

# New York State Bar Association

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2004-2006 Executive Committee

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May 3, 2006

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

Dear Undersecretary Dudas:

This letter is being submitted in response to the proposed rules (the "Proposed Rules") of the U.S. Patent and Trademark Office ("PTO") published at 71 Fed. Reg. 10, p. 2498 (January 17, 2006) affecting the practice before the Trademark Trial and Appeal Board ("the Board").

The following comments are submitted on behalf of the Trademark Law Committee of the New York State Bar Association's Intellectual Property Law Section, and have been endorsed by the Intellectual Property Law Section's Executive Committee:

### Mandatory Disclosures

For the reasons set forth by the American Intellectual Property Law Association ("AIPLA") in its March 16, 2006 comments submitted to the Board on the Proposed Rules, we agree that mandatory disclosures will increase discovery motion practice, be onerous and costly, and not increase fair dispositions of claims and defenses.

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May 3, 2006

Page 2

Protective Order

The Trademark Law Committee agrees with the International Trademark Association ("INTA"s) comments submitted to the Board on March 20 that it should be made clear that a party can file a motion to have an alternative protective order apply in appropriate circumstances.

Interrogatories

We believe the Board should not reduce the number of interrogatories from 75, for the reasons set forth by the AIPLA. If there is to be a reduction, like INTA, we believe that the proposed reduction is too drastic.

Service by Plaintiff

Like the AIPLA and INTA, we believe that a plaintiff should be allowed to rely upon the owner information and correspondence address of record in the PTO's official public records for purpose of service of the complaint on a defendant in an inter partes proceeding.

CONCLUSION

The Intellectual Property Law Section's Trademark Law Committee and Executive Committee believe that the Proposed Rules should not be adopted as currently drafted, because they would not further the goals of judicial economy or the streamlining of Board proceedings. Moreover, the Proposed Rules contain significant changes to the practice before the Board and would substantially affect the due process rights of the parties. Accordingly, a public hearing on the Proposed Rules is warranted. While written comments are useful, they are no substitute for public dialogue and a hearing in this case.

We thank the Board for consideration of the above.

Respectfully submitted,



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