Charles N. Quinn
Direct Dial: (610) 458-4984
Email Address: cquinn@foxrothschild.com

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VIA ELECTRONIC MAIL TO: TTAB_settlement_comments@uspto.gov

Trademark Trial and Appeal Board
Attn: Karen Kuhlke
P.O. Box 1451
Alexandria, VA 22313-1451

Re: **Notice of Inquiry; 22 April 2011 Federal Register**

Dear Sirs:

This is submitted in response to the Notice of Inquiry in the 22 April 2011 issue of the Federal Register pursuant to which the United States Patent and Trademark Office sought comments from stakeholders about the extent to which Trademark Trial and Appeal Board personnel should become more directly involved in settlement discussions of parties to interparties proceedings.

I provide these comments as my own; the positions taken in this letter are not those of my Firm nor are they those of any other lawyer, partner or associate, in our Firm.

As regarding question one of whether the Board should be routinely involved in settlement discussions of parties or, instead, be involved only in particular cases on an "as needed" basis, I believe the Trademark Trial and Appeal Board should not be routinely involved in settlement discussions between the parties.

Trademark rights are commercial rights. As such, the papers filed with the Trademark Trial and Appeal Board and the picture received therefrom by personnel of the Trademark Trial and Appeal Board is really only the tip of the commercial iceberg. In my thirty-eight years of experience, in nearly every case there are commercial issues underlying the proceeding, of which Board personnel have little knowledge or appreciation. To make any meaningful contribution to settlement discussions of the parties, Board personnel would need in-depth knowledge of those issues and I do not think that is necessarily desirable or even feasible, given the workload of the Board.

Accordingly, I do not believe parties in general would benefit from involvement of a nonparty in settlement discussions in proceedings before the Trademark Trial and Appeal Board.

Respecting the issue of motions for summary judgment and whether those motions should be brought unless the parties have been involved in at least one detailed settlement conference, I see no need for this. Summary judgment motions are many times filed as procedural tools to elicit the opposing party's position on a given issue. The fact that the motion may be denied does not make the filing of such a motion an unnecessary or unethical act, and since such motions are clearly sanctioned under the Federal Rules of Civil Procedure, I do not think further restricting summary judgment motions, by requiring settlement discussions prior to the filing of a summary judgment motion, would be desirable.

As regard to the question as to whether parties should be restricted to only limited discovery until they have had a detailed settlement discussion with a Board judge, attorney or mediator, I do not agree with this idea. Discovery should proceed just as it does under the Federal Rules of Civil Procedure; there should not be any limitation on discovery by handcuffing the attorneys until they have had some detailed settlement discussion.

For a settlement discussion to be meaningful, it needs to be privileged and, unfortunately, it is difficult for many practitioners to segregate in their minds information received in the course of a settlement conference from information received legitimately through discovery and other means, and thereafter use only the second category of information in prosecuting the practitioner's case. Accordingly, I am opposed to any requirement that the parties be accorded only limited discovery until they have had a detailed settlement discussion in the presence of a third party.

I am against any amendment to the rules of the Board to require that a motion for summary judgment be filed before a plaintiff's pretrial disclosures are due. I see no point to that nor do I see any point to requiring the parties to engage in a settlement conference in conjunction with a discussion of the pretrial disclosures. If a case gets to the point of where the plaintiff has submitted or is submitting pretrial disclosures, if the case is going to be settled it will be settled by the parties acting on their own. I see no point to requiring a settlement conference at that point in the proceeding.

I hope that the foregoing is helpful and some extent illuminating regarding the issues raised by the Board in the April 22, 2011 Federal Register notice.

Respectfully submitted,

Charles N. Quinn
CNQ:dlr

Charles N. Quinn
Attorney at Law
Fox Rothschild LLP
Eagleview Corporate Center
747 Constitution Drive
Suite 100
Exton, PA 19341
610-458-4984
610-458-7337 (fax)
cquinn@foxrothschild.com
www.foxrothschild.com