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Attention: Ellen J. Seeherman

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Comments of the Intellectual Property Law Section of the D.C. Bar

**To The
Proposed Rule Changes of the Trademark
Trial and Appeal Board**

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The views expressed herein represent only those of the Intellectual Property Law Section and not those of the D.C. Bar or of its Board of Governors. Steering Committee Member Hannah M. Fisher did not participate in the preparation, review or approval of these comments.

Comments of the Intellectual Property Law Section of the D.C. Bar

**To The
Proposed Rule Changes of the Trademark
Trial and Appeal Board**

The Intellectual Property Law Section of the D.C. Bar appreciates the opportunity to respond to the request for written comments regarding the proposed changes to the Trademark Trial and Appeal Board Rules published in the Federal Register on June 5, 1997, at Volume 62, No. 108, page 30802.

The Section supports the principal of simplifying Board practice and reversing the growth in the number of motions and the abuses of discovery procedures which have occurred in the recent past. However, we do not believe that these admirable goals will be achieved by unnecessarily increasing time constraints on litigants or reducing the flexibility of the Board to address the specific facts and circumstances of each case. Rigid rules are attractive because they are easily applied, but they do not serve the interest of justice on many occasions.

One of the most desirable aspects of practice before the Board is the opportunity to resolve disputes without recourse to litigation. For many years, this "alternative dispute resolution" function has been valued by practitioners and their clients who have avoided litigation and amicably resolved disputes for a few thousand dollars that might otherwise have cost hundreds of thousands of dollars to litigate.

With these thoughts in mind, we submit:

1. Rule 2.120(a): Although it is desirable that a party's first set of discovery requests should be served in a manner to allow responses before the close of the discovery period, follow-up interrogatories, document requests and requests for admission should not be similarly restricted. Follow-up discovery is generally served only after the receiving party has had an opportunity to review responses to its first discovery requests. Delays in receiving answers to discovery, the need to obtain clarification of discovery responses, and the time required to exchange documents will often make it impossible to prepare and serve follow-up written discovery so as to allow for responses within the 180 day discovery period. It is therefore suggested that the amendment be modified as follows: "*Each parties' initial* interrogatories, requests for production of documents and things, and requests for admission must be served in sufficient time that responses will fall due prior to the close of the discovery period."

2. Rule 2.120(a): Extending the discovery period only upon "stipulation of the parties" will both drive up the cost of Board proceedings and promote the practice of ambushing opponents through dilatory conduct and obstreperous tactics. This rule

change does not appear to support the objective of the Board to reduce discovery abuses and remove the advantage from the party with the most money to spend in pursuing a case. The Board should have discretion to allow extensions of the discovery period “in the interest of justice and for good and sufficient cause shown”, or a similar standard. Naturally, the Board will have discretion to interpret the new standard more narrowly than the present one.

3. Rule 2.120(a): Allowing extensions of time to respond to discovery only “upon stipulation of the parties, or upon motion showing extraordinary circumstances granted by the Board” is far too rigid considering the wide variety of circumstances that may arise in a Board proceeding. For example, a party located abroad that is not accustomed to U.S. discovery procedures or a large corporation with a number of offices may require additional time to fully respond to discovery. The Board’s proposed rule change will encourage parties hard-pressed for time to submit incomplete, overly cautious and objection-filled responses to discovery that will not advance the resolution of the action. Again, the Board should reserve to itself the ability to allow extensions “in the interest of justice and for good and sufficient cause shown”, or a similar standard. Again, the Board will have discretion to interpret the new standard more narrowly than the present one.

4. Rule 2.120(d) and (h): Limiting the number of interrogatories to 25, document production requests to 15, and requests for admission to 25 is far too restrictive and will compel litigants, no matter what their monetary means, to conduct discovery by deposition. The proposed rule will also favor foreign litigants, against whom discovery by deposition is not generally an alternative. One of the great economies achieved through the use of opposition and cancellation proceedings, as opposed to litigation, is the ability to secure sufficient information regarding an adverse party without the need to conduct a great number of expensive and time-consuming depositions. Obtaining information by written discovery facilitates settlement and makes Board proceedings economical for parties of limited means. The present system, under which parties are generally confined to 75 interrogatories, appears sufficiently restrictive in the context of Board proceedings. If parties were similarly limited to 75 document requests and 75 requests for admission such a system would be supported by the Section. It would also be useful for the Board to adopt a standard as to what constitutes a separate interrogatory or document request. For instance, discovery inquiries generally come with a section designated “instructions” which indicates, for example, that when a party identifies a person with knowledge regarding a subject the responding party must provide the person’s name, last known address, title and other information. Under the current and proposed rules, there is no guidance as to whether such an “instruction” constitutes more than one interrogatory (e.g. whether asking for a person’s name and address constitutes two interrogatories). Clarification of the Board’s rules in this regard would greatly aid in avoiding discovery disputes.

5. Rule 2.120(d) and (h): Prohibiting the filing of motions for leave to serve more than the allowed number of discovery requests gives a distinct advantage to foreign parties who may not be deposed and parties who have the financial means to conduct numerous depositions. Again, we encourage the Board to retain the ability to allow additional written discovery “in the interest of justice and for good and sufficient cause shown”, or some similar standard.

6. Rule 2.120(d) and (h): Mis-counting the number of interrogatories, document requests and requests for admissions served upon an adverse party should not place the requesting party in a position where it is foreclosed from obtaining any discovery. This problem might not arise as frequently if the Board retains its flexibility in allowing extensions of the discovery period and clarifies the definition of what will be deemed a “subpart” of a discovery request. (see Point 4, above).

7. Rule 2.121(a)(1) and (c): Requiring that testimony periods may only be reset upon a stipulation of the parties or a “showing of extraordinary circumstances” is far too rigid. Again, the Board should be permitted to reset testimony periods on motion “in the interest of justice and for good and sufficient cause shown”, or some similar standard.

8. Rule 2.127(a): Limiting the number of pages in dispositive motions to 25 is overly restrictive. Federal district courts have set significantly higher page limits on motions (e.g. the United States District Court for the District of Columbia has a 45 page limit [Local Rule 108(e)] and the District Court for Maryland has a 50 page limit [Local Rule 105(3)]. Appellate briefs are capped at 50 pages. Fed. R. App. P., Rule 28(f). Because of the more limited issues involved in many Board matters, we believe that a 40 page limit for dispositive motions would generally be adequate along with the Board’s suggested lower limit of 25 pages for procedural motions.

9. Rule 2.127(d): Failing to toll the discovery process as to the moving party where a motion for summary judgment has been filed will likely lead to abusive tactics by some non-moving parties. Most moving parties submit motions for summary disposition because they believe a claim or defense lacks merits and that additional discovery or other proceedings would waste the time and money of both parties and the Board. To subject the moving party to additional discovery obligations in a typical proceeding would defeat the entire basis for the summary judgment procedure. If a party requires discovery to respond to a motion for summary judgment, Rule 56(f), Fed. R. Civ. P., provides an adequate vehicle.

One factor not mentioned by the Board in its proposed rules is the time required for parties to obtain institution of Board proceedings and orders in relation to pending motions. If the Board wishes to limit the time periods in which oppositions and cancellations may be maintained, the Board could greatly speed the process by substantially reducing the amount of time it requires to institute proceedings and rule upon procedural and substantive motions, especially those motions that are uncontested.

It should be noted that the Section supports the Board's proposal to limit the number of briefs submitted in relation to motions pursuant to proposed Rule 2.127(a).

Thank you for the opportunity to present our comments. In the event that hearings are scheduled in this matter, the Section would enjoy the opportunity to participate.

Any questions regarding this submission should be directed to Paul F. Kilmer, GADSBY & HANNAH LLP, 1747 Pennsylvania Avenue, N.W., Washington, D.C. 20006; (202) 429-9600.