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March 20, 2006

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Box Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Gerard F. Rogers
Administrative Trademark Judge
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Comments on "Miscellaneous Changes to Trademark
Trial and Appeal Board Rules"
71 Federal Register 2498 (January 17, 2006)

Dear Under Secretary Dudas:

The American Bar Association Section of Intellectual Property Law ("ABA-IPL" or "the Section") appreciates the opportunity to offer comments regarding the U.S. Patent and Trademark Office ("PTO") proposed rules directed to changes to the practice before the Trademark Trial and Appeal Board ("the Board") published at 71 Fed. Reg. 10, p. 2498 (January 17, 2006). The views expressed herein represent the views of the Section. They have not been submitted to the House of Delegates or the Board of Governors of the American Bar Association, and should not be construed as representing the policy of the Association.

ABA-IPL is a national organization whose nearly 19,000 members are primarily lawyers in private and corporate practice, and in the academic community. The Section represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of intellectual property law.

The PTO proposed changes to the rules of practice before the Board are so significant that the Section respectfully requests that the PTO extend the comment period by at least sixty (60) days, or alternatively reopen it after March 20th, in order for the Section to more fully analyze and comment upon the changes. Additionally, we request that the PTO hold a public hearing before final rulemaking to give trademark owners and lawyers who regularly practice before the Board the opportunity to fully explain to the Board how the proposed changes could adversely affect users of Board procedures and to permit the PTO to more fully understand the concerns of its customers.

A. Mandatory Disclosures

One proposal about which the Section needs more time to consider regards the mandatory disclosure provisions for *inter partes* proceedings. We believe that limited, fact neutral disclosures akin to those required under Rule 26(a) of the Federal Rules of Civil Procedure may assist in the prompt resolution of *inter partes* proceedings. However, currently we believe that the PTO's proposed rules that would require fourteen separate initial disclosures do not enhance early settlement or increase fair dispositions of claims and defenses (two of the PTO's stated goals of a mandatory disclosure regime). In fact, ABA-IPL believes that the PTO's proposed mandatory disclosures will exacerbate the problems the proposed rules are meant to solve.

The Section believes that the PTO's proposed mandatory disclosures will discourage, rather than encourage, early settlement. Since the fourteen mandatory, and possibly irrelevant, disclosures would be due one hundred (100) days after the Board issues its Institution Order, if settlement is not achieved with this time period, expensive discovery must commence. Once the expense of complying with the mandatory disclosure regime has been incurred, a significant incentive to settle – cost savings – no longer exists. And because of the expenses involved in complying with the mandatory disclosure requirements, parties who cannot afford to produce onerous mandatory disclosures early in a Board proceeding will, with greater frequency, abandon their cases. This may be unfair to small trademark owners and will not increase fair dispositions of claims and defenses.

As currently proposed, the mandatory disclosures take a one-size-fits-all approach. ABA-IPL believes that some, if not many or most, of the mandatory disclosures would not be needed in many cases. The costs of such unneeded discovery would lessen the equitable resolution of many *inter partes* cases. Moreover, the mandatory disclosures will place an opposer of an ITU application at a tremendous financial and procedural disadvantage. While the opposer would have to incur significant expense to comply with the mandatory disclosure requirements, the applicant would normally have almost no documents and incur very little expense.

In its rules notice, the PTO noted that whether a party has adequately met its mandatory disclosure obligations “may be subject to dispute.” Also in the rules notice, the PTO stated that the mandatory disclosures exchanged in *inter partes* proceedings could be used as affirmative evidence by the receiving party. These two factors will inevitably lead to more, not

less, highly-contested level of discovery motion practice, further decreasing the likelihood of prompt settlement while increasing the workloads of the Board.

B. Service of Papers

In another proposal, the PTO wants to amend the trademark rules to provide that a plaintiff, and not the Board, serve a copy of a complaint (*e.g.*, notice of opposition, petition for cancellation, or concurrent use application detailing claims) on the defendant in all *inter partes* proceedings. While the Section currently sees some advantages to having the plaintiff serve the complaint on the defendant in Board proceedings, we believe that as currently proposed, the rules may place new and unreasonable burdens on plaintiffs. Moreover, the Section believes that various terms in the proposed rules regarding the service of complaints are undefined and/or need clarification, *e.g.*, the terms “correspondence address of record” and “proof of service” are not readily understood in the context of proposed rules. Additionally, we believe that the PTO should reconsider what steps a petitioner should have to take to prove that it attempted to serve the owner of a registered United States trademark.

C. Interrogatories

The PTO proposes to limit the number of interrogatories to 25 while continuing to count subparts as separate interrogatories. The Section opposes such a reduction in the number of interrogatories. As a general rule, we believe that the number of interrogatories allowed is inversely proportional to the number of discovery depositions needed in a case. Since a reduction in the number of interrogatories a party is allowed to take usually causes additional discovery depositions to be noticed, the PTO’s proposal may significantly increase the costs of *inter partes* proceedings before the Board.

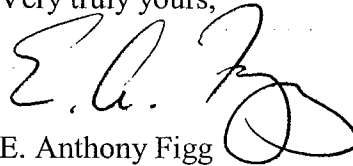
The Honorable Jon Dudas
March 20, 2006
Page 5

D. Submissions to the Board In CD-ROM Form

The PTO proposes to remove from Trademark Rule 2.126, 37 C.F.R. 2.126, the option to file submissions in CD-ROM form. CD-ROMs present technical problems for the ESTTA/TTABIS systems and have rarely been utilized. The Section believes the Rule changes appropriate and unobjectionable.

We appreciate the opportunity to provide comments on the proposed rules and are available to assist the PTO in further aligning Board practice and procedures with the needs of the parties appearing before the Board.

Very truly yours,

A handwritten signature in black ink, appearing to read 'E. A. Figg', with a large, stylized flourish at the end.

E. Anthony Figg
Chair

cc: IPL Council
Hayden Gregory
Betsi Roach