December 17, 2015

The Hon. Mary Boney Denison  
Commissioner for Trademarks  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA  22313-1451

Re: Comments Concerning the Proposed Changes to the TTAB Standard Protective Order

Dear Commissioner Denison:

I write on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) in response to the United States Patent and Trademark Office’s request for comments concerning the proposed changes to the Standard Protective Order of the Trademark Trial and Appeal Board (“TTAB”).

The American Bar Association is the largest voluntary professional association in the world and its Intellectual Property Law Section is the largest intellectual property association with approximately 20,000 members. The views expressed in this letter are presented on behalf of the Section. These comments have not been approved by the House of Delegates or Board of Governors of the American Bar Association and should not be considered views of the American Bar Association.

The Section appreciates the Office’s invitation to provide feedback on the proposed revisions to the Standard Protective Order and is pleased that the TTAB has taken the initiative to update the order. The Section supports the Office’s revisions to the Standard Protective Order as an overall improvement to the order and takes this opportunity to provide further feedback for consideration in the revision process.
Part 3: Access to Protected Information

“Highly Confidential” Category

Members of the Section have expressed support both for and against the removal of the “highly confidential” category. Some members see it as unnecessary and confusing while others have expressed concern about its removal on the ground that it is a necessary tool to protect materials that fall between the scope of “confidential” and “trade secret/commercially sensitive.” The overall consensus is that a need to share certain materials with in-house counsel is not uncommon.

The Section encourages the TTAB to consider whether this need can be satisfied through retention of the “highly confidential” category or within a separate section of the order that examines access to privileged documents by both in-house and outside counsel in appropriate circumstances. Addressing this issue within the Standard Protective Order would further encourage its use and not unduly burden parties who otherwise would need to modify the order. In the alternative, the Section encourages the TTAB to consider motions to amend the Standard Protective Order to allow, in appropriate circumstances, documents to be shared with in-house counsel and outside counsel, but not the parties.

Definition of Independent Experts or Consultants

The Section proposes the following modification (in italics) to the definition of independent experts or consultants:

“Independent experts or consultants include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not current or former employees, officers, members, directors, or partners of any party, affiliates of any party, or the attorneys of any party or its affiliates, or competitors to any party, or employees or consultants of such competitors with respect to the subject matter of the proceeding.”

The additional language further clarifies who would be prohibited from serving as an independent expert or consultant, thereby decreasing the risk of a conflict of interest.

Part 5: Disclosure to Independent Experts or Consultants

The Standard Protective Order provides a method for objecting to the disclosure of privileged information to potential independent experts or consultants by disclosing the identity of the potential expert or consultant prior to releasing privileged information. During the Section’s review of the Standard Protective Order, two schools of thought emerged. The first is that disclosure of potential experts and consultants is privileged work product and should not be required. The second is that disclosure is necessary to the effective enforcement of the Standard Protective Order, and that without disclosure there is no opportunity to object to the disclosure of privileged information to persons who may be employed by competitors.
To address these concerns, the Section encourages the TTAB to require disclosure of potential experts and consultants only prior to releasing “trade secret/attorneys eyes only” information. The purpose of the disclosure requirement is to protect very sensitive information from someone who has too close an affiliation with an opposing party. Sensitive information generally pertains to trade secret-level information. In contrast, documents marked “confidential” are generally not competitively sensitive, minimizing concern of disclosure to an unknown consultant. The proposed revision would allow counsel to utilize non-testifying experts to run pilot surveys and provide preliminary analysis without fear of disclosing too much of their litigation strategy.

**Part 17: Other Rights of the Parties and Attorneys**

Like the current order, the proposed revised Standard Protective Order acknowledges the ability of parties to advance claims of privilege at trial and otherwise to pursue “additional protections not provided by this Order.” Although it favors the retention of this language, the Section believes that the potential remedies for the inadvertent disclosure of information and documents protected by the attorney-client privilege should not be limited to those that depend on the TTAB’s intervention. Accordingly, the Section encourages the TTAB to incorporate into the Standard Protective Order a mechanism allowing a party making such an inadvertent disclosure to “claw-back” the privileged material in question through a notice to the nondisclosing party and without the need for potentially time-consuming motion practice.

**General Comments**

**Signature**

The Section recommends that signing the Standard Protective Order be voluntary and not compulsory.

**TBMP Language**

The Section encourages the use of stronger language in the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) to confirm that withholding documents solely on the ground of confidentiality, unless otherwise justified, is a violation of the rules:

> “Given the automatic operation of the Board’s standard protective order, any refusal or delay by a party in providing information or documents on ground that they are confidential violates the Board’s discovery rules and shall be sufficient grounds for filing a motion to compel.”

It would likewise be helpful for the TBMP to enumerate clear grounds for a motion to compel and/or sanctions for withholding documents on the grounds of confidentiality, including estoppel from relying on the withheld documents at trial.
Conclusion

The Section favors in principle the revised TTAB Standard Protective Order as an overall improvement to the current order, and appreciates the opportunity to contribute to the process. If you have any questions or would like to discuss any of these comments, please feel free to contact me. Either I or another member of the leadership of the Section will gladly respond to any inquiry.

Very truly yours,

Theodore H. Davis Jr.
Section Chair
American Bar Association
Section of Intellectual Property Law