

March 15, 2006

**Via E-Mail**

Gerard F. Rogers, Esq.  
Trademark Administrative Judge  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**Re: Comments to the Miscellaneous Changes To The Trademark  
Trial And Appeal Board Rules**

Dear Mr. Rogers:

At Dickinson Wright we have five (5) attorneys who specialize in trademark counseling and litigation, including practice before the Trademark Trial and Appeal Board. We have reviewed the proposed rules changes and have the following comments.

1. Proposed Rule 2.119(b)(6)

Proposed Rule 2.119(b)(6) provides that documents may be served by electronic transmission when mutually agreed upon by the parties. Since electronic transmission is not referenced in Rule 2.119(c), we assume that no additional time will be added to the prescribed period for responding or taking action.

2. Proposed Rule 2.120(e)(2) and (h)(2)

Proposed Rule 2.120(e)(2) provides that when a party files a motion to compel disclosure or discovery, the case will be suspended by the Board. In our opinion, the Board should not suspend proceedings pending the disposition of a motion to compel. Discovery should proceed. The parties have six month to conduct discovery. If the failure to disclose prejudices the moving party, the moving party may file a motion for an extension of discovery based on the nonmoving party's failure to meet its discovery obligations. A blanket suspension merely serves to delay the proceedings.

Proposed Rule 2.120(e)(2) provides that the filing of a motion to compel will not toll the time for a party to comply with any disclosure requirement or response to outstanding discovery requests or to appear for any noticed discovery deposition. Proceedings are not suspended until the Board issues an order suspending proceedings. TBMP §523.01. That section of the TBMP also provides that the filing of a motion to compel nor the resulting suspension tolls the time for the parties to respond

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to discovery served prior to the filing of the motion to compel. Thus, the Board practice does not follow the letter of the Rule. A strict reading of the rule permits a party to file discovery prior to the suspension order and requires the other party to respond. The Board should amend the rule to provide that the filing of a motion to compel automatically suspends proceedings with the exception that it does not toll the time for the parties to respond to any discovery served prior to the filing date of the motion to compel.

Thank you for considering these comments.

Very truly yours,



Marc A. Bergsman

MAB/MAB

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