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March 20, 2006

REVISED
VIA E-MAIL – ab56comments@uspto.gov
CONFIRMATION VIA U.S. MAIL

Trademark Trial and Appeal Board
Attn: Gerald F. Rogers
P.O. Box 1451
Alexandria, VA 22313-1451

**Re: Proposed Changes to Trademark Trial and Appeal Board Rules
Published in the Federal Register Volume 71, No. 10 on January 17,
2006 (Docket Number 2003-T-009)**

Dear Mr. Rogers:

We hereby submit the following comments in response to the above referenced Notice of Proposed Rule Making (“Proposed Rules”). While we share the goal of increasing the efficiency of Trademark Trial and Appeal Board (“TTAB”) proceedings, we are concerned that some of the more important provisions of the Proposed Rules do not advance that goal and, if implemented, would impose substantial and unwarranted burdens on the operation of the process that are not present in the current procedure.

We are particularly concerned with the Proposed Rules seeking to implement certain new disclosure requirements including, most importantly, one new rule that would require the parties to make significant initial disclosures before discovery. As understood, this Proposed Rule would require extensive disclosure of a wide variety of information, including confidential information, at a very early stage of the proceeding. We are of the opinion this extensive early disclosure is unwarranted and will prove to be unnecessarily costly and burdensome within the context of a typical Trademark Office proceeding. We also believe these new disclosure requirements will result in prejudice to some participants and unfair advantage to others. For example, the owner of a well established and long standing trademark, seeking to oppose an application based on an intent to use the mark, will be required to quickly collect and present extensive information at great cost and effort before discovery even begins while the ITU applicant will be required to provide little or almost no information in return. Such a disparity is not only unfair but also could encourage abuse of the system.

For these and the other reasons stated herein, we do not believe the Proposed Rules should be adopted.

Our comments with respect to various provisions, in the order in which they were presented in the proposed Notice of Rule Making, are set forth below. For convenience, we will use the terms commonly used in an Opposition Proceeding in describing the effects of the Proposed Rules.

I. Commencement of Proceedings

The Proposed Rules would amend current practice by requiring Opposer to commence an Opposition Proceeding by filing a copy of the Notice of Opposition with the TTAB *and* serving a copy upon the Applicant. In our experience, the current procedure has proven to be remarkably efficient and does not require amendment. If the ESTTA System is used, the filing of a Notice with the TTAB and the service of that Notice by the TTAB often can be completed within one day. Information regarding the failure, if any, of the service of the Notice is returned directly to the TTAB, which can then take appropriate action without the intervention of Opposer. The interposition of the extra steps required under the Proposed Rules likely would decrease the efficiency of the current procedure.

Moreover, one of the stated reasons for the Proposed Rule – “that plaintiffs and defendants often are in contact prior to a plaintiffs filing of its complaint” – is simply not applicable in many cases. Even in those cases where there has been some pre-opposition communications, we have not found that the current process has ever jeopardized the “continuation of such direct communications” or the “procedural efficiency of the early stages of a proceeding” as suggested in the Proposed Rules.

Accordingly, we are of the opinion the current procedure for service of process is preferable to that set forth in the Proposed Rules.

II. Adoption of Disclosure and Related Issues

A. Early Disclosure

We have significant and serious concerns with the provision of the Proposed Rules pertaining to the adoption of mandatory disclosure requirements that purport to be similar to those set forth in Fed. R. Civ. P. 26(a)(1).

First, although the implementation of Fed. R. Civ. P. 26(a)(1) may have proven to be helpful in Federal civil actions, we question whether the imposition of an early disclosure requirement will be similarly helpful in Trademark Office proceeding because of the differences between the two types of proceedings both as a legal and practical matter. From a legal prospective these differences include the nature and scope of relief available, the degree to which

Morgan & Finnegan, L.L.P.

Trademark Trial and Appeal Board
March 20, 2006
Page 3

the Tribunal exercises control over discovery and the participating attorneys, the sanctions available to that Tribunal for failure to comply with discovery requests, the relevant issues to be considered in reaching a determination and the entire “trial” procedure.

From a practical perspective, it should be remembered Trademark Office proceedings are often viewed by the participants as a less expensive and less complex alternative to civil litigation and the “stakes” are often lower. One of the benefits of the Trademark Office proceedings is that the parties, for various legitimate reasons, may limit discovery to reduce the cost of the proceeding and the inconvenience to the participants. The imposition of extensive early disclosure requirements will destroy some of these traditional advantages of Trademark Office proceedings and is likely to increase the costs and complexity of a typical proceeding without expediting the proceeding or serving any other legitimate interest.

In addition, although the Proposed Rules indicate that the Initial Disclosures should be more “limited” than in civil actions, we believe the Proposed Rules, as described, would require *more* disclosure than would be required in a Federal Court proceeding involving the same two parties and the same two marks. As described in the Notice, the Proposed Rules would require extensive disclosure of information pertaining to virtually every issue that could conceivably be relevant to the determination of a trademark dispute. These include a list of at least fourteen different factors including information pertaining to the origin of the mark, past use of the mark and plans for future use, any use by third parties of the same mark, marketing methods, surveys or market research and prior litigation involving the mark. In our opinion, these requirements exceed, and very likely far exceed, the requirements that would be imposed upon trademark litigants in Federal Court.

As noted, the imposition of these mandatory disclosure requirements also could operate to impose significant prejudice on one party and convey unfair advantage on the other. For example, the owner of a well established trademark will be required to make significant disclosures dating back to the origins of the mark and extending into the future, including information that may be confidential or proprietary, that can only be collected through great effort and expense. The owner of an ITU application, on the other hand, would be required to expend little or virtually no corresponding effort or expense. Foreign parties, who are often not familiar with United States discovery proceedings and who probably will have to coordinate the collection and presentation of this information at a distance working through United States counsel, also could be prejudiced by the early disclosure requirements. It is submitted that any procedure that could impose this type of prejudice and burden unequally on the parties in the context of a Trademark Office proceeding not only is unfair but also could create a disincentive on the part of the party not subject to the burden to seek to settle the dispute on a fair basis at an early stage. It also could lead to other misuses of the initial disclosure process.

For all these reasons, we do not believe these types of initial disclosures should be required in Trademark Office proceedings.

B. Protective Order

Of related concern, is the apparent requirement that these initial disclosures (as well as subsequent disclosures) be subject to the TTAB's Standard Protective Order if the parties cannot otherwise agree. It is respectfully submitted there must be some mechanism set forth in the Rules by which a Trademark Owner can move for additional protection in appropriate circumstances in cases where the other party does not agree. Returning to the scenario discussed above, there may be little incentive for the owner of an ITU application to agree to any additional protective measures because the ITU applicant will have little or no confidential information to disclose whereas the established owner may have a great deal of highly sensitive information. Although Proposed Rule 2.120(f) appears to provide for bringing a motion for a different Protective Order, there is arguably inconsistent language in the discussion section of the Proposed Rules and the grounds upon which said motion will be reviewed and the manner in which the Rule will be applied remains unclear.

C. Summary Judgment

The prohibition on summary judgment motions prior to Initial Disclosure would decrease the efficiency of the process in instances where the grounds for summary judgment are entirely unrelated to the disclosures that the moving party would be required to make. A party would be at a considerable disadvantage if required to submit the extensive disclosure envisioned by the Proposed Rules before bringing a possibly dispositive summary judgment motion on grounds entirely unrelated to the information to be disclosed (*e.g.* fraud by the applicant). While there may be only a limited number of circumstances where this might occur, it would be prejudicial to the moving party and it would decrease the efficiency of the system not to permit summary judgment under those circumstances.

D. Expert Disclosures

Discovery pertaining to experts often is deferred, in Trademark Office proceedings as well as in civil actions, until the end of the proceeding. There are many valid reasons for doing so including the time it takes to select an expert and for that expert to prepare an opinion or to conduct a survey and related decisions as to how to use the opinion or survey. In some cases, such as those involving survey evidence, it is helpful to take discovery in order to prepare the survey. In addition, expert testimony is expensive and parties often defer a decision on using an expert until other options can be explored through discovery or the like. To our knowledge, this practice has not created any significant inefficiencies in the Trademark Office proceedings. The Proposed Rules, even with the provision allowing for after deadline retention, would require a significant advancement in the time in which the disclosure of experts traditionally would take place without any corresponding suggestion that it would increase efficiency of the proceeding or facilitate its resolution. It would however impose an additional burden upon the parties and possibly cause them to commit to incurring additional expense

which might not prove to be necessary. For these reasons, we do not believe that the Proposed Rule regarding expert disclosures should be adopted.

E. Pre-Trial Disclosures

For many of the same reasons as stated earlier, we are of the opinion that the imposition of the envisioned Pre-Trial disclosure, in the context of a Trademark Office proceeding, would only cause the parties to incur unnecessary effort and expense with no reason to expect that it will increase the efficiency of the proceeding or the fairness of the result.

III. Removal of Options to Make Submissions of CD-ROM

We have no comment on this provision and assume reconsideration will be given to the use of CD-ROMs as improvements in technology to make them more suitable for use in Trademark Office proceedings. We do not believe similar restrictions have been imposed by the Federal Courts.

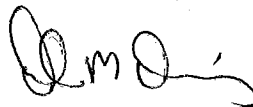
IV. Change to Rule on Briefing of Motions

In our opinion, the proposed requirement that the table of contents and related introductory information shall henceforth be counted as pages for the purposes of the page limits currently established is an unreasonable *de facto* page limit reduction that does not further the stated goal of increasing the efficiency of Trademark Office proceedings.

V. Conclusion

For the reasons stated above, we respectfully submit that the Proposed Rules do not further the stated purpose of increasing the efficiency of Trademark Office proceedings and often detract from that purpose or otherwise create significant and unwarranted burdens on the operation of the process that are not present in the current procedure. Accordingly, we believe the Proposed Rules should not be adopted. In the alternative, we respectfully submit that given the importance of these new Proposed Rules and the significant changes that would be implemented as a result of their adoption that further investigation including a full public hearing should be held prior to considering their adoption.

Very truly yours,



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