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May 3, 2006

The Honorable Jon W. Dudas  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
U.S. Patent and Trademark Office (USPTO)  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
Attention: Gerard F. Rogers

*Submitted by email to: AB56Comments@uspto.gov*

**RE: Comments on Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 71 Fed. Reg. 2498 (Jan. 17, 2006).**

Dear Under Secretary Dudas:

The following are the comments of Intellectual Property Owners Association (IPO) with respect to the proposed new rules for Miscellaneous Changes to Trademark Trial and Appeal Board (TTAB) Rules published in a notice in the Federal Register on January 17, 2006 (71 Fed. Reg. 2498). We appreciate the opportunity to comment.

IPO is a trade association for owners of patents, trademarks, copyrights and trade secrets. IPO's membership includes more than 200 companies and a total of 7,700 individuals who are involved in the association either through their companies or as an inventor, author, executive, law firm or attorney member. Most members of IPO's Board of Directors are chief intellectual property counsel in U.S. companies. IPO serves all intellectual property owners in all industries and all fields of technology. IPO advocates effective protection for patents, trademarks, copyrights, and trade secrets and also urges laws that provide reasonable certainty to avoid undue litigation. The proposed changes to the United States Trademark Trial and Appeal Board Rules will have a significant effect on many of our members, their employees, and others in the trademark community, who practice before the USPTO in trademark matters. IPO appreciates the opportunity to provide its comments on specific rule changes as proposed in the notice.

The comments below address the rule changes proposed for Part 2 of title 37 of the Code of Federal Regulations.

## **I. GENERAL REQUEST FOR CLARIFICATION**

IPO believes the new rules may affect the current TTAB practice relating to the extension of time periods and/or milestone due dates (e.g., close of discovery period, etc.), as well as the periodic suspension of proceedings (e.g., to allow the parties time to explore settlement possibilities). We recognize that the proposed rules may cause the TTAB to adopt new policies regarding these issues. We recommend that USPTO clarify how

extensions of routine due dates and suspension of proceedings will be handled by the TTAB. In addition, given that the number of *pro se* parties before the USPTO and the TTAB specifically continue to increase, we recommend consideration of how the Board will handle these cases.

## **II. SPECIFIC COMMENTS ON SELECTED PROPOSED CHANGES**

### **A. PROPOSED CHANGE TO 37 C.F.R. 2.101(a), (b) and (d)**

The Office proposes to revise §2.101(b) to define the phrase "correspondence address of record" and to specify the steps opposer should take if opposer believes that the correspondence address of record is not accurate, or if the service copy of the notice of opposition is returned as undeliverable to opposer. The section further reads "if the opposer believes that the applicant of record or correspondence address of record is not accurate or current, the opposer should serve an additional copy of the opposition and exhibits on any party, or the party's attorney or domestic representative, that the opposer has reason to believe may be the correct applicant, or its successor-in-interest..."

IPO believes this latter obligation is overly burdensome for the opposer. We believe it should be the applicant's burden to maintain current contact information in the record of its application. IPO suggests that the opposer's burden be limited to notifying the TTAB if the service copy of the Notice of Opposition is returned as undeliverable.

### **B. PROPOSED CHANGE TO 37 C.F.R. 2.111(a) to (c)**

The Office proposes to revise §2.111(b) to define the phrase "correspondence address of record" and to specify the steps petitioner should take if petitioner believes that the correspondence address of record is not accurate, or if the service copy of the petition to cancel is returned as undeliverable to petitioner.

Similar to §2.101(b), IPO believes this obligation is also overly burdensome for opposer as applied to cancellation proceedings.

### **C. PROPOSED CHANGE TO 37 C.F.R. 2.116(g)**

The Office proposes to add a new paragraph (g) to §2.116. The proposed §2.116(g) provides that the Board's standard protective order, available via the Office's web site or upon request, is applicable to all *inter partes* proceedings unless (a) the parties agree to and the Board approves an alternative protective order, or (b) a motion by a party to enter a specific protective order is granted by the Board.

IPO agrees that this rule is likely to promote the production of documents and information at an earlier stage of the proceeding, compared to the production of documents and information exchanged under the current rules.

### **D. PROPOSED CHANGE TO 37 C.F.R. 2.120(A)(1)**

The Office proposes to revise Section 2.120(a)(1) to include detailed provisions regarding

the requirements for a discovery conference and for initial and expert disclosures in lieu of discovery.

IPO is concerned that the scope of the initial disclosures is too broad and that the initial disclosure obligations create an unfair imbalance which places too great a burden on opposers. In addition, the proposed rules impose greater obligations on parties to an appeal than do the Federal Rules of Civil Procedure.

An obligation to provide objective information regarding such things as dates of use, other Board proceedings, and most knowledgeable individuals is reasonable. However, we object to other categories that, by their subjective nature, will be much more burdensome to disclose and potentially subject opposers to fishing expeditions and excessive, costly and unnecessary work. These categories include: information on the adoption or creation of the mark, plans for future use of the mark, third party uses and surveys or market research. For an opposer that has spent a great deal of time and effort in selecting the mark it relies on and conducted surveys and market research, the initial disclosures would be costly and burdensome. If the nature of the mark is such that there is extensive third party use of a common term, disclosure of all known third party uses would be costly and burdensome. Clever applicant's counsel could easily take advantage of this for unscrupulous reasons whether or not there is any real intention to defend the application.

**E. PROPOSED CHANGE TO 37 C.F.R. 2.121(a) and (d)**

The Office proposes to revise §2.121(a) to provide for a deadline for pre-trial disclosures and for testimony periods.

IPO recommends that USPTO identify the consequences if the deadline for pre-trial disclosures is not met along with a sufficient description of procedures available to remedy a failure to make the pre-trial disclosures prior to the deadline. In particular, the rules should address whether last minute submissions prior to trial will be sufficient to overcome the consequences of a failure to comply with the pre-trial disclosure deadlines.

**F. PROPOSED CHANGE TO 37 C.F.R. 2.123(e)**

The Office proposes to revise §2.123(e)(3) to provide that a party may object to improper or inadequate pre-trial disclosures and may move to strike the testimony of a witness for lack of proper pre-trial disclosure. See comments above for 37 C.F.R. §2.121(a).

**G. PROPOSED CHANGE TO 37 C.F.R. 2.127(a), (c) and (e)**

The Office proposes to revise §2.127(e) to provide that a party may not file a motion for summary judgment before it has made its initial disclosures and to provide that a party may submit disclosures and disclosed documents when briefing a motion for summary judgment.

IPO recommends that the USPTO clarify whether the responding party to a summary judgment motion is obligated to respond if it alleges the moving party failed to make an adequate initial disclosure. Likewise, the rules should discuss the procedure for determining whether an initial disclosure was adequate should this situation arise.

Similarly, IPO recommends the USPTO clarify the rules on the process for determining whether a party's initial disclosure is adequate (in general), the penalties for an inadequate initial disclosure, and whether a party must file a motion to compel an adequate initial disclosure before penalties will be imposed.

Please contact us if you have questions on any of our comments.

Sincerely,

A handwritten signature in black ink, appearing to read "Marc S. Adler". The signature is fluid and cursive, with the first name "Marc" and last name "Adler" clearly distinguishable.

Marc S. Adler  
President