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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194774
Party	Plaintiff BN Immunotherapeutics, Inc.
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Attachments	Motion for Protective Order and Stay.pdf ( 13 pages )(39543 bytes ) Exhibit A - Emails between Jennings and Pennington.pdf ( 4 pages )(39721 bytes ) Exhibit B - Emails between Jennings and Pennington.pdf ( 3 pages )(21596 bytes ) Exhibit C - Emails between Jennings and Phelan.pdf ( 3 pages )(23530 bytes ) Exhibit D - Therasense v. Becton.pdf ( 5 pages )(399892 bytes ) Rasmussen Declaration.pdf ( 21 pages )(1345197 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

BN Immunotherapeutics, Inc.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91194774
v.	)	
	)	Serial No. 79/048,489
AmVac AG Corporation,	)	
	)	
Applicant.	)	

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**INTRODUCTION**

In this motion, the opposer, Bavarian Nordic Immunotherapeutics, Inc. (“BNIT”), a member of Bavarian Nordic Group, moves for entry of a protective order to allow pre-trial discovery to proceed while protecting the confidential business information of both parties from disclosure. Both sides in this case agree that a protective order is appropriate. Both sides agree on most of the relevant provisions. The parties, however, have been unable to reach agreement on one of the key issues—whether Bavarian Nordic Group’s in-house counsel should have access to the most highly confidential discovery materials.

In summary, the key issue is whether Li Westerlund, Bavarian Nordic Group’s Vice President for Global IP, should have access to the most highly confidential material to allow her active involvement and representation of the Bavarian Nordic Group in this matter directly pertaining to its intellectual property rights. As this memorandum shows, Dr. Westerlund has no role in making the kind of competitive business decisions that justify excluding counsel—whether in-house counsel or an outside law firm—from access to discovery material.

For the reasons that follow, BNIT respectfully requests that the Trademark Trial and Appeal Board issue the protective order in the form it has proposed.

## **BACKGROUND**

### A. Procedural Posture.

BN ImmunoTherapeutics (BNIT) is developing active immunotherapies for the treatment of cancer. Its lead product PROSTVAC is a therapeutic vaccine for the treatment of prostate cancer that is being prepared for entry into phase 3 clinical trials. The pipeline has additional clinical development stage candidates, such as the breast cancer therapeutic vaccine MVA-BN-HER2. BNIT is a member of the Bavarian Nordic Group, which is a leading industrial biotechnology company developing and producing novel vaccines for the treatment and prevention of life-threatening diseases with a large unmet medical need. The Group's business strategy is focused in three areas: biodefense, cancer and infectious diseases. Bavarian Nordic was founded in 1994 and has been listed on the Copenhagen Stock Exchange since 1998. The cancer vaccine business, with research and development headquartered at BNIT in California, is an important strategic area for the Group. With operations in Denmark, Germany, the USA, and Singapore, Bavarian Nordic employs over 400 people.

AmVac AG (“AmVac”) is a biopharmaceutical company with a strategic focus on the development and subsequent commercialization of innovative immune therapies and prophylactic vaccines. The head office of the company is in Zug, Switzerland. Creating new therapies for the indication areas gynecology, urology and respiratory diseases are at the core of AmVac’s strategy. AmVac was founded in 2005. According to its website, the primary goal of AmVac’s strategy is to become a fully integrated biopharmaceutical company creating medical and commercial value on a sustainable basis. Depending on the indication and market involved, AmVac aims to develop and market its products either alone or, if necessary, with qualified partners.

BNIT has opposed AmVac's United States Trademark Application Serial No. 79/048,489 (for "PROSTAVAC") based on prior use, as laid out in BNIT's Notice of Opposition, entered May 3, 2010.

B. Negotiation of the Protective Order.

Very early on in the opposition, the parties' agreed to abide by the Trademark Trial and Appeal Board's standard protective order (found at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>). The Board's standard protective order allows in-house counsel to view all materials except those marked "highly confidential, attorneys' eyes only."

On November 12, 2010, BNIT first inquired as to whether AmVac would consent to allowing Dr. Westerlund to view "highly confidential, attorneys' eyes only" documents. *See* Exhibit A at 2 (November 12, 2010 email from Mr. Pennington to Mr. Jennings). AmVac did not respond until January 11, 2010. *See id.* at 1. BNIT renewed its request on February 6, 2011. *See* Exhibit B (February 6, 2011 email from Mr. Pennington to Mr. Jennings). AmVac replied on February 7, 2011 without giving a definite response to BNIT's request regarding either the protective order issue or its request that discovery be stayed while the protective order issue was decided. *See id.* BNIT again inquired as to whether AmVac had a final response to the request to add Dr. Westerlund to the protective order or, in the alternative, to stay discovery while this motion was pending. *See* Exhibit C at 2 (February 16, 2011 email from Mr. Phelan to Mr. Jennings). Despite BNIT's requests for clarification, AmVac has not responded definitively to any of BNIT's inquires about its position, instead urging BNIT to file the instant motion. *See id.* at 1.

C. Dr. Westerlund's Role At Bavarian Nordic.

Dr. Westerlund was hired by Bavarian Nordic, A/S, the parent company of BNIT, in

2004 as Director of Intellectual Property Rights. (Declaration of Rasmussen in Support of BNIT's Motion for Protective Order ("Rasmussen Decl.") ¶ 3). In October 2007, her title changed to Vice President for Global Intellectual Property. (*Id.*). Since joining the company, she has been responsible for legal enforcement or defense of Bavarian Nordic Group's intellectual property assets. (*Id.*). Dr. Westerlund is admitted to practice law in California and the District of Columbia. (Rasmussen Decl. ¶ 6).

Dr. Westerlund is in charge of Bavarian Nordic Group's Global IP. The Transactions and Legal Department, located in Kvistgard, Denmark, directly handles licensing agreements and negotiations and is a separate and distinct department from Global IP. (Rasmussen Decl. ¶ 4). The Global IP Department was deliberately set up separately from the Legal and Transactional Department. Specifically, this separation was put in place to ensure the independence for Dr. Westerlund that would allow her active and direct representation in any matter involving enforcement and defense of Bavarian Nordic Group's intellectual property.

The Bavarian Nordic Group has a management team that consists of four executives: the President and CEO of Bavarian Nordic A/S, the parent company, the Executive Vice President and Division President Infectious Disease, the Executive Vice president and Division President Cancer Vaccines and the Executive Vice President and Chief Financial Officer. (Rasmussen Decl. ¶ 2 & Ex. 1). Key decisions at Bavarian Nordic Group are not made by Dr. Westerlund, but rather by the management team, or in some cases the Board of Directors. (Rasmussen Decl. ¶ 7). Key decisions at BNIT are not made by Dr. Westerlund, but rather by its CEO and President, also a member of the Group's management team. (*Id.*). These include decisions about the direction of the company's R&D efforts; employment decisions regarding top-level managers and scientists; decisions about the significant commercial aspects of the business such as pricing,

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