

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 AVENUE OF THE AMERICAS, NEW YORK, NEW YORK 10036-8403

TEL 212 382 0700 FAX 212 382 0888 FAX 212 398 0681

email@ostrolenk.com

PARTNERS	ASSOCIATES	OF COUNSEL	*DC BAR
SAMUEL H. WEINER	JOEL J. FELBER**	MARTIN PFEFFER	**CONNECTICUT BARS
ROBERT C. FABER	KOUROSH SALEHI**	LAWRENCE A. HOFFMAN	WASHINGTON OFFICE
MAX MOSKOWITZ	DOUGLAS Q. HAHN	MARTIN J. BERAN	1725 K STREET, N. W.
JAMES A. FINDER	GLEN R. FARBANISH	PAUL GRANDINETTI*	WASHINGTON, D.C. 20006
WILLIAM O. GRAY, III	MICHAEL I. MARKOWITZ	MARK A. FARLEY	TEL 202 457 7785
			FAX 202 429 8919

Writer's Direct Line
(212) 596-0522

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VIA FACSIMILE 571-273-0059

Gerald R. Rogers
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Proposed Amendment to the Trademark Rules

Dear Mr. Rogers:

I have reviewed the proposed amendment to TTAB Rules in inter partes proceedings. It is readily apparent that a great deal of time, effort and thought has been expended in preparing these proposed changes.

Certainly, the approach of having the opposer or cancellation petitioner serve the pleading directly upon counsel for applicant or registrant is realistic and will likely expedite the proceeding in its earliest stages.

However, I respectfully suggest that further consideration may be appropriate with respect to the issue of initial disclosures, for at least two reasons.

1. In any number of opposition proceedings the party seeking registration is either an ITU applicant, a 44(d) or 44(e) applicant or a use applicant with minimal use at the time that the application is filed. Whether or not the applicant defends the opposition proceeding vigorously or merely sits back in order to keep costs as low as the current income being generated from the mark in the United States, the opposer has the burden of proving its case and its initial stage of activity thereof would be expressed in the form of interrogatories and document requests. To

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place a further burden upon opposer to provide detailed initial disclosures in order to be given the right to serve discovery might well be tantamount to being a form of punishment for bringing the proceeding in the first place. If there is to be the concept of initial disclosures in Board proceedings, the disclosures required should be highly circumscribed to such matters as dates of use, the marks, the goods, the channels of trade and class of purchasers. Other issues such as the extent of use, surveys, other Board proceedings and the like should be left to discovery if the applicant cares enough about pursuing same, since it is likely that in a large number of proceedings the applicant will have little or no use of the mark and the burden of the applicant providing initial disclosure before taking discovery of opposer would be minimal as compared with the burden upon opposer which already has the overall obligation to put forth a credible case. Accordingly, if there is to be initial disclosure, a limitation on the subject matter thereof would help to level the playing field.

2. Separate and apart from my sense that broad initial disclosure requirements might not work substantial justice to opposers and cancellation petitioners in a number of instances, there is a practical issue which may require further consideration. The broader the initial disclosure requirement, the more likely that the opposer or petitioner may well fail the test and the applicant will move to delay a response to discovery on grounds that the complaining party has not complied with the rules. The Board may well be inundated with motions-some valid but some relatively frivolous-and this will create an even bigger backlog in work for the Trademark Trial and Appeal Board.

With respect to the proposed discovery conference, this would be infinitely more successful if a member of the Board were actively involved therein since it can be assumed that the proceeding was instituted and an Answer filed because the parties could not agree on an amicable disposition of the proceeding in the first place.

All in all, I urge you not to rush to judgment on finalizing these rules and, indeed, it may well be appropriate to hold a public hearing on this issue so that you can have the opportunity to receive full input from the Trademark Bar on this very important matter.

Respectfully,



Martin J. Beran
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: 212-382-0700

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