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March 10, 2006

E-MAIL TO: AB56Comments@uspto.gov
CONFIRMATION VIA MAIL

ORAL HEARING REQUESTED

TTAB
P.O. Box 1451
Alexandria, VA 22313

Re: Opposition to proposed miscellaneous changes to Trademark Trial and Appeal Board Rules (docket number 2003-T-009 published in the Federal Register Volume 71, No. 10, January 17, 2006)

Dear Sirs:

SUMMARY

As a trademark owner and small business proprietor, I am strongly **opposed** to these proposed rule changes. I believe the proposed changes will be bad for trademark owners as a group, are contrary to the harmonization of our intellectual property laws with those of other nations, and will have a dramatic chilling effect on those considering using the statutorily granted rights to opposition and cancellation proceedings contained in the Lanham Act.

BACKGROUND

I am a trademark owner with two federal trademark registrations, for the marks WYNDE HILL® and STEELHENGGE® both currently registered with the United States Patent and Trademark Office. These trademarks are two of the most valuable and important assets my small business owns. The selection, use, and registration of these marks were the result of careful thought on my part and a decision to invest scarce funds by protecting these marks through federal registration. The right to do so is granted to me under the Lanham Act. I am also a trademark practitioner and an attorney having been admitted to practice law in 1981. I have represented numerous clients in several hundred opposition and cancellation proceedings over the years. I also have significant experience in district court proceedings. I write in my individual capacity.

I believe that trademark opposition and cancellation proceedings should provide interested parties a relatively streamlined and cost effective mechanism for resolving trademark registration issues. Such proceedings should have a relatively short timeline, should

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encourage negotiation and settlement of such disputes and should produce fair and relatively predictable results. Although the current system leaves much to be desired, principally because the Trademark Trial and Appeal Board is slow to process papers, produces results that are generally not citable as precedent, and is hesitant to ever grant summary judgment, the proposed rules do not address any of these shortcomings in a meaningful or material way. The proposed rules put substantial burdens on trademark owners such that the difference between a proceeding conducted under these proposed rules and district court litigation will be insignificant. I believe trademark owners contemplating the decision between proceeding in federal court and proceeding in front of the Trademark Trial and Appeal Board will be much more likely to opt for district court litigation. The differences in cost and procedure will be minor, while the district court offers significantly more relief since legal fees, damages, and injunctions are available there. The result of this will be to rob trademark owners of the intended streamlined, prompt, and cost effective mechanism for resolving the issue of obtaining or maintaining a federal trademark registration.

SPECIFIC COMMENTS

Commencement of Proceedings

I believe the proposed rule of requiring an opposer or petitioner to directly serve the initial pleading on the other side is a bad idea. As a trademark owner I do not have the resources to determine the actual current address of an applicant or registrant who may be located anywhere in the world. Although the online resources of the Patent and Trademark Office provide addresses for filing correspondents and applicants, at the time of filing I believe the records are badly out of date for registrants. I also believe that the records of the United States Patent and Trademark Office generally do not accommodate the format of the address of many international trademark owners such that accurate and complete postal addresses are even available within the records of the Patent and Trademark Office.

Adoption of disclosure

I believe the proposed rules for instituting a deadline for making voluntary initial disclosures, expert disclosures, and pretrial disclosures are all detrimental to trademark owners. In particular, the proposed rule concerning the amount of material to be voluntarily disclosed far exceeds the corresponding federal court rule, will require substantial involvement with outside counsel to review documents and produce large volumes of material which will be burdensome and expensive for small companies and companies with large portfolios of trademarks. The expert disclosure rule will force trademark owners to retain experts early in the proceeding or, if they choose not to retain experts until just before the testimony period, the proposed rule will accomplish nothing. The requirement to disclose witnesses and exhibits in the pretrial phase does not recognize that there is a significant difference between current Board rules and district court

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litigation. For example, in the current TTAB practice there is a 30-day period between the plaintiff's testimony period closing and the defendant's testimony period opening. This allows the defendant to obtain opposing expert testimony and to rebut the opinions of the other party's expert. This opportunity is not present in district court litigation and the rule is a solution to a nonexistent problem.

Harmonization

The proposed rules are contrary to the trend toward harmonization of our laws with those in other countries. Presently, opposition proceedings in the United States are among the most expensive, time consuming, and contentious proceedings for trademark oppositions and cancellations anywhere in the world. The proposed rules make this problem greater and will greatly increase the expense, inconvenience, and burden on trademark owners and applicants. The opposition and cancellation proceedings in most other countries are far more streamlined, less expensive and less invasive into the private business affairs of the parties. The proposed rules are contrary to harmonizing our laws with those of other countries. As you know, most countries do not have a procedure for discovery in oppositions and cancellations, and voluntary disclosure is alien to foreign trademark owners. I believe few, if any, foreign owners would file oppositions or cancellations if they knew that they were required to disclose the information contained in the proposed rule.

A public hearing is required and hereby requested

I understand that the proposed rule making process in this instance does not include an oral hearing and testimony on the proposed rules. I hereby request that an oral hearing be granted and that I be given notice of the hearing and a reasonable opportunity to attend and testify to present my opposition to these rules. I believe the rules are sweeping, provide significant changes to the nature of opposition and cancellation proceedings, and will substantially and adversely impact trademark owners, the users of the trademark system in this country. Such dramatic changes require an oral hearing.

CONCLUSION

TTAB proceedings should be significantly different than district court litigation. These proposals position the two types of proceedings closer together, minimizing and trivializing the difference. These proposals move the TTAB in exactly the wrong direction. The proposals should be abandoned in total.

Respectfully submitted,

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Attorney at law and trademark owner