

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

March 6, 2023

Cancellation No. 92066968

Software Freedom Law Center

v.

Software Freedom Conservancy

Jennifer L. Elgin, Interlocutory Attorney:

This case comes up on Respondent's request (filed November 14, 2022)¹ for reconsideration of the Board's October 19, 2022 order ("Board's Order")² concerning the conduct of certain noted depositions. The request is fully briefed.

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

¹ 102 TTABVUE. Citations to the record or briefs in this opinion also include citations to the publicly available documents on TTABVUE, the Board's electronic docketing system. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable.

² 101 TTABVUE.

the history of the proceeding and the arguments submitted in connection with the Board's Order and request for reconsideration.

I. Request for Reconsideration

A. Background

On June 15, 2022, Petitioner filed a motion challenging Respondent's designation of the entirety of the forthcoming depositions of Respondent's witnesses Karen Sandler and Bradley Kuhn as "Confidential – For Attorneys' Eyes Only (Trade Secret/Commercially Sensitive)" ("Attorneys' Eyes Only").³

In support of its motion, Petitioner contended that pre-designation of the entire depositions as Attorneys' Eyes Only is improper under the Standard Protective Order, and that the true purpose of this designation was to prevent Petitioner's principals from attending the depositions.⁴ Respondent argued that it has the right to temporarily designate the entirety of the transcript (and thus the depositions) as Attorneys' Eyes Only under the terms of the Standard Protective Order; that these witnesses have sensitive information that could be disclosed; that Petitioner will not be prejudiced by exclusion of their principals from the depositions; and that Petitioner's principals have conducted a "campaign of harassment – both physical and psychological" against Mr. Kuhn and Ms. Sandler, justifying their exclusion.⁵ In

³ 96 TTABVUE.

⁴ *Id.* at 2; *see also* 101 TTABVUE 2.

⁵ 97 TTABVUE 7-12; *see also* 101 TTABVUE 2-3.

reply, Petitioner alleged Respondent's opposition was a disguised motion for protective order.⁶

On October 19, 2022, the Board granted Petitioner's motion.⁷ The Board found that the Standard Protective Order presumptively treats all depositions and exhibits under the lower Confidential tier, but that a party may, within the thirty-day period following the deposition, re-designate portions under the appropriate tier of the protective order.⁸ The Board further explained that "[t]he Attorneys' Eyes Only designation is reserved for highly sensitive information 'the producing party reasonably and in good faith believes would likely cause harm.'"⁹ The Board found, citing *U.S. Polo Ass'n v. David McLane Enters., Inc.*, 2019 USPQ2d 108442, at *2-3 (TTAB 2019) ("*U.S. Polo*"), that Respondent bears the burden to demonstrate that its confidentiality designations are appropriate, and:

Respondent has not shown with "clear and specific evidence" that designation of the entirety of these depositions (regardless of the nature of the question, answer, objection, or exhibit) under the Attorneys' Eyes Only tier is necessary to prevent "clearly defined and serious injury." Rather, Respondent only offers conclusory argument, unsupported by evidence, of harm. Accordingly, the Attorneys' Eyes Only designation is not made in good faith.¹⁰

B. Request for Reconsideration

In its current request, Respondent first argues that the Board failed to recognize that Ms. Sandler and Mr. Kuhn are officers of Respondent "who have complete

⁶ 100 TTABVUE 4-5; *see also* 101 TTABVUE 3.

⁷ 101 TTABVUE.

⁸ *Id.* at 5-6.

⁹ *Id.* at 5 (citing Standard Protective Order § 1).

¹⁰ *Id.* at 6.

knowledge of [Respondent's] sensitive business information"¹¹ Further, Respondent argues the Board failed to properly consider the thirty-day period for review of a deposition transcript provided in Section 8 of the Standard Protective Order; misread Section 1 of the Standard Protective Order; and "groundlessly asserted that Respondent [] did not act in good faith in making its 'Attorneys' Eyes Only' designation and opposing Petitioner's motion."¹² Respondent also asserts that the Board's reliance on *U.S. Polo, supra*, is in error, because that case merely relies on the Board's Manual of Procedure, and concerns "final" designations of discovery materials as opposed to "temporary" designations of materials.¹³

Respondent offers two new exhibits in support of its request for reconsideration: (1) an unsigned "[Proposed] Stipulated Protective Order" from an unrelated civil action to show that, "[i]n civil litigation it is common practice to designate an entire deposition transcript as 'Attorneys' Eyes Only' pending review of the transcript by the deposed party";¹⁴ and (2) a declaration by Ms. Sandler to confirm that she and Mr. Kuhn have knowledge of Respondent's "sensitive business information that should be kept out of the hands of Petitioner and its principals" and "providing this information to Petitioner may cause serious harm."¹⁵ Further, Ms. Sandler refers

¹¹ 102 TTABVUE 2-3.

¹² *See id.* at 3, 7-8.

¹³ *Id.* at 8-9.

¹⁴ *See id.* at 7, 15-25 (Exh. 1).

¹⁵ *Id.* at 12; *see also id.* at 26-30 (Declaration of Karen M. Sandler) (Exhibit 2).

obliquely to the “campaign of harassment” perpetrated by Petitioner’s principals, but refrains from providing details of the alleged “abusive” behavior.¹⁶

In opposition to the request for reconsideration, Petitioner contends Respondent merely reargues its prior positions regarding interpretation of Sections 1 and 8 of the Standard Protective Order.¹⁷ Petitioner argues the Board should not consider the exhibits to Respondent’s motion because they were not previously made of record.¹⁸ Further, Petitioner maintains that the evidence supports the Board’s finding that Respondent’s confidentiality designations were not made in “good faith.”¹⁹

In reply, Respondent again asserts it is not seeking to delay the proceeding and its designations were made in “good faith.”²⁰

C. Analysis and Decision

The basis for a request for reconsideration under Trademark Rule 2.127(b), 37 C.F.R. § 2.127(b), is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. *Guess? IP Holder*, 116 USPQ2d at 2019. A request for reconsideration is not to be used for re-argument of points previously raised or for introduction of new evidence or arguments. *See Lumber Liquidators Servs., LLC v. Columbia Ins. Co.*, 2022 USPQ2d 31, at *2 (TTAB 2022); *Scotch Whisky Ass’n Ltd. v. ASW Distillery, LLC*, 2021

¹⁶ *Id.* at 28 (Sandler Decl. ¶¶ 4-5) (“If there comes an appropriate time, Mr. Kuhn and I will provide details of that campaign of harassment.”).

¹⁷ *See* 104 TTABVue 2-3, 4-5.

¹⁸ *Id.* at 3.

¹⁹ *Id.* at 3-4.

²⁰ *Id.* at 3.

USPQ2d 179, at *3 (TTAB 2021); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 518 (June 2022). As discussed below, the Board has reviewed its order carefully, and finds no basis to reconsider its decision.

First, Ms. Bradley’s newly-provided declaration appears to be offered primarily to bolster Respondent’s claim that its two witnesses (confirmed to be current employees) possess knowledge that, if disclosed to Petitioner’s principals, would be harmful to Respondent. Even if the Board were to consider the declaration, Respondent has not demonstrated that mere knowledge of highly sensitive information by a current or former employee supports pre-designating **the entirety** of a deposition as Attorneys’ Eyes Only. Moreover, the Board notes that many of the categories of Attorneys’ Eyes Only information Respondent claims are in the possession of its witnesses have little, if any relevance in a Board proceeding, and Respondent admits it does not know exactly what questions Petitioner will ask during the depositions.²¹ Nor would the Board’s consideration of a single draft protective order in an unrelated federal district court case demonstrate that the Board’s interpretation of its own Standard Protective Order or caselaw is erroneous.

The Board disagrees with Respondent’s suggestion that the Board misinterpreted Sections 1 and 8 of the Standard Protective Order. The Board found that Section 8 of the order presumptively treats the entirety of a deposition transcript as Confidential.

²¹ *See* 97 TTABVUE 8-9 and 102 TTABVUE 10-11. *But see* 102 TTAB 29-30 (Sandler Decl. ¶ 9) (“Given the broad-reaching requests that Petitioner has already made in written discovery, I expect that, during my and Mr. Kuhn’s depositions, Petitioner will inquire about [certain topics]”). Respondent does not indicate whether it already provided responsive information or objected to any such inquiries, such as on grounds of relevance.

The Board did not state, however, that Section 8 prevents a party from making a good-faith designation of certain documents or discussions as Attorneys' Eyes Only during the deposition – particularly if produced documents have been previously marked as such. Indeed, Section 8 also provides as follows:

Protected documents produced during an oral discovery deposition . . . shall be noted appropriately as such by the producing or offering party at the outset of any discussion of the document or information contained in the document If [deposition] testimony includes protected information, the interested party shall, to the extent practical under the circumstances, make note on the record of the protected nature of the information.²²

The Board found, however, that Respondent had not carried its burden to establish the propriety of wholesale prior designation (even if temporary) of the depositions as Attorneys' Eyes Only, regardless of the nature of the question, answer, objection, or exhibit.

Nor was the Board's reliance on *U.S. Polo*, 2019 USPQ2d at 108442, in error. That case confirmed the Board's previous guidance with regard to challenging confidentiality designations in a precedential decision.²³ Respondent, moreover, has not established any real distinction between over-designation of written discovery (addressed in *U.S. Polo*) and deposition testimony merely because the Standard Protective Order permits re-designation after the conclusion of the deposition. The Board previously has found that even parties' stipulations to designate an entire

²² Standard Protective Order § 8.

²³ Prior to the issuance of *U.S. Polo*, the relevant portions of Section 412.01(b) of the TBMP cited to Fed. R. Civ. P. 26(c)(1) and *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759, 1761 (TTAB 1999) (burden for protective order), among other authorities. *See, e.g.*, TBMP § 412.01 (June 2018).

deposition as Attorneys' Eyes Only is improper in Board proceedings. *See Revolution Jewelry Works, Inc. v. Stonebrook Jewelry, LLC*, 2022 USPQ2d 229, at *14-15 (TTAB 2022) (ordering parties to review the protective order and limit information and documents designated as Attorneys' Eyes Only to that which they determine "in good faith" is truly confidential or trade secret/commercially sensitive information: "In particular, we note that the parties' designations of entire Rule 30(b)(6) deposition transcripts as 'Attorney's Eyes Only' is improper.") (citing *Sports Auth. Mich. Inc. v. PC Auth. Inc.*, 63 USPQ2d 1782, 1787 (TTAB 2001)).

Finally, the Board turns to Respondent's argument regarding the Board's use of the term "good faith." Respondent appears to interpret the Board's order as finding that Respondent acted in "bad faith." This is not accurate. Rather, the Board found that Respondent had not carried its burden to show that prior designation of the entire depositions (as opposed to particular categories of information or documents) complies with Section 1 of the Standard Protective Order, which states that Attorneys' Eyes Only designations shall be made only as to selected categories of sensitive and competitive information as well as "any other commercially sensitive information the disclosure of which to non-qualified persons subject to this Order the producing party reasonably **and in good faith** believes would likely cause harm."²⁴

²⁴ Standard Protective Order § 1 (emphasis supplied). Indeed, Respondent previously offered its witnesses' public declarations and exhibits regarding topics Respondent evidently considers will be relevant to this proceeding (such as the selection of Respondent's trademark and creation of its website, Respondent's hiring decisions, Respondent's decision to register its trademarks, its attendance at industry conferences, Respondent's revenue and non-profit status, its member projects, its fundraising efforts, its social media presence, and interactions with Petitioner) in connection with its motion for summary judgment. *See generally* 20 TTABVue 23-106 (Declaration of Bradley Kuhn) and 107-42 (Declaration of Karen Sandler).

Respondent's wholesale designation does not rise to this level. *Cf. Revolution Jewelry Works, Inc.*, 2022 USPQ2d 229, at *14-15.

Accordingly, having found no error in the Board's Order, Respondent's request for reconsideration is **denied**.

II. Conduct of Deposition and Future Motions

The Board continues to be very concerned that the depositions still have not taken place despite multiple orders by the Board to complete them expeditiously. Furthermore, the Board notes that Respondent admits it intends to file **another** motion "to exclude [Petitioner's principal] from the deposition . . . pursuant to FRCP 26(c)" ²⁵ Respondent intimates that it will expand its previous arguments regarding the "campaign of harassment" in support of this promised motion. ²⁶ The Board highly discourages this type of piecemeal litigation, which unnecessarily delays proceedings, needlessly raises the cost of the litigation, and taxes the Board's scant resources.

The Board has the inherent authority "to manage its docket, to prevent undue delays, and to regulate the conduct of those who appear before it." *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) (citation omitted). The Board observes that Petitioner and Respondent previously agreed to conduct

This is a strong indication that there are many potentially relevant and wholly non-confidential topics and documents about which Respondent's witnesses may testify, and that therefore Respondent's wholesale prior designation is not made "in good faith."

²⁵ 102 TTABVue 10 n.10.

²⁶ See *id.* ("However, that is a separate issue to be addressed later, if necessary."); see also *supra* note 16.

depositions remotely.²⁷ In view thereof, and because doing so will avoid the need for further motions practice regarding in-person attendance at the depositions, Respondent is ordered to produce Ms. Sandler and Mr. Kuhn for deposition by remote means within **thirty days** of the date of this order. *See* TBMP § 404.06 and authorities cited in n.2. Respondent may designate truly confidential or trade secret/commercially sensitive information as Attorneys' Eyes Only **during** the depositions in accordance with the terms of the Standard Protective Order, upon which Petitioner's principals (should they choose to attend) should be temporarily excused from the depositions until such time as such discussions are concluded.²⁸ In view thereof, the parties are **precluded** from filing any further motions regarding the depositions of Ms. Sandler and Mr. Kuhn until such time as the depositions are completed.

Petitioner is ordered to complete the written discovery supplementation and document production (as ordered in the Board's order dated April 12, 2022) within

²⁷ *See, e.g.*, 81 TTABVUE 11 (“[Mr. Bradley] lives in Oregon and does not agree to come to New York City for his deposition. He will appear for a video online deposition at a mutually convenient date and time. As to Karen Sandler, we will confer with her and propose dates for her online video deposition.”) (March 2, 2021), *id.* at 9 (“In view of the ongoing health risks from COVID-19, we propose that the depositions be conducted virtually rather than in person. Given the nature of our respective clients, we believe your client will agree that non-proprietary videoconferencing software will be employed.”) (Nov. 17, 2021), *id.* at 25 (“We wanted to depose these witnesses in person but you would not allow for that. As we have already waited for years, we accept to take these depositions through video conferencing.”) (Nov. 30, 2021), and *id.* at 68 (“This will give us time to hire a deposition service that can handle a virtual deposition”) (Dec. 13, 2021).

²⁸ The Board encourages the parties to agree in advance as to the subject matters and documents that will be designated as Attorneys' Eyes Only.

ten days of the date of completion of the depositions of Ms. Sandler and Mr. Kuhn.²⁹ The parties are ordered to cooperate in scheduling the depositions of Petitioner's witnesses (to the extent any have been duly noticed) to take place after Petitioner has supplemented its discovery responses.

Following the close of fact discovery, proceedings herein are **suspended** for ninety days for the sole purpose of affording Petitioner the opportunity to take discovery limited to Respondent's designated expert witness. Additionally, if Petitioner retains an expert for rebuttal purposes, Petitioner must serve a rebuttal expert disclosure upon Respondent in accordance with Fed. R. Civ. P. 26(a)(2) and notify the Board of its intention of using a rebuttal expert witness within the same ninety-day time period set forth above. In the event Petitioner retains a rebuttal expert witness, Respondent will be entitled to take limited discovery of Petitioner's rebuttal expert witness within the same ninety days provided above. If all discovery regarding designated expert witnesses is completed prior to the conclusion of the ninety-day suspension period, the parties must promptly notify the Board so that the Board may reset remaining dates.³⁰

²⁹ 91 TTABVUE 12.

³⁰ The parties are warned that failure to comply with the Board's orders herein may result in the imposition of sanctions, including judgment. *See* Trademark Rule 2.120(h), 37 C.F.R. § 2.120(h); *Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at *5-6 (TTAB 2019) (judgment as a sanction granted for failure to comply with Board orders to produce witness for deposition); *see also* TBMP 527.01(a). In addition, should Respondent again over-designate portions of the depositions as Attorneys' Eyes Only, the Board would entertain Petitioner's motion to reopen the depositions.

III. Proceedings Resumed

Proceedings are **resumed** and the remaining proceeding dates are reset as follows:

Fact Discovery Closes	5/2/2023
Expert Discovery Closes	7/31/2023
Plaintiff's Pretrial Disclosures Due	9/14/2023
Plaintiff's 30-day Trial Period Ends	10/29/2023
Defendant's Pretrial Disclosures Due	11/13/2023
Defendant's 30-day Trial Period Ends	12/28/2023
Plaintiff's Rebuttal Disclosures Due	1/12/2024
Plaintiff's 15-day Rebuttal Period Ends	2/11/2024
Plaintiff's Opening Brief Due	4/11/2024
Defendant's Brief Due	5/11/2024
Plaintiff's Reply Brief Due	5/26/2024
Request for Oral Hearing (optional) Due	6/5/2024

Important Trial and Briefing Instructions

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, matters in evidence, the manner and timing of taking testimony, 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). **Such briefs should utilize citations to the TTABVue record created during trial, to facilitate**

the Board's review of the evidence at final hearing. *See* TBMP § 801.03. 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).