



## American Intellectual Property Law Association

January 2, 2018

The Honorable Gerald F. Rogers  
Chief Administrative Trademark Judge  
United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

*Via email: [gerard.rogers@uspto.gov](mailto:gerard.rogers@uspto.gov)*

Re: AIPLA Comments to the current TTAB Standard Protective Order,  
effective June 24, 2016

Dear Judge Rogers,

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to provide comments on the current version of the USPTO's Standard Protective Order for use in TTAB opposition and cancellation proceedings.

AIPLA is a national bar association of approximately 13,500 members who are primarily practitioners engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping to establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

AIPLA commends the Office on its efforts periodically to review and improve its TTAB procedures. In response to the Office's request for comments on the current standard protective order, AIPLA offers the following comments and suggestions:

1. Overall comment about the Standard Protective Order. AIPLA members generally believe that the changes made to the Standard Protective Order in June of 2016 were positive and improved upon the prior version. In particular, making it clear that the standard order automatically applies to all proceedings was generally a positive step, but it does create potential challenges in those cases where one party is not represented by counsel. AIPLA also believes that the change from three to two tiers of designation was appropriate and makes it easier to administer the order and manage the confidential information produced and used in a TTAB proceeding. However, AIPLA believes that further consideration should be given to the treatment of in-house counsel's access to protected information. AIPLA has noted some ambiguities in the

current version of the order and suggests some additional changes to the content and procedures to improve the order's effectiveness.

2. Procedures to Implement the Standard Protective Order. Currently, the TTAB's initial Institution Order references the Standard Protective Order, provides a hyperlink to the language of the order, and states that it is automatically imposed in all *inter partes* proceedings. AIPLA suggests two modifications to further improve the effectiveness of the order. First, it would be beneficial if the standard order is actually entered on the case docket, with the case caption, as a separate entry in the docket. This is best accomplished upon the filing of the defendant's answer. Incorporating the order directly in the docket would give the order more prominence and clarity as an order that has been entered in the case and would make it easier for the parties to reference the order, as needed, instead of searching the website or clicking through the link in the Institution Order. AIPLA suggests that its entry as a separate document on the docket be triggered by the defendant's answer because the entry would not be needed in cases of a default or, most likely, if the defendant filed a successful motion to dismiss in lieu of an answer.

Second, AIPLA requests that the USPTO make a downloadable Word or RTF version of the Standard Protective Order available on the TTAB website. This would make it easier for the parties to modify the language of the order if they agree to do so.

3. Use of Protective Order with Parties Not Represented by Counsel. One challenge that has been identified with the TTAB's protective order is the administration of the order and production of confidential material in cases involving unrepresented parties. Because there is no attorney to receive the represented party's confidential materials/information, there is a greater likelihood that the unrepresented party will mishandle it. Indeed, AIPLA has received comments from some members that an unrepresented party should not be permitted access to any Confidential or AEO designated material. Although the represented party can insist on the parties executing the order so as to create a potential contract, as the Board suggests, the unrepresented party may refuse and/or any remedies for a violation may still be ineffectual, expensive to obtain, or both. In addition, the current protective order creates a dilemma for the represented party when designating its information in discovery. If the represented party designates information as Attorney's Eyes Only ("AEO") material, it can effectively deny the opposing unrepresented party access to its information. Otherwise, it risks revealing its most sensitive information to a potential, competitor, which could cause great damage. Neither option is tenable. In either case, additional motion practice is likely to be required to address the issues, increasing the overall expense of TTAB proceedings. There is no easy solution, and this dilemma further illustrates why it may be more appropriate to enter the protective order as a separate document directly in the case docket and to wait until after the answer is filed to do so. To the extent one party is unrepresented, that will then be known, and the Board can at least call special attention to the existence of the protective order and the

unrepresented party's obligation to adhere to it. Furthermore, in those cases where one party is unrepresented by counsel, the Board should consider whether it would be appropriate to (a) require the parties to execute the standard order or an acceptable substitute, (b) prohibit an unrepresented party's access to any designated material (Confidential and AEO information) unless it retains counsel or other terms and conditions are set to safeguard the information, and/or (c) require the participation of the interlocutory attorney during the discovery conference to ensure these issues are properly addressed to the best extent possible.

4. In-House Counsel's Access to AEO Information. The current version of the protective order creates a default rule that permits an in-house attorney to review protected information that is designated as Confidential but precludes access to AEO designated information. AIPLA recommends that, instead of creating a default position prohibiting in-house counsel's access to AEO information, the standard protective order should be revised to instead make the issue of in-house counsel's access to such information a mandatory item of discussion at the initial discovery conference. The parties should be encouraged to reach an agreement that is entered by stipulation. Alternatively, the standard order could include a check box with options allowing or not allowing access to AEO information by in-house counsel. In the alternative scenario, the parties would file the protective order with the agreed upon box checked. If, despite good faith efforts, no agreement can be reached by the parties, the Board should resolve the issue upon a motion filed by either party.

5. Disclosure of Protected Information to Experts and Consultants. AIPLA believes there is some ambiguity in Sections 3 and 5 of the Standard Protective Order regarding the disclosure of protected information to independent experts and consultants. Section 3 provides that Confidential information may be disclosed, subject to compliance with Section 4 (obtaining the acknowledgment certificate), while AEO information requires compliance with both Sections 4 and 5 (prior notification to the disclosing party). However, Section 5 states: "In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share *disclosed information* with an independent expert or consultant must also notify the party who designated the information as protected." (italics added) Although AIPLA believes that the prior notification requirement of Section 5 is intended to (and should) apply only to AEO designated information, the foregoing sentence from Section 5 can be read to require prior disclosure for each level of protected information. AIPLA suggests that Section 5 be revised to make it clear that prior notification is required only with respect to AEO designated information.

In addition, the order should clarify which party bears the burden of persuasion when a proposed disclosure to an expert or consultant has been objected to. AIPLA believes the burden of persuasion should lie with the party objecting to the disclosure of its AEO information to the expert or consultant, which is consistent with the burden of

persuasion on the designating party whenever a particular designation of protection is challenged.

6. Production of Documents. Section 7 of the Standard Protective Order provides that if the responding party makes its documents available for inspection and copying by the requesting party, those documents are “protected.” However, the level of protection is not specified. AIPLA recommends that the order be revised to state that the documents are to be protected as AEO documents during the inspection. Otherwise, a party or other person not suitable for receiving AEO level documents could participate in the inspection. By thus limiting the inspection, the Board adequately protects the producing party’s documents until such time as the requesting party has selected documents for copying and the producing party can evaluate and properly designate those documents selected.

7. Depositions. During a deposition, the Standard Protective Order requires the interested party to make an oral note on the record whenever there is a discussion involving non-documentary protected information. However, it also states that the deposition transcript is “protected” for 30 days from service to give each party the opportunity to designate portions of the transcript, as needed. This creates some ambiguity as to whether a party who failed to make an oral note regarding protected information during the time of testimony can later designate that testimony during the 30-day period. Also, the level of protection for the transcript during the 30-day period is not specified. AIPLA suggests that the order be revised to delete the requirement that an oral note be made on the record during the deposition and/or to make clear that the failure to make an oral note of protection during the testimony does not waive a party’s right to designate the testimony for protection during the 30-day review period. AIPLA also suggests that the order be revised to clarify whether the transcript should be treated as Confidential or AEO during this 30-day period.

Thank you for considering AIPLA’s suggestions.

Sincerely,

A handwritten signature in black ink that reads "Myra H. McCormack". The signature is written in a cursive, flowing style.

Myra H. McCormack  
President  
American Intellectual Property Law Association