

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: December 5, 2008

Opposition No. 91186698

Gen-Probe Incorporated

v.

Aptima, Inc.

**Robert H. Coggins,
Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference at 11:00 a.m. (Eastern Time), December 4, 2008. Board participation was requested by applicant. During the conference, opposer was represented by Brain E. Banner and G. Franklin Rothwell, applicant was represented by John J. Brooks III, and participating for the Board was the above-signed Interlocutory Attorney. The Board commends the parties for their collegiality during the conference.

In addition to general comments on the nature and sequence of Board proceedings, the parties were reminded of their obligation with respect to service of papers. Although the parties were unable to reach agreement to accept service of papers by e-mail, the parties agreed to accept courtesy copies of papers by e-mail. The parties were reminded that ESTTA and TTABVue would be useful online tools for filing and viewing documents at the Board, and that the ESTTA consent motion forms

are currently unavailable in this proceeding. The parties were also reminded that the Board's manual of procedure (the TBMP) would be helpful to the parties.

The automatic imposition and possible amendment of the Board's standard protective order were discussed. The parties were advised of their duties for initial disclosures under Fed. R. Civ. P. 26(a)(1). The parties stated that they were not engaged in any related Board proceeding or other related litigation.

The pleadings were reviewed, and the ground of priority and likelihood of confusion was discussed. Because of the routine nature of the claims and defenses in this opposition, the Board suggested to the parties that they could adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories, document production requests, and admission requests. The parties were also advised that they could stipulate to the authenticity of documents and make other stipulations as to evidence.

The Board reminded the parties that pursuant to the Board's recent rule amendments, neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of res judicata or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties revealed that they had previously engaged in settlement and discovery discussions to the extent that the

parties had looked at possible areas of settlement, limitations on discovery, and use of marks during this proceeding; however, the parties have not reached an agreement on settlement or limiting discovery. Opposer stated that it had no new settlement position as of the date of this conference. The parties were encouraged to continue discussing settlement and were reminded that the Board is usually liberal with regard to suspension of proceedings to accommodate settlement discussions.

The mandatory discovery conference having now been held, proceedings will continue on the schedule set forth in the Board's September 30, 2008 institution order. Initial disclosures are due January 8, 2009.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 Fed.Reg. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31,

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2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>