

# AIPLA

## American Intellectual Property Law Association

March 29, 2019

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
ATTN: Jennifer Cook

Re: Comments of the AIPLA to the current Standard Protective Order

Dear Ms. Cook,

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 Trademark Trial and Appeals Board (TTAB) opposition and cancellation proceedings. In particular, this is to respond to the questions posed by the Board regarding access by in-house counsel to "Confidential – For Attorneys' Eyes Only" (AEO) material.

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.

The primary issue raised in the USPTO's request for comments is whether the default version of the protective order's treatment of higher-level, "attorney eyes only" confidential information should continue to limit the information to outside counsel. AIPLA believes that whether it is appropriate for in-house counsel to have access to AEO information and documents should be a case-by-case determination, considering a variety of factors, including whether that counsel is in a competitive decision-making position, whether the parties are competitors, whether both parties have in-house counsel, the preference of individual clients, and the issues that may be relevant to the particular matter. Because of the inherent difficulty of clawing back information that has already been disclosed, AIPLA believes that the default rule should be to deny in-house counsel access to AEO information but provide a transparent mechanism for a party to request such access when appropriate.

In addition, AIPLA recommends, as it has in past comments, that the issue of in-house counsel's access to AEO information be a mandatory item of discussion at the initial discovery conference.

AIPLA's answers to the particular questions posed by the TTAB are below:

1. *Please describe the entity or individual submitting the comments (i.e., a law firm, a private practice attorney, a corporation or other business entity, in-house counsel, a trade association, a legal or policy association, professor/academia, other).*

**ANSWER: The American Intellectual Property Law Association (AIPLA), a national bar association.**

2. *The SPO currently provides for the protection of information and documents designated as (1) Confidential or (2) Confidential – For Attorneys' Eyes Only (trade secret/ commercially sensitive) (AEO). Under the SPO, AEO material is only available for review by outside counsel, not in-house counsel. Absent agreement by the parties or Board order, in-house counsel currently cannot access AEO information and documents. Should the SPO be amended so that the default is to allow for in-house counsel access to AEO information and documents? YES or NO, and please explain the reason for your response.*

**ANSWER: No, the default should not be so changed. It is not always appropriate for in-house counsel to have access to AEO information. An analysis should be done on a case-by-case basis.**

3. *If your answer to question 2 is yes, should it matter if the in-house counsel is domestic or foreign? Please explain.*

**ANSWER: Although our answer to Question No. 2 would maintain the default prohibition on sharing AEO Information with in-house counsel, we note that any analysis should consider whether in-house counsel are domestic or foreign, because only US counsel are subject to licensure discipline for violating a protective order, and there may be other jurisdictional challenges to enforcing a protective order outside of the United States.**

4. *When a party requests that in-house counsel be entitled to access AEO information in a particular case, the TTAB currently relies on the test set forth in Akzo N.V. v. U.S. Int'l Trade Commission, 808 F.2d 1471, 1484, 1 USPQ2d 1241 (Fed. Cir. 1986) to make that determination. The factors to be balanced are:*

- (1) Whether the party seeking to gain access to AEO information for in-house counsel has "need for the confidential information sought in order to adequately prepare its case."*
- (2) Any showing of "harm that disclosure would cause the party submitting the information."*
- (3) The forum's interest in maintaining the confidentiality of the information sought."*

*Do you believe that this test is still appropriate for assessing in-house counsel access to AEO information? YES or NO, and please explain the reason for your response.*

**ANSWER: Yes, AIPLA believes that this test is still appropriate for assessing the propriety of in-house counsel access to AEO information. The test could be modified to address more explicitly whether the in-house counsel is in a competitive decision-making position, but the case law applying the standard does address that issue.**

5. *If your answer to question 2 is no, and you do not think the SPO should be amended so that the default is to allow for in-house counsel access to AEO material, should the SPO instead be amended to incorporate the Akzo test described in question 4. YES or NO, and please explain the reason for your response.*

**ANSWER: AIPLA does not oppose amending the Standard Protective Order to incorporate the Akzo test.**

6. *In addition to the issue of access to AEO material, the USPTO is interested in comments on the SPO's levels of confidentiality for protected information and documents. The previous version of the SPO included three levels: Confidential, Highly Confidential, and Trade Secret/Commercially Sensitive, with a presumption that in-house counsel would not have access to information or documents in the last category. Should the current SPO be amended to re-introduce the "Highly Confidential" tier? Please explain.*

**ANSWER: AIPLA recommends that the Board maintain only the current two tiers of confidentiality. AIPLA advises against introducing a third tier for "Highly Confidential" information, which would unnecessarily complicate the issues of confidentiality protection and allowable disclosures.**

Thank you in advance for considering AIPLA's suggestions.

Sincerely,



Sheldon H. Klein  
President  
American Intellectual Property Law Association