

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

Impossible Foods Inc. v. Impossible X LLC, et al.

Impossible Foods Inc. v. Impossible X LLC, No. 21-cv-02419-BLF (SVK) (N.D. Cal. June 30, 2025) · No. 21-cv-02419-BLF (SVK) · Decided June 30, 2025

SUMMARY

The court conducted an in camera review of attorney-client communications concerning trademark statements of use submitted to the USPTO. It found a prima facie case that Defendants committed fraud on the PTO regarding their 2018 Statements of Use and held that one email, identified as Tab 6 (INT_IMP_00011214), fell within the crime-fraud exception. The court ordered production of that document.

CASE DETAILS

COURT	United States District Court for the Northern District of California
WRITING FOR THE COURT	Susan Van Keulen
JURISDICTION	United States District Court for the Northern District of California
DECIDED	June 30, 2025
DOCKET	21-cv-02419-BLF (SVK)
DISPOSITION	other
PROCEDURAL POSTURE	Plaintiff sought in camera review of attorney-client communications under the crime-fraud exception to determine whether the communications should be produced in discovery.
STANDARD OF REVIEW	For purposes of applying the crime-fraud exception, the court determined whether Plaintiff established a prima facie case of fraud on the PTO and whether the specific communications were sufficiently related to and made in furtherance of the alleged fraud. The ultimate fraud-on-the-PTO merits issue requires clear and convincing evidence, but the threshold determination for the privilege issue required only a prima facie showing.
PRECEDENTIAL VALUE	unpublished district court opinion; precedential status unknown

TOPICS

- trademark law
- discovery dispute
- attorney client privilege
- evidence
- civil procedure

PRACTICE AREAS

trademark

discovery

evidence

civil procedure

commercial litigation

QUESTIONS PRESENTED

1. Whether Plaintiff established a prima facie case that Defendants committed fraud on the PTO in connection with the 2018 statements of use.
2. Whether the attorney-client communications submitted for in camera review were sufficiently related to and made in furtherance of the alleged fraud so that the crime-fraud exception defeated privilege.
3. Whether the court should order production of communications concerning the 2024 trademark submissions.

HOLDINGS

1. Plaintiff established a prima facie case that Defendants made false, material representations regarding use of the marks, knew or believed the representations were false, intended the PTO to rely on them, and caused presumed injury sufficient for the crime-fraud privilege analysis.
2. Tab 6 was not protected by the attorney-client privilege because it was sufficiently related to and made in furtherance of the alleged fraud concerning the 2018 statements of use.
3. The court did not decide whether Defendants committed fraud in connection with the 2024 submissions because the communications potentially implicated by the crime-fraud exception concerned only the 2018 statements of use.

KEY QUOTATIONS

“To invoke the crime-fraud exception, a party must satisfy a two-part test:” (at 2)

“Of the documents which the Court has examined, only one document appears to be “sufficiently related to” the fraud and made “in furtherance of” the intended fraud, i.e., the submission of the false 2018 Statements of Use.” (at 6)

“Accordingly, the Court orders production of Tab 6 only.” (at 7)

FACTUAL BACKGROUND

Impossible Foods alleged that Impossible X LLC and Joel Runyon submitted false sworn statements of use to the PTO for several IMPOSSIBLE-related marks, representing that the marks were used with various apparel categories. Defendants admitted that the marks were not being used with every listed category, and Runyon testified that the company had never sold pants or yoga pants. After reviewing the relevant materials and deposition testimony, the court found a prima facie case that the 2018 statements of use were fraudulent and that one email chain concerning those statements was sufficiently related to and in furtherance of the alleged fraud.

PROCEDURAL HISTORY

Impossible Foods filed a discovery statement seeking in camera review of emails between Joel Runyon and his trademark-prosecution counsel. After initially denying the request, the court granted in camera review upon

finding that Plaintiff had made the threshold showing required under Zolin. Following review of the submitted communications, the court ordered production of one document, Tab 6, and denied production of the remaining communications.

DISPOSITION

other

CASES CITED

- In re Grand Jury Investigation, 810 F.3d 1110, 1113-14 (9th Cir. 2016)
- In re Napster, Inc. Copyright Litig., 479 F.3d 1078, 1090, 1094-95 (9th Cir. 2007)
- Mohawk Indus. v. Carpenter, 558 U.S. 100 (2009)
- Starsight Telecast, Inc. v. Gemstar Dev. Corp., 158 F.R.D. 650, 655-56 (N.D. Cal. 1994)
- Adidas, 2018 WL 4600291, at *1 (D. Or. Sept. 25, 2018)
- In re Bose Corp., 580 F.3d 1240, 1242-43, 1246 (Fed. Cir. 2009)
- OTR Wheel Eng'g, Inc. v. W. Worldwide Servs., Inc., 897 F.3d 1008, 1019-20 (9th Cir. 2018)
- Teeter-Totter, LLC v. Palm Bay Int'l, Inc., 344 F. Supp. 3d 1100, 1109 (N.D. Cal. 2018)