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The United States Patent
and Trademark Office
Trademark Trial and Appeal Board

PTO-C-2011-0011

Attn: Honorable Karen Kuhlke

Re: PTO's Notice of Inquiry re TTAB's
Participation in Settlement Discussions

Dear Judge Kuhlke:

We have found useful the current Rule requirement that the parties discuss settlement during their discovery conference. These discussions have triggered negotiations ultimately leading to settlement in some of our contested proceedings, without the participation of an Administrative Trademark Judge (ATJ) or Board Interlocutory Attorney (IA).

We question whether the Board's active participation in settlement discussions would significantly increase settlements. Rather, we have some concern that the Board's participation may impede those open and frank discussions between counsel that can lead to productive negotiations.

We respond to the questions in the Notice of Inquiry in the order they were listed:

(1) The Board should become involved in settlement discussions only on an "as needed," not a routine, basis.

(2) The settlement discussions should be handled by an IA, not an ATJ. The use of outside mediators should not be required. If mediation is desired by both parties, they can readily arrange for it without the Board's participation.

(3) The Board should become involved in settlement discussions only if both parties request its participation by stipulation or other joint communication. Unilateral requests should not be granted. The Board's participation is more likely to be productive if both parties request it.

(4) The Rules should be amended to require that in addition to their discussion of settlement during the discovery conference, the parties must engage in a settlement discussion within 30 days after the close of discovery.

(5) Whether the IA, or, if applicable, other Board personnel, participating in the settlement discussions requested by both parties should be recused from working on the case should be left to the discretion of the IA or other Board personnel, subject to the right of either party to move for such recusal on a showing of good cause.

(6)&(8) The current Rule on the time for filing summary judgment motions need not be amended.

(7) The Board should continue its liberal policy of suspending proceedings in contested cases in view of ongoing settlement discussions. But the Rules should not be amended to limit discovery depending on the results of settlement discussions.

Reducing litigation costs is a much needed objective. We suggest, for the Board's future consideration, another type of cost-saving measure: i.e., permitting a party to introduce its testimony-in-chief through affidavits made on personal knowledge, setting forth such facts as would be admissible in evidence, and showing that affiant is competent to testify to such facts, subject to the right of the other party to (a) object or move to strike, e.g., on grounds of competency, relevancy or materiality, and (b) to depose and cross-examine each affiant on the content of his/her affidavit. This procedure has been used to some extent by the federal courts in non-jury cases.

Very truly yours,

Vito T. Giordano

V.T. Giordano

VTG:rf