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May 8, 2006

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

Dear Under Secretary Dudas:

This letter is intended to supplement the comments made by the American Bar Association Section of Intellectual Property Law ("ABA-IPL") in March regarding proposed rules to change practice and procedures 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 ABA-IPL. 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 American Bar Association.

Since the proposed rules were first published, the United States Patent and Trademark Office ("PTO") has received a number of thoughtful and important comments reflecting concern of trademark owners and their counsel regarding the likely negative impact of the rules if implemented. ABA-IPL certainly appreciates the spirit

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and the intent of the proposed rules. Cost-effective and streamlined procedures are worthy goals for the PTO and its users. However, ABA-IPL believes that a number of the proposals, if implemented in their current form, will have the opposite effect and perhaps prejudice users of the PTO. Further, ABA-IPL strongly feels that the potential impact of the proposed rules and the consensus of concern regarding them necessitate a public hearing before further consideration is given to adopting the proposed rules.

A. Mandatory Disclosures

There appears to be a consensus among all of the commentators on the proposed rules that the mandatory disclosure regime envisioned by the proposed rules are overbroad, unnecessarily burdensome and costly. The mandatory disclosure requirements of the proposed rules go well beyond those of the Federal Rules of Civil Procedure and provide a disincentive to using the Board to resolve disputes. Currently, Rule 26 of the Federal Rules of Civil Procedure merely requires parties to identify individuals with knowledge and the scope of their knowledge, the nature and location of applicable documents, the plaintiff's computation of damages and the extent of liability coverage possessed by the defendant. Rule 26 does not require a party to provide all the facts underlying its case and allow the opposing party to utilize those disclosures as affirmative evidence.

The proposed rules regarding initial disclosures do not comport with the Federal Rules of Civil Procedure. Instead the proposed rules would require a party to expend substantial resources to fulfill its disclosure obligations (*e.g.*, to obtain and collate facts from witnesses and documents) and would be particularly burdensome on small companies. The potential use of the disclosures as affirmative evidence

discourages a party from availing itself of the Board's procedure. Moreover, whether parties have complied fully with the initial disclosure requirements under the proposed rules will most likely cause a substantial increase in motion practice before the Board, thereby eviscerating any cost savings supposedly underlying the proposed rules.

B. Protective Order

ABA-IPL respectfully submits that the proposed Standard Mandatory Protective Order would require parties to produce highly-confidential materials, including trade secrets, to competitors without (1) an understanding between the parties that the materials would be shared only with outside counsel, or provide for limited access to in-house counsel, (2) an agreement that the order would survive the *inter partes* action, and (3) any mechanism to enforce the terms of the agreement on parties during or after the proceedings because the Board lacks contempt power or power to issue injunctive relief to an aggrieved party. A procedural rule that mandates the production of highly confidential materials, without stringent safeguards against disclosure to and use by a potential competitor, is so potentially prejudicial that parties would be discouraged from using the Board's opposition and cancellation proceedings for the resolution of disputes.

Parties should be permitted to negotiate customized protective orders that meet their particular needs. They should not be forced to adopt a protective order that would result in a number of difficulties for parties to an *inter partes* proceeding, namely, the production of highly confidential materials.

C. Expert Witnesses

The proposed rule provides that experts be disclosed no later than 90 days prior to the close of the discovery period, or if the expert is retained after the deadline for disclosure of experts, promptly upon retention of the expert. ABA-IPL concurs with the comments made by most other user groups and law firms that the proposed rule is ambiguous, requires disclosure of expert information prematurely, will result in unnecessary cost and invites abuse by the parties.

The proposed rule would require parties to retain experts and develop their testimony before fact discovery is completed, thereby driving up costs early in the proceedings. The proposed rule does not differentiate between testifying and non-testifying experts, thereby subjecting parties to disclosure of information commonly immune from disclosure on work product grounds, and allows the parties to retain experts after the disclosure deadline but does not detail under what circumstances it would be permissible to do so (*e.g.*, for purposes of rebuttal, etc.). Consequently, ABA-IPL recommends that the PTO adopt the expert disclosure procedures utilized by most federal district courts, including not requiring the disclosure of testifying experts until the close of the fact discovery period.

D. Service of Process

ABA-IPL does not object to the proposal that would require an opposer or petitioner to serve the applicant of record, the owner's domestic representative, or the attorney of record in the case of a pending application. However, ABA-IPL objects to any proposed rule that would allow an opposer or petitioner to serve the attorney of record for a registered mark, unless the attorney has agreed to accept service on behalf of the owner of the registration. Not only may the attorney who prosecuted an

application to issue have no ongoing responsibility for the registration, she may no longer have an attorney/client relationship with the owner of the registration and may be unable to contact or locate the registrant. Since clients move or go out of business, are acquired or merge and/or transfer their files and PTO records are not always updated to reflect such changes in ownership of marks, ABA-IPL considers it inappropriate to permit service upon the attorney of record (with whom the PTO does not communicate after registration) five or ten years, or more, after the attorney's last action with respect to a registered mark.

E. Conclusion

We continue to appreciate the opportunity to comment on the proposed rules and welcome any questions the Board may have.

Very truly yours,


Chair

cc: IPL Council
Hayden Gregory
Betsi Roach