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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.

