c)(1)(E) may include barring individuals from attending a deposition where the evidence supports that exclusion will prevent the intimidation of a witness. *See, e.g., Tolbert-Smith v.*

Bodman, 253 F.R.D. 2, 4 and n.1 (D.C. Cir. 2008) (excluding two former supervisors from deposition based upon opinions of plaintiff's treating physician that her reaction to the resulting stress would be "very severe"); *In re Shell Oil Refinery*, 136 F.R.D. 615, 617 (E.D. La. 1991) (granting protective order excluding defendant's designated corporate representative, the deponent's supervisor, from deposition to prevent intimidation of the witness). *But cf. Kerschbaumer v. Bell*, 112 F.R.D. 426, 426 (D.D.C. 1986) (noting a court may bar even parties from attending depositions, but declining to do so where the moving party provided only an inchoate fear that it would result in perjury).[26]

In determining whether to exclude an individual from a deposition for intimidation, a court (or in this case, the Board) may balance the deposing party's significant interest in conducting discovery in preparation for trial in the manner of its choosing against the harm the individual's attendance at the depositions will cause the witnesses. *Cf. Heat & Control, Inc. v. Hester Indus., Inc.*, 785 F.2d 1017, 1024 (Fed. Cir. 1986) (noting a court may need to balance the relevance of the discovery sought and its potential hardship to the party subject to a subpoena); *see also Pamida, Inc. v. E.S. Originals, Inc.*, 281 F.3d 726, 729 (8th Cir. 2002) (in considering a motion to quash, a district court has a "range of choice" and may need to "balance[e] relevant factors"); *Deitchman v. E.R. Squibb & Sons, Inc.*, 740 F.2d 556,

[26] The parties' discussions of *Galella v. Onassis*, 487 F.2d 986, 997 (2d Cir. 1973), where the court barred the plaintiff, an individual, from attending deposition under Rule 26(c)(5), are not relevant, as Respondent is not seeking to exclude Petitioner from attending the deposition; rather, Petitioner seeks to exclude only one individual: Mr. Moglen.

563 (7th Cir. 1984) ("To weigh competing hardships to determine the appropriateness of discovery is clearly within the responsibility of the trial judge, in the first instance.").

In this instance, Respondent's evidence indicates the likely harm to Mr. Kuhn and Ms. Sandler should Mr. Moglen be present at their depositions, let alone take their depositions. This would present significant prejudice to Respondent's ability to defend the cancellation.

Weighing against these considerations is Petitioner's argument that Mr. Moglen has "a good knowledge of the background and the record" and as an employee of Petitioner, is "inexpensive." These facts, however, are not entitled to significant weight. Petitioner is ably represented by outside counsel, and could send any corporate representative other than Mr. Moglen to assist. Even assuming that Mr. Moglen possesses unique information relating to the claim and defenses pending before the Board (which he has not asserted), Petitioner has not demonstrated that its outside counsel is unable to take the depositions without real-time assistance from Mr. Moglen. As to the added expense of using outside counsel, the Board routinely requires parties representing themselves pro se to retain counsel to obtain access to discovery, even if this results in additional costs.[27] Finally, Mr. Moglen has not entered an appearance as counsel for Petitioner in this proceeding. Although the

[27] For example, parties, including their in-house counsel, do not have access to "Attorneys Eyes Only" material and information under the Board's Standard Protective Order. *See U.S. Polo Ass'n v. David McLane Enters.*, 2019 USPQ2d 108442, at *3 (TTAB 2019); *Georgia-Pacific Corp. v. Solo Cup Co.*, 80 USPQ2d 1950, 1951 (TTAB 2006). Thus, to obtain access to such materials, a pro se party must hire outside counsel or forgo access to these materials.

Board need not decide at this juncture, given the depth of Mr. Moglen's knowledge, it is quite uncertain whether he could represent Petitioner as counsel. *See* Trademark Rule 11.307, 37 C.F.R. § 11.307 ("A practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be a necessary witness" except in limited circumstances); *see also* TBMP § 513.02 and authorities cited therein.

Moreover, should Petitioner's counsel find himself unable to complete the depositions without Mr. Moglen's input, Petitioner has available remedies: i.e., suspending the depositions and/or filing a motion for additional time, to allow its counsel to confer with Mr. Moglen. *See* Fed. R. Civ. P. 30(d)(1); *see also* TBMP § 404.06(c). On the other hand, the potential psychological harm to Respondent's witnesses cannot be ameliorated by any Board order.

In view thereof, the Board finds that Respondent has shown good cause for the sought-after protective order, and the motion is **granted**. Mr. Moglen is precluded from taking or attending the depositions of Mr. Kuhn and Ms. Sandler, in person or virtually.

Moreover, the Board notes that:

> Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.

Fed. R. Civ. P. 26(b)(1) (emphasis added); *see also* TBMP § 402.01. Because the Board cannot conceive of any possible relevance of the witnesses' mental health concerns to the claim or defenses in this proceeding that would not be outweighed by the burden of providing this discovery, the scope of the depositions is limited accordingly, and there is no need for an expansion of time to question these witnesses.

IV. Proceedings Remain Suspended; Response Required

Respondent is permitted **thirty days** from the date hereof to notify the Board by filing an appropriate paper in ESTTA if the decision granting the protective order herein resolves the pending Petition to the Director, failing which the Petition will be dismissed as moot.[28]

Proceedings remain **suspended** pending Respondent's response to this order. Upon resumption, appropriate dates will be set.

[28] *See* 111 TTABVUE.